

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

947
United States Court of Appeals
BRIEF OF THE APPELLANTS
for the District of Columbia Circuit

FILED

APR 12 1940

IN THE

Nathan S. Brown
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 23575

John F. Cody et al. Appellees

v.

Aktiebolaget Flymo, Karl Rudolph Dahlman, and
Flymo Societe Anonyme, Appellants

~~appeal from the United States District Court~~
for the District of Columbia

LAURENCE R. BROWN
for Appellants

Of Counsel:

JOHN H. LEWIS, JR.
STEVENS, DAVIS, MILLER & MOSHER

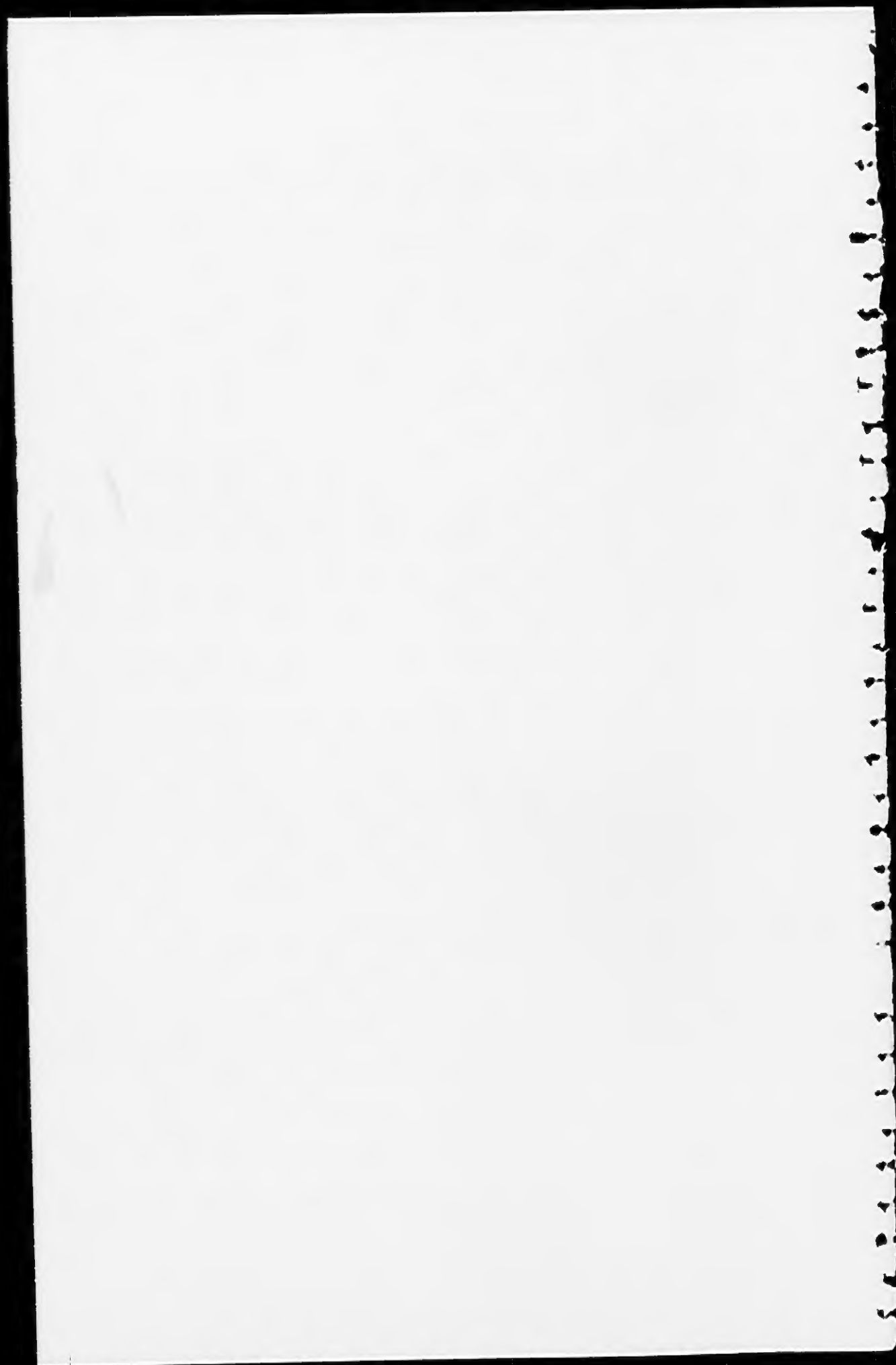


TABLE OF CONTENTS

BRIEF	Page
STATEMENT OF ISSUES FOR REVIEW	1
REFERENCES TO RULINGS	2
STATEMENT OF THE CASE	3
STATEMENT OF FACTS RELEVANT TO THE ISSUES	4
Flymo et al. introduces the subject matter involved here	4
Cody et al. copied claims from the Flymo et al. patent	5
The Junior Party Cody et al. Burden of Proof	9
Flymo et al. prevailed in the U.S. Patent Office Twice	11
Cody et al. Appeals to the U.S. District Court for the District of Columbia	12
The District Court reversed the Patent Office decision on the record	13
The counts in issue taken from the Flymo et al. Pat- ent 3,110,996	14
ARGUMENT	14
Summary	14
The party Cody et al. did not sustain his heavy bur- den of proof in overcoming the two Patent Office decisions	15
Trial de novo under 35 USC 146 is limited	16
The Decision of the Trial Court is based on Errone- ous Conclusions of Law and Determinations of Fact	18

	Page
The junior party Cody et al. has not met the imposed burden of proving reduction to practice. As a matter of fact, no successfully operable machine was proven by Cody	18
As a matter of law, the Cody et al. proofs fell short of a reduction to practice	19
The Trial Court position on Elmore v. Schmitt	22
The Flymo et al. motions need be decided if priority stands in favor of Cody et al.	23
Inoperability of Cody et al. device under 35 USC 112	24
Publication and patent bar to Cody et al. under 35 USC 102	26
CONCLUSION	27
Holding of Priority for Flymo et al. is in order	27
Counts are unpatentable to the party Cody et al.	28

Table of Contents Continued

iii

APPENDIX	Page
Motion for Summary Judgment	1a
Memorandum in Support of Plaintiff's Motion for Summary Judgment	2a
Defendant's Opposition to the Plaintiff's Motion for Summary Judgment and Motion for Summary Judgment in Favor of Defendant	9a
Memorandum in Support of Defendant's Opposition to the Plaintiff's Motion for Summary Judgment and in Support of Defendant's Motion for Summary Judgment in Favor of Defendants	12a
Statement of Genuine Issues by Defendant in Opposition to Motion by Plaintiff for Summary Judgment	41a
Statement of Material Facts by Defendant in Support of Defendants' Motion for Summary Judgment ..	43a
Plaintiffs' Response to Defendants' Opposition to Plaintiff's Motion for Summary Judgment	45a
Hearing on Cross-Motions for Summary Judgment ...	53a
Memorandum Opinion	67a
Order Granting Plaintiffs' Motion for Summary Judgment and Denying Defendants' Motion for Summary Judgment	70a
Order	71a
Notice of Appeal	72a
Dahlman Patent 3,110,996	73a

	Page
APPENDIX EXHIBITS	
Volume I—Dahlman File History	1-46
Volume II—Cody et al. File History	47-117
Volume III—Cody et al. v. Dahlman Interference No. 94,824. File History	118-280
Volume IV—Cody et al. Testimony Interference No. 94,824	218-420
Volume V—General Exhibits	421-457
Decision: Package Devices, Inc. et al. v. Sun Ray Drug Co. et al., DCEPa 162 USPQ 400 (1969)	421
35 USC 102 (b)	434
35 USC 112	435
35 USC 135 (b)	435
35 USC 146	436
MPEP 706.03 (d) (f)	438
Commercial Bulletins—Toro—	439
News Releases—Brussel Fair Gold Medal Winner	440
Complaint—Cody et al.	441
Answer—Dahlman et al.	448

INDEX OF CITATIONS

CASES:	Page
Anderson v. Scinta (CCPA) 372 F.2d 523 (1967)	21
Bell Telephone Laboratories, Inc. v. International Standard Electric Corp. (DC Del) 27 F Supp. 926 (1939)	16
Bendix Aviation Corp. v. Ooms (App. DC) 153 F.2d 125 (1946)	25
Butler v. Shaw (CC Mass) 21F 321 (1884)	16
Chicago Pneumatic Tool Co. v. Hughes Tool Co. (10th Cir.) 192 F.2d 620 (1951)	26
Conner v. Joris (CCPA) 241 F.2d 944; 44 CCPA 772 (1957)	20
Ellis Foster Co. et al. v. Union Carbide & Carbon Corp. (3rd Cir.) 284 F.2d 917 (1960)	24
*Elmore v. Schmitt 278 F.2d 51; 47 CCPA 958 (1960) 2, 12, 22	
Gaiser v. Lender 253 F.2d 433; 45 CCPA 846 (1958) ..	21
Hansgiring v. Kemmer (CCPA) 102 F.2d 212 (1939) ..	25
Hazeltine Research Co. v. General Motors Corp. (6th Cir.) 170 F.2d 6 (1948)	26
*Hill v. Wooster, 132 US 693 (1889)	24
Howard Plastics, Inc. v. Traver Investments, Inc. et al. (DC SI11) 138 USPQ 568 (1962)	24
*Kirschke v. Lamar (DC WD Mo.) 300 F Supp 146 (1969)	17
*Morgan v. Daniels, 153 US 120 (1893)	15
*Package Devices, Inc. et al. v. Sun Ray Drug Co., et al. (DC E Pa.) 162 USPQ 400 (1969)	26
Pure Oil Co. v. Socony-Vacuum Oil Co., Inc. et al. (CA DC) 212 F.2d 454 (1954)	24
*Radio Corporation of America v. Philco Corp. (DC NJ) 275 F Supp 172 (1967)	20
Radio Corporation of America v. Philco Corp. (DC E Pa) 187 F Supp 940 (1960)	24, 25
*Railway Co. v. Sayles 97 US 554 (1877)	26
*St. Pierre v. Harvey, 233 F.2d 337; 43 CCPA 918 (1956)	21

* Cases chiefly relied upon are marked with an asterisk.

	Page
*Sanford v. Kepner 344 U.S. 13 (1952)	24
*Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47 (1938)	26
Sperry Rand Corp. et al. v. Bell Telephone Labora- tories Inc. (DC SNY) 171 F Supp 343 (1959)	24, 25
*Steenstrup v. Morton 38 App. D.C. 343, 30 F.2d 867 (1929)	25
Tidewater Patent Development Co., Inc. v. The Gillett Co., (4th Cir) 273 F.2d 936 (1959)	16, 24

PATENT OFFICE PROCEDURAL RULES:

Manual of Patent Examining Procedure Section 706.03 (f)	24
--	----

STATUTES:

35 USC 102(b)	4, 13, 26, 27, 28, 29
35 USC 112	4, 13, 24, 25, 26, 27, 28, 29
35 USC 135(b)	23
35 USC 146	16, 24

* Cases chiefly relied upon are marked with an asterisk.

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Case No. 23575

AKTIEBOLAGET FLYMO, KARL RUDOLPH DAHLMAN, AND
FLYMO SOCIETE ANONYME *Appellants*

v.

JOHN F. CODY ET AL. *Appellees*

Appeal From the United States District Court
for the District of Columbia

BRIEF OF THE APPELLANT

STATEMENT OF ISSUES FOR REVIEW

The trial court erred in making, without a trial, findings of fact and conclusions of law contrary to those made in a decision of the United States Patent Office which awarded priority below to Appellant (the senior party) and in reversing the Patent Office decision on the record in a summary Judgment proceeding.

The trial court erred in summarily dismissing certain motions of Flymo et al. of such substance as would necessarily result in a Judgment for the senior party Flymo et al.

This case has appeared on the miscellaneous Docket of this Court No. 3269 as a request for interlocutory appeal on May 21, 1968, with an order filed July 1, 1968, denying the request.

REFERENCES TO RULINGS

- I. An oral hearing in the trial court on the Cody et al. Motion for Summary Judgment on the Patent Office record and the Flymo et al. cross motions was conducted on May 9, 1969 (Appendix page 53a herein-after p. 53a).

This hearing was curtailed and amounted only to a brief background presentation of the relationships of the parties.

- II. The position of the Trial Court is set down in the memorandum opinion filed July 19, 1969 (p. 67a).

The judgment was premised on several grounds:

- (1) A conclusion that The Board of Patent Interferences' determinations after a full and contested proceeding "are erroneous in law and fact".
- (2) A conclusion that the central issue is whether Cody had a machine of practical efficacy and utility.
- (3) A conclusion that "efficiency cannot be questioned".
- (4) A conclusion that "The Cody machine cut grass satisfactorily under operating conditions, although the width of the cut was not in relation to the length of the blade at the optimum desired".
- (5) A conclusion that "The fact that further experimentation and refinement was deemed necessary for the machine to reach its full potential is of no consequence".
- (6) A conclusion that "The inventor was not proceeding on laboratory theory; there was actual physical practice because it was shown that the invention worked".
- (7) A conclusion that "The Board's reliance on *Elmore v. Schmitt, supra*, is misplaced. Without reviewing the facts of that case in detail, it is clear

that the Court of Customs and Patent Appeals rejected the counts in interference, because the invention had not been reduced to an actual demonstration such as encountered in its practical use, but was supported solely on a basis of prediction founded on laboratory tests. The nub of the invention is a machine that cuts grass and Cody's machine cuts grass in actual fact".

- (8) Apparently because of several references to the prior conception of Cody, there was some weight given this conception in arriving at a reversal, where only an actual reduction to practice should have any weight.
- (9) The defenses of Flymo were summarily dismissed with the statement "It is not for the Court in this proceeding to re-examine all aspects of the Board's decision, but only to review the Board's ruling on the central issue of priority".
- (10) A ruling was made in favor of Cody et al. that 'Priority was clearly established and there was a sufficient reduction to practice as a matter of law'.

STATEMENT OF THE CASE

The nature of this case, Civil Action No. 1654-67 in the District Court below, is an appeal under 35 USC 146 brought up by the losing junior party Cody et al. from the United States Patent Office to review the holding in a fully contested interference proceeding awarding priority to the senior party patentee Flymo et al. The interference includes three Counts taken from issued Flymo et al. patent 3,110,996. The Patent Office held that the junior party Cody et al. did not prove an actual reduction to practice of the invention of the interference Counts both in an initial hearing before the Board of Interference Examiners and in a rehearing requested by the junior party Cody et al. The subject matter relates to a wheelless lawn mower of the

rotary blade type supported on a cushion of air directed from a blower so that it will not blow the grass away from the cutting blade.

In the District Court, after various preliminary matters not relevant to this appeal, the junior party Cody et al. moved for Summary Judgment on the record to overrule the award of priority made in the Patent Office. The senior party Flymo et al. opposed this motion and made a cross motion for Summary Judgment on the basis that the counts were unpatentable (1) under 35 USC 102 to the junior party Cody et al. who first claimed the invention more than one year after Flymo et al. had published and patented the invention and (2) that the junior party Cody et al. had not under 35 USC 112 claimed a device which included structure necessary for successful operation under the single disclosed embodiment.

The trial court, without any new evidence, in a memorandum opinion of June 19, 1969 followed by an order of July 18, 1969 reversed the Patent Office holding and awarded priority to the junior party Cody et al. summarily disposing of the cross motions of Flymo et al. without consideration.

Flymo et al. now take this appeal from the decision of the trial court and asks this Honorable Court to make a final ruling on the priority in favor of the senior party patent holder sustaining the ruling of the United States Patent Office.

STATEMENT OF FACTS RELEVANT TO THE ISSUES

Flymo et al. Introduces the Subject Matter Involved Here.

The party Flymo through the assignor inventor Karl Rudolph Dahlman conceived of a lawn mower operating on a cushion of air and not requiring wheels. An operable machine was built on this principle and exhibited at the Brussels Fair in Belgium in 1963 winning a gold medal. Published articles appeared in Nov. 1962 (Exhibit III,

p. 271) and a patent was granted to Dahlman in Belgium in March 1962 (Exhibit III, p. 268). The mower was licensed to Toro in the United States (Brief for Dahlman. Exhibit III, p. 182) and was extensively marketed and advertised in the United States (Exh. V, p. 439) before Cody et al. copied the claims from the Patent.

Flymo et al. filed in the United States on March 12, 1962, claiming priority of the earlier Swedish application of March 16, 1961, and, subsequently, U.S. Patent 3,110,996 issued on November 19, 1963.

Flymo et al. operated its machine on the principle of using a radial blower to pass air around the rim of the mower housing so that it would not blow grass down in the path of the rotating blade, thereby permitting the blade to cut grass in a conventional manner. Because of the serious question of whether a lawn mower can be supported on a cushion of air without blowing down the grass so that grass cutting would be ineffective, the operability of the mower was questioned in the U.S. Patent Office (Patent Office Paper No. 8, Exhibit I, p. 14) and a demonstration of the Flymo et al. device was made before the Examining Corps proving operability (Dahlman Amendment Exhibit I, p. 8), after which the patent (p. 73a) was granted.

Cody et al. Copied Claims From the Flymo et al. Patent.

An interference was declared in the United States on March 18, 1965 (Exh. III, p. 279), after Cody et al. copied claims from the Flymo et al. patent which was cited in the prosecution of the Cody et al. application filed Nov. 7, 1962 (Patent Office paper No. 5, Exh. II, p. 80).

At no time in the U.S. Patent Office or in subsequent testimony did Cody et al. ever demonstrate an operable machine, and the machine upon which Cody et al. relied worked on a different principle than the Flymo et al. machine. Thus Cody et al. used a downward blowing conventional airplane-like propeller, which tended to blow

down the grass flat on the ground below the cutting blade so that the blade would not cut it unless certain aerodynamic baffles were introduced at critical locations between the blower and the cutting blade to produce small regions of modified air flow that would tend to suck at least part of the blown grass blades back up into the path of the cutting blade.

Quotes are taken from the Cody et al. patent application as follows:

"While vehicles such as automobiles have, in the past, been supported on cushions of air, it would normally be expected that, if such support were applied to lawn mowers, the blast of air downwardly would flatten the grass and thereby prevent the lawn mower from function properly. . . . The housing is also provided with suitable baffles which tend to counteract the swirling motion imparted to the air by the propeller while other baffles are employed so as to control the blades of grass to position the grass in a generally upright condition for the cutting of the blade . . . Another object of the present invention is to provide a mowing machine which will ride smoothly over the vegetation to be mowed, regardless of minor variations in the contour of ground thereunder, to provide a smooth uniform height cutting operation . . . while the flexible skirt 19 materially improves the performance of the lawn mower, the lawn mower is nevertheless operative without the skirt 19 and it will be understood that even a metal skirt 19 could be used. . . . For creating a downward blast of air, . . . the impeller or propeller 20 is mounted on shaft 55 for rotation therewith Below the propeller 20 and immediately above blade 20 for projecting above the path of travel of the tips of blade 30, are a pair of opposed secondary baffles 61 and 62, which protrude within the chamber from opposite inner sides of the outer housing body 11, . . . to cause the grass on the extreme sides of the path of travel of the lawn mower to stand upright so that they may be cut by blade 30 OPERATION as the swirling air moves downwardly, it engages the baffles 58 which tend to straighten out the path of the air, and, indeed, direct

a portion of the air in a clockwise direction to counteract the torque created by the engine and the vortex In directing the air downwardly the baffles 58 also create a vacuum along their back surfaces. Thus, the vacuum of the vortex and of the baffles 58 tends to lift the grass or vegetation which has been blown flat by the air blast across edge 24. When the grass or vegetation is lifted, it is cut by blade 30 in the usual manner; however, the cutting action may take place inwardly of the tips of blade 30, thereby suggesting that the cutting edges 60 be sharpened over a greater length than conventional blades." (Exh. II pp. 50ff)

Without aerodynamic baffles the Cody et al. device demonstrated in proof would not work properly. This is admitted by the inventors Cody et al. in the testimony and is stated in the application in which Cody et al. copies the claims.

Excerpts of the inventors testimony are quoted as follows:

(Cody) Q. 120. Would you describe the operation of the machine when you cut grass, and I think you did say that you cut grass in April of 1960, didn't you?

A. Yes. Well, we were not getting a cut over the full length of the cutter blade. We were cutting more to the center and the machine had quite a bit of torque and we knew that we would have to correct both of these things.

Q. 121. Did you subsequently correct both of those?

A. Yes, we did.

Q. 122. In what way did you correct them?

A. Well, the width of the swath that the blade was cutting we corrected by putting air deflector boxes inside the hull just above the cutter blade, which controlled the air movement, deflected the air movement that was coming from the propeller, the downward blast from the propeller, so that the cutter blade would cut a full swath. Secondly, we installed later torque fins that applied pressure in the opposite direction of the torsional pull. This corrected the torque on the machine so that it was stabilized.

Q. 123. And did you, then, try the machine again?

A. Yes.

Mr. Hopkins: Off the record (Discussion off the record)

(Sites) Q. 39. Did the machine have the fiberglass skirt on the device when it was first built?

A. No, the first machine didn't. We had talked about that idea and we wanted to see whether it worked without one or not, and we found out real quick that the first mound of dirt or rock you hit, a little mound of dirt, with a hard surface, that it wouldn't work. It would cause your machine to tip over or something and so we went to a flexible skirt instead of the hard surface, a vertical shell is what it amounts to, and whenever you hit a hard resisting object it would flex and let your machine pass over and still perform its operation.

Q. 40. Let's go back to the first machine you build without the skirt and you tried it. I believe you told me it actually cut grass; is that right?

A. Yes, sir; it cut grass. It had a torque problem and it didn't cut the grass to the best possible, what you'd really want. I mean it wasn't the ultimate in cutting grass but it did cut grass. It made a fair swath, but it wasn't giving us exactly what we wanted so we went inside and had a torque problem which we tried correcting and did correct the torque by putting air deflectors in it.

Q. 45. Did it (motor) lift the machine off the ground?

A. Yes, sir.

Q. 46. I'm talking about the first one, now.

A. The first one, yes, it would displace its own weight, not sufficient because we had the heavy engine, but it would pick it up and it would cut grass. It just wasn't as efficient as what we wanted and wasn't what we would want to put on the market. (Exh Vol. IV pp. 334ff and 378ff).

At the time, the Flymo et al. patent claims were copied Cody et al. was claiming the aerodynamic baffles as a necessary part of their operable structure in all claims directed to a corresponding invention. In the U.S. Patent Office each and every claim is considered a separate and discrete

invention so this required Cody et al. to claim a new invention, that of Flymo et al., which operated without the aerodynamic baffles to counteract torque and raise the grass. The claim was not made by Cody et al. until more than one year after statutory bars were in effect comprising a Flymo et al. patent in Belgium and publication in Sweden.

Cody et al. was the junior party with the burden of proof.

The Junior Party Cody et al. Burden of Proof.

Flymo et al. raised the question below whether the burden of proof to Cody et al. should not be beyond a reasonable doubt since the same invention was first claimed after the issuance of the Flymo et al. patent. The Patent Office ruled below that Cody et al. did not prove priority of the invention by a preponderance test.

Cody et al. at no time ever showed or demonstrated any operable machine. The only corroboration of the inventors testimony, which is crucial, was vague oral testimony sometimes contradictory, from such witnesses as the father-in-law of one of the inventors submitted many years after the fact with a bare allegation that some sort of a machine not identified, defined or described in detail or compared with the counts "cut grass", without specifying how, where, on what kind of day, with what kind of effectiveness or in any way showing that the cutting of grass was good enough to prove the machine operable.

Agerton Q. 11. Did it cut grass?

A. It cut grass; yes, sir.

Q. 16. What did you see on the inside?

A. Well, I saw a blade down there and I very well remember that during the time that he was testing it he happened to hit a little object of some kind in the yard and it sheared a pin in the shaft.

Q. 24. Getting back to the machine when you first saw it, how was the propeller and the blade driven?

A. With a gasoline-type motor.

Q. 27. How were they mounted, did they have one shaft or two shafts, or what?

A. Well, they had one shaft, I think I'm right, they had one shaft and it was hooked to the engine.

Neill Q. 16. Well, can you describe the machine you saw?

A. The base of the machine—I'd call it the base of it—was fiberglass.

Q. 17. Would you term that a housing?

A. It was the housing, yes, and it had what we'd call more like a blower shell there and it had a regular cutting blade like a rotary lawnmower on it. It had metal handles attached to it and at that particular time, when he first came out with it, he had four-cycle engines of them, which was different than the ones he made later.

Q. 26. Well, now, on the first one, did they have an inner shell on the thing or not?

A. It had to have an inner shell, sir; it wouldn't have flown without an inner shell, which as I refer to the inner shell, which gave your air to hold it in flight.

Q. 30. Were the blades made out of wood or metal, or do you recall that?

A. All the early blades were made out of wood.
(Ex IV pp. 391ff and 364ff)

On the other hand, the inventors themselves acknowledged that the machine relied upon didn't "fly right" and had torque problems, and needed a flexible skirt to prevent scraping the ground and critically placed baffles for aerodynamic air deflection to keep from blowing the grass flat. None of these improvements were proven to be on the machine relied upon for proofs by the oral testimony of corroborating witnesses. Instead there was considerable evidence introduced that the inventors, in a search for an operable machine, had made many experiments and changes over a period of several years following the development of the machine relied upon for proof.

The record shows this:

Cody Q. 182. Mr. Cody, I hand you a group of photographs marked exhibits 20, 21, 22, 23 and 24 and ask you if you can identify these photographs, please?

A. Yes, these are photographs we had Mr. Martin take of various parts that we used in the various experiments with the machine.

(Exh IV p. 346)

The attorney for Cody et al. also admitted on the record in the trial court that he had intentionally not carried the testimony further, even though he had the burden of proof as a junior party.

Mr. Hopkins: "Now the issue, and the reason we are the Plaintiff, and the reason we are appealing is that I stopped taking testimony when they testified that it cut grass." "Then I took an appeal to the District Court for the District of Columbia . . . since I could put on additional proof as to the fact that this machine was cutting grass all over" (p. 56a)

Flymo et al. Prevailed in the U. S. Patent Office Twice.

Cody et al. was denied priority after a fully prosecuted inter-party proceeding in the Patent Office and, again, was denied priority upon a rehearing.

The Board of Patent Interferences in their decision on priority stated: "In order to prove an actual reduction to practice, it must be proved that the machine operated in an acceptable manner for its intended purpose. However, we do not find, from the record, that the results of the machine built in 1960 were acceptable we are unable to ascertain, from the record, when and which parts were included in a machine that resulted in a satisfactory operation. We, therefore, find that . . . it has not been proved by a preponderance of the evidence that the machine operation was satisfactory.

We, therefore, find that the party Cody *et al.* has failed to sustain their burden of proof and the senior party Dahlman must prevail on the basis of his constructive reduction to practice of counts 1-3 by the filing of his involved application."

Upon Cody et al.'s request for reconsideration, the Board of Patent Interferences confirmed the award to Dahlman.

"We did not overlook the testimony referred to by Cody et al. such consideration did not convince us that Cody et al. had proved, with the required preponderance of evidence, that the machine did, in fact, operate in a satisfactory manner for its intended purpose.

No doubt the tests were of an encouraging nature and may have justified a prediction that the invention would probably be successful if and when it could be put to practical use. However, reduction to practice requires more than that. What is required is not a mere basis for prediction but an actual demonstration. See *Elmore v. Schmitt*, 47 CCPA 958; 757 O.G. 288; 278 F.2d 510.

We believed when reaching our original decision and we still believe that just cutting grass, without regard for its effectiveness, is insufficient proof of the practical utility of the maching (sic) for its intended purpose under ordinary working conditions. Thus, Cody et al. did not sustain their burden of proof and did not prove actual reduction to practice of the invention in issue." (Exh. III pp. 118ff).

**Cody et al. Appeals to the U. S. District Court for the
District of Columbia.**

In this proceeding, several motions were brought on matters of procedure, none of which relate to this appeal, and, therefore, which are not necessary to relate herein. Thereafter Cody et al. brought a motion for summary judgment on the record to declare the U.S. Patent Office in error for their decisions made below (p. 1a). Flymo et al. opposed this motion and made cross motions on two grounds of record proposed to the Examiner below in the Patent Office (p. 9a). A decision was not made by the Board of Patent Interferences on these motions since they become ancillary to priority only if an award of priority is

made to Cody et al. In the Summary Judgment proceeding, Flymo et al. moved for a decision on the motions only considered in the Patent Office at the examination level to the effect that: (a) the counts were unpatentable to Cody et al. who did not disclose a device operable without special aerodynamic blades between the propeller and the cutting blade and thus, under the provisions of 35 USC 112, these times must be included in his claims to make the device from the Cody et al. disclosure operable, and (b) the invention of the counts was not claimed by Cody et al., until more than one year had passed from publication and patenting of the invention by Flymo et al., to the effect that Cody et al. is barred under the provisions of 35 USC 102 from obtaining a patent.

Cody introduced no new evidence to the District Court.

**The District Court Reversed the Patent Office Decision
on the Record.**

Cody et al. introduced no new evidence before the District Court, which proceeded on the record from the U.S. Patent Office to make several conclusions of law and determinations of fact, reversing the award of priority to the senior party Flymo et al. (p. 70a) The hearing on the motions was set on May 9, 1969 (p. 53a) for which a transcript was prepared (p. 53a) and a memorandum opinion was issued on June 19, 1966 (p. 67a) with an order of judgment on July 18, 1969. (p. 71a)

The District Court summarily dismissed without consideration the cross motions made by Flymo et al.

Accordingly, Flymo et al. now comes to this Honorable Court on appeal, asking for reversal of the findings of the District Court, and the entry of a final decision on the issue of priority.

**The Counts in Issue Taken From the Flynn et al. Patent
No. 3,110,996.**

Claim 1. (Count 1) A grass cutting machine comprising a housing having a bottom opening, the peripheral edge of which is located substantially in a plane, a cutter mounted in said housing, driving means for said cutter, and a radial discharge type fan driven by said means for producing a flow of air radially to strike the housing and flowing out through said bottom opening therefrom along the peripheral edge at rates suitable for keeping said peripheral edge at a small distance above the ground by ground effect.

Claim 5. (Count 2) A grass cutting machine comprising a hood having a top cover portion and a skirt portion, the latter being substantially shaped as a vertically disposed cylinder terminated at its bottom with a supporting rim, a motor attached to said top cover portion, said motor having a vertical shaft extending into the space within said skirt portion, an air impeller mounted on said shaft, a rotary cutter mounted on said shaft below said air impeller, an air inlet opening disposed centrally of said top cover portion, said air impeller being constructed to suck in air through said air inlet opening and to expel air through the open bottom of said hood at a rate sufficient to slightly elevate the assembly of said hood, motor, air impeller and rotary cutter from the ground by ground effect.

Claim 12. (Count 3) A wheelless grass cutting machine having a power operated rotary cutter and commonly driven air impelling means for producing ground effect to support said machine on a cushion of air at a distance above the ground.

ARGUMENT

Summary

(1) It is shown, as a matter of law, that the party Cody et al., seeking to overturn a decision of the Patent Office, must bear a heavy burden of proof and have every reasonable doubt resolved against him in asking the District

Court to set aside an action of the Patent Office as one of the executive departments of the Government. As a matter of fact, Cody et al. did not submit any proofs, but relied solely upon the record. Thus the District Court was in error in reversing the Patent Office holding of priority for the patentee Flymo et al., and it is shown that this Honorable Court, to be consistent with the state of fact and law, must make a decision on priority in favor of the patentee Flymo et al.

(2) It is shown that the trial court, as a matter of both fact and law, did not properly overrule the Patent Office on the record, and, therefore, that the trial court should be reversed.

(3) It is shown that the trial court erred in failing to consider the cross motions of Flymo et al., which became ancillary to priority, when the trial court reversed the Patent Office, and that this Honorable Court should make a determination of the right of the party Cody et al. to make the counts, if the trial court award of priority is sustained in favor of Cody et al.

The party Cody et al. did not sustain his heavy burden of proof in overcoming the two Patent Office decisions. The District Court, on the Basis of the Record and without any new evidence introduced by the junior party Cody et al., having the heavy burden of proof, reversed the holding of an expert administrative body, the United States Patent Office, which awarded priority to the patentee Flymo et al. in a fully contested proceeding below. (p. 71a)

There is a long line of cases establishing this to be erroneous as a matter of law. The Supreme Court has established the basic principle, since followed, in *Morgan v. Daniels*, 153 U.S. 120, (1893) which states . . . "it must be laid down as a rule that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there must be accepted as controlling upon that question of fact in any subsequent suit between the parties, unless the contrary is established

by testimony which, in character and amount, carries thorough conviction." This same case goes further in holding that not only is the burden of proof to make good this defense imposed upon the party setting it up, but "every reasonable doubt should be resolved against him."

The case of *Bell Telephone Laboratories, Inc. v. International Standard Electric Corp.*, (DC Del) 27 F Supp 926 (1939) holds that the findings of the Patent Office should be followed unless the contrary is established by testimony which, in character and amount carries thorough conviction.

Butler v. Shaw, (Mass. Cir.) 21 F 321, 327, (1884) rules this sort of proceeding is something more than a mere appeal. it is an application to the court to set aside the action of one of the executive departments of the Government, and that to do such more than a preponderance of evidence must be submitted.

Such rulings are followed in many recent decisions such as *Tidewater Patent Development Co., Inc. v. The Gillette Co.*, (4th Cir) 273 F.2d 936 (1959) wherein it is ruled that the plaintiff has a heavy burden of proof to upset the Patent Office finding of priority.

Since herein the junior party Cody et al. has not offered any new evidence, it is respectfully submitted that the trial court erred in overruling the Patent Office on the record.

Trial de novo under 35 USC 146 is limited to introduction of evidence not available at the time of taking testimony before the Patent Office.

The burden of the junior party is to bring his evidence forth at the time of the Patent Office proceedings in a contested case. It is established, as a matter of law, that in a proceeding under 35 USC 146 a party cannot withhold pertinent evidence at the time of an interference and, thereafter, use section 146 to produce the evidence in the District

Court, *Kirschke v. Lamar*, (DC WD Mo.) 300 P Supp 146 (1969).

As a matter of record, Cody et al. has admitted that known evidence was withheld below (p. 56a) and that the Cody et al. appeal was only taken to permit a more complete presentation of old evidence (p. 58a).

It has been ascertained that this Honorable Court can make a final ruling in the matters presented herein under various decisions. In this matter fully adjudicated in the U.S. Patent Office against a party who has an issued patent, the junior party Cody et al. has had ample opportunity at law to establish his rights. In the trial court below Cody et al. has elected to ask for summary judgment. This court, also, has the opportunity to grant judgment to Cody et al. if there is a valid claim. Thus, Cody et al. has had ample chance for his day in court.

However, the party Flymo et al. is in the position that time of the monopoly granted in his patent continues to run while this matter is being pursued in the courts. Thus, if Flymo et al. prevails, it is inequitable to reduce the patent grant period unnecessarily by a series of repeated attacks extending over many years.

As a matter of fact, the entry of Cody et al. claim has so clouded the title to the invention that the party Flymo et al. has been seriously damaged and has lost critical timing and the opportunity to enjoy the rights to the patent grant. This is in nature of an irreparable injury which continues to damage the patentee Flymo et al.

Thus, it is only equitable and proper to ask this Honorable Court to make a final decision on priority without remand for any purpose so that Flymo et al. will not be further damaged by the irreparable further loss of the rights of the patent grant during a critical time that would occur if the case is remanded below for any reason.

**The Decision of the Trial Court Is Based on Erroneous
Conclusions of Law and Determinations of Fact.**

The junior Party Cody et al. has not met the imposed burden of proving reduction to practice. As a matter of fact, no successfully operable machine was ever proven by Cody.

In the record of proofs in the interference proceeding the inventors Cody and Sites testified (Exh IV) that the machine relied upon to prove reduction to practice did not have deflectors or baffles (A 122 Cody Exh. IV, p. 335). Furthermore, (1) the machine did not have the necessary skirt (A 39 Sites Exh. IV, p. 378), (2) it was too heavy and underpowered (A 114 Cody Exh. III, p. 333; A 60 Sites, p. 382), (3) it did not cut at the cutter blade but more to the center (A 120 Cody Exh. IV, p. 334) and no cutter blade was shown sharpened at the center (A 98 Cody Exh. IV, p. 330), (4) it had a torque problem (A 40 Sites Exh. IV, p. 378), (5) the propellers were not efficient and gave blow-back and needed rings around them which were later added (A 196 Cody, p. 349) and (6) for a period of several years after the proofs, a search was made (A 197 Cody, Exh. IV, p. 349) for a workable combination of elements resulting in a large number of different variations (A 64 Sites Exh. IV, p. 383) and machines more like the one first conceived, which had a double wall housing to direct air out the rim areas, than the one relied upon for proof (A 220 Cody, Exh. IV, p. 353; A 36 Cody, p. 320).

No machine was operated at any time during the proofs.

The application of Cody et al., in which the patented Flymo et al. claims were copied, states that the baffles are necessary to hold the grass up while it is being cut and that the propeller, otherwise, blows the grass flat on the ground (Exh. II, p. 60) and this is also borne out in the inventors testimony (A 190 Cody Exh. IV, p. 347).

Thus, as a matter of fact, there was never an operable device demonstrated and proven that would establish a

reduction to practice and it was the burden of the junior party Cody et al. to prove such. Yet the trial court held that "The Cody machine cut grass satisfactorily", and "The machine . . . was capable of being applied in practical affairs and had an apparent industrial value." Compare this with the view of the inventors who testified that it "wasn't what we would want to put on the market" (A 46 Sites Exh. IV, p. 380) and "We were cutting more to the center and the machine had quite a bit of torque and we knew that we would have to correct both of these things." (A 92 Cody Exh. IV, p. 329; A 120 p. 334).

The record in the District Court hearing on May 9, 1969, shows also an admission that Cody et al. "stopped taking testimony when they testified it cut grass", (p. 56a) further showing that the junior party did not produce the necessary burden of proof to overcome the patented claims based upon an operable machine demonstrated to the Patent Office.

On the other hand, the patented Flymo et al. machine, which was demonstrated to the Patent Office and put into large scale production in the United States (Exh. V. p. 439), used a radial air impeller (not a propeller) which did not require baffles to operate, but which directed the air radially out around the rim of the housing beyond the end of the cutting blade and not downwardly through the path of the cutting blade to flatten the grass.

As a Matter of Law the Cody et al. Proofs Fell Short of a Reduction to Practice.

The law is firmly established that evidence must carry a thorough conviction to overcome a Patent Office ruling and that a reduction to practice must produce something of practical use, coupled with a knowledge, preferably by actual trial, that the thing will work practically for its intended purpose and, if it falls short of success, it is not a sufficient reduction to practice even if it may give rational hope for future fulfillment of the purpose at which it aims.

A further rule is established that when following an alleged reduction to practice, a party is dissatisfied with the results and departs from techniques that were used, the evidence negates success. *Radio Corporation of America v. Philco Corp.*, (DC NJ) 275 F. Supp 172 (1967).

Contrast this with the trial court findings that

(1) "Efficiency cannot be questioned."

(2) "The Cody machine cut grass satisfactorily under operating conditions although the width of the cut was not in relation to the length of the blade."

(3) "The fact that further experimentation and refinement was deemed necessary for the machine to reach its full potential is of no consequence."

Also, the trial court found that "Flymo's counts were not based upon the utility of Flymo's invention under any specified operating conditions of terrain, slope, type of grass or the like. Accordingly, it was not proper for the Board to reject the Cody claims merely because the Board apparently felt that Flymo's machine would work better than Cody's. Cody has the prior conception date . . .". As a matter of fact the Flymo counts were only patentable after proof of operation in the Patent Office. (Exh. I, p. 8, 15)

The status of the law is otherwise. For example, the Court of Customs and Patent Appeals in *Conner v. Joris*, (CCPA) 241 F.2d 944 (1957) clearly confirms many early decisions establishing the principle that practicability or utility pursuant to the intended purpose must be demonstrated under actual service conditions with sufficient clearness to render it reasonably certain that the subject matter will perform its intended function in actual service. The same court, which is expert in Patent Law matters, also establishes the test that the device (tire chains) must operate satisfactorily under normal working conditions

for a reasonable length of time, a condition not proven by Cody et al. *St. Pierre v. Harvey*, (CCPA) 233 F.2d 337 (1956).

Additionally, it was held in *Anderson v. Scinta* (CCPA) 372 F.2d 523 (1967) that an automobile wiper blade must have been advanced to a condition where it was capable of satisfactory operation by testing on a curved windshield rather than on a flat windshield and necessitating a full description of the structure of blade, time and exact nature of tests, and results obtained. It was not enough when deficiencies were present.

Also this case and a whole body of law shows that the prior conception date of Cody et al. under the circumstances involved without diligence is meaningless unless an earlier reduction to practice is proven. Cody et al. has never proven nor claimed diligence.

Another case, *Gaiser v. Lender* (CCPA) 253 F.2d 433 (1958) holds that an airplane windshield requires testing involving conditions simulating those of actual use to produce uniform heating for reasonable time.

It is clear, therefore, that the mere allegations of record to prove that the Cody et al. machine "cut grass" by oral testimony many years after the fact without establishing any time period, conditions simulating actual use, description of the cut grass or the way in which the machine glided over the ground on its air cushion without digging up the turf, etc., were not sufficient to prove a successful reduction to practice. Also the law is firmly established that the circuit court can give a final ruling on the priority of invention. Even if it had been proper for the trial court to make a ruling to overturn the expert administrative body on the record, it is shown the findings of the trial court are erroneous and should be overruled by this Honorable Court, resulting in a reversion of the award of priority to the senior party patentee Flymo et al.

**The Trial Court Position on *Elmore v. Schmitt*
(CCPA) 278 F. 2d 51 (1960).**

The trial court states "The Board's reliance on *Elmore v. Schmitt, supra* is misplaced. Without reviewing the facts of that case in detail, it is clear that the Court of Customs and Patent Appeals rejected the counts in interference because the invention had not been reduced to an actual demonstration such as encountered in its practical use but was supported solely on a basis of prediction founded on laboratory tests. The nub of the invention, in this instance, is a machine that cuts grass and Cody's machine cuts grass in actual fact."

In the first place, the "nub" of the invention is to cause a machine to be properly supported to run evenly over the grass on a cushion of air without wheels in such a manner that the grass is not blown away from the cutting blade. This is described as the objective in the Cody et al. application (Exh. II, p. 50). Flymo et al. established this by a demonstration after the issue was raised in the Patent Office (Exh. I, p. 8). The Cody et al. testimony by the inventors and their application show that the only possible performance that could be expected, with the structure relied upon to prove reduction to practice, would be with most of the grass flattened with the possibility that some grass might be cut near the center of the blade, while the machine could not be handled properly because of too much torque and the machine could not fly right because it was too heavy, underpowered and had an inefficient propeller with backwash, and needed a cloth skirt on the bottom.

In the second place, the *Elmore* case clearly establishes whether a laboratory test or otherwise is involved, that the "party seeking to prove actual reduction to practice must show that his invention worked as intended to work in its practical intended use". The facts of the case show that the tests were encouraging but did not show the "tests accurately reproduced the operating conditions which would

be encountered in *any practical use* of the invention and" "reduction to practice requires more than that . . . Experiments in the direction of the desired result are not such reduction, no matter how nearly they approximate that end. The work of the inventor must be finished, physically as well as mentally." This issue was fairly and squarely determined in two carefully considered opinions of the Board of Patent Interferences (Exh. III, pp. 118, 139).

Clearly the testimony produced by Cody et al. fails to meet this test whether in a laboratory room or outside using the grass as a laboratory. The *Elmore* case has been followed many times and its ruling of law is beyond question.

Therefore, the Board's reliance on the case is shown to be well founded in fact and in law and is not misplaced. Accordingly, the trial court appears to be in error on the finding that the "Board's reliance . . . is misplaced" without new evidence presented by Cody et al. to support the allegations, and thus, the trial court should be overruled.

The Flymo et al. Motions Need Be Decided if Priority Stands in Favor of Cody et al.

These motions, presented in the Patent Office, are not necessary to a decision and do not become pertinent as ancillary to priority unless an award is made to the junior party Cody et al. For this evident reason, the Patent Office Board of Patent Interferences failed to review the motions below and there has been no review of the hearing before the Examiner from which there is no basis for appeal in the Patent Office (Exh. III, p. 235) and who erred in law by relying on 35 USC 135 (Exh. III, p. 234). Now, the trial court erroneously refuses to consider these motions after reversing the Patent Office holding of priority and granting junior party Cody et al. priority, thus making them ancillary to priority. This puts in direct issue the question of patentability to the party Cody et al.

The Flymo motions relate to the rights of the party Cody et al. to make the counts of interference. These motions

may be moot as long as the award of priority is in favor of Flynn et al. However, if the priority award of the trial court to Cody et al. is sustained by this Honorable Court, then, it is shown as a matter of law that this court must review the motions to determine whether, in fact, the counts are patentable to Cody et al.

The rule is well established in actions under 35 USC 146 that the District Court cannot direct the issuance of a patent to the losing party in an interference unless the court finds that the claims involve invention, and that it becomes the duty of the Court of Appeals to consider the question.

Tidewater Patent Development Co., Inc. v. The Gillette Co. (4th Cir), *supra*.

The Supreme Court has set this rule in the leading cases *Hill v. Wooster*, 132 U.S. 693 (1889) and *Sanford v. Kepner*, 344 U.S. 13, (1952), and it is followed in this circuit, *Pure Oil Co. v. Socony-Vacuum Oil Co., Inc. et al.* (DC Cir) 212 F. 2d 454 (1954) and other circuits *Ellis-Foster Co., et al. v. Union Carbide and Carbon Corp.* (3rd Cir) 284 F.2d 917 (1960). The trial court ruling, in failing to consider the question of patentability to Cody et al. after granting an award of priority, is inconsistent with various district court decisions. *Sperry Rand Corp. et al. v. Bell Telephone Laboratories, Inc.* (DC SDNY) 171 F. Supp. 343 (1959), *Radio Corporation of America v. Philco Corp.* (DC EPa) 187 F Supp 940 (1960), *Howard Plastics, Inc. v. Traver Investments, Inc. et al.* (DC S Ill.) 138 USPQ 568.

Thus the following two grounds are presented for review and determination by this Court in the event it sustains the trial court award of priority to Cody et al.

Inoperability of Cody et al. Device Under 35 USC 112.

Under Patent Office interpretation, a claim under 35 USC 112 is incomplete if it omits essential elements, particularly if such are essential to novelty or operability, MPEP 706.03(f).

In the Cody et al. application in the Patent Office, where an airplane-type propeller blows downwardly against the ground, it is stated that the blast of air downwardly would flatten the grass and prevent the mower from functioning properly. This application describes the invention as one where suitable baffles are provided to re-position the grass in an upright condition for cutting by the blade. It states "Thus, the vacuum of the vortex and of the baffles 58 tends to lift the grass or vegetation which has been blown flat by the air blast . . ." (Exh. II, p. 59)

It is clear the Cody et al. machine is inoperable without the baffles. Therefore, on the basis of the Cody et al. disclosure used to copy claims from the Flymo patent, which discloses a different operating principle using a radial impeller that does not blow down on the grass but which directs air along the rim of the housing and therefore requires no air flow modifying aerodynamic baffles, the Cody et al. claims are inoperative under 35 USC 112 when they omit the necessary baffle structure.

Cody et al. had to remove the baffle limitation from his claims to copy claims from the Flymo et al. patent.

The *Radio Corporation of America v. Philco Corp.* (DC E Pa) case *supra*, clearly establishes that, in an action under 35 USC 146, the question of disclosure and the right of a party to make the counts should be considered and that it is ancillary to the determination of priority. Also *Sperry Rand Corp. v. Bell Telephone Laboratories, supra*, establishes that "inoperability is a proper issue as long as it is raised on motion in the Patent Office."

It is established that when an inventor copies a claim for interference purposes based upon a patent of another, he must be able to demonstrate clearly that the invention was covered in his application disclosure. *Steenstrup v. Morton* (DC Cir) 38 App. D.C. 343, 30 F.2d 867 (1929), *Hansgirk v. Kemmer* (CCPA) 102 F.2d 212, (1939), *Bendix Aviation Corp. v. Ooms* (DC Cir) 153 F.2d 125 (1946).

This matter is quite fully discussed at various parts of the record. (Exh. III, pp. 208ff)

Accordingly, it is shown that Cody et al., on the basis of law and fact, are not entitled to a patent on the ground of inoperability under the provisions of 35 USC 112 (Exh. V, p. 435) and a holding to that effect is respectfully requested.

Publication and Patent Bar to Cody et al. Under 35 USC 102(b).

As a matter of record Cody et al. had to revise their application to copy claims from the Flymo et al. patent at the late date of July 30, 1964 (Exh. II, p. 82). The Flymo et al. invention was patented (615,141) in Belgium March 30, 1962, and published in a Swedish magazine *Industriell Teknik* on November 1, 1962, (Exh. III, pp. 271ff). Both these publications are more than one year before Cody et al. made application for this particular invention in his pending case.

35 USC 102 (Exh. V, p. 434) defines the loss of the right to a patent when "(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

The principle that an applicant cannot enlarge his application to embrace for the first time an article in public use or published under 35 USC 102 has long been established and consistently followed. *Railway Co. v. Sayles*, 97 U.S. 554 (1877); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47 (1938); *Hazeltine Research Co. v. General Motors Corp.* (6th Cir) 170 F.2d 6 (1948); and *Chicago Pneumatic Tool Co. v. Hughes Tool Co.*, (10th Cir) 192 F.2d 620 (1951).

A recent decision in point *Package Devices, Inc. et al. v. Sun Ray Drug Co., et al.* (DC E Pa) 162 USPQ 400 (1969), (Exh. V, p. 421) holds that, under 35 USC 102(b),

the amendment date is the reference date for new matter added by amendment.

Thus, it is clear Cody et al. has no right to make these claims at the late date he did in view of patent and publication bars charged to his knowledge by 35 USC 102(b), and is estopped from having a patent issue therefor.

Accordingly, a decision is respectfully requested on the basis of the motions made by Flymo et al. that, if the trial court award of priority to Cody et al. is sustained, this Honorable Court, then, rule that the counts are not patentable to Cody et al. based upon an incomplete claim under 35 USC 112, and/or that Cody et al. is estopped from copying the counts more than one year after a patent and publication bar under 35 USC 102(b) and, therefore, is not entitled to a patent.

CONCLUSION

Holding of Priority for Flymo et al. Is in Order.

The senior party patentee Flymo et al. has established that the junior party Cody et al. has a heavy burden to upset a fully contested inter-party Patent Office decision in a District Court proceeding, but has relied, only, on the record without new evidence.

It is shown that the trial court, as a matter of law, must accept a Patent Office decision as a conclusive action of an executive department of the Government unless error is established by testimony which carries thorough conviction, and every reasonable doubt should be resolved against a reversal.

It is established that the determinations of fact and conclusions of law, upon which the trial court based a decision to overrule the Patent Office, are erroneous in various respects.

It is shown that the junior party as a matter of fact, by admission, voluntarily quit taking testimony and as a

matter of law is, therefore, precluded from establishing any further proofs available at the time of testimony. It is established, as a matter of circumstances, that it is inequitable to the parties to bear the burden of extensive time and expense of continuing litigation when the Honorable Court is empowered to make a final decision without remand for any purpose.

Accordingly, this Honorable Court is requested to make a final ruling on priority in favor of the senior party patentee Flymo et al., reversing the trial court, and sustaining the Patent Office, with instructions that the party Cody et al. cannot bring into the trial court any new testimony that was available at the time of making proofs below.

Counts Are Unpatentable to the Party Cody et al.

This question need only be considered in the event the trial court is sustained in reversing the Patent Office and an award of priority is granted Cody et al.

It has been established, as a matter of law, that this Honorable Court must review the questions of patentability raised by the party Flymo et al. as ancillary to priority if priority is granted to Cody et al.

It has been shown, as a matter of fact and law, that the counts copied from the Flymo et al. patent are unpatentable to Cody et al., as based upon an inoperative disclosure in the Cody et al. application, unless his counts contain the necessary aerodynamic baffle structure under provisions of 35 USC 112.

It has been shown, as a matter of fact and law, that the counts were copied from the Flymo et al. patent more than one year after Flymo et al. had patented and published the invention and, thereby, Cody et al. is precluded from getting a patent therefor under 35 USC 102(b).

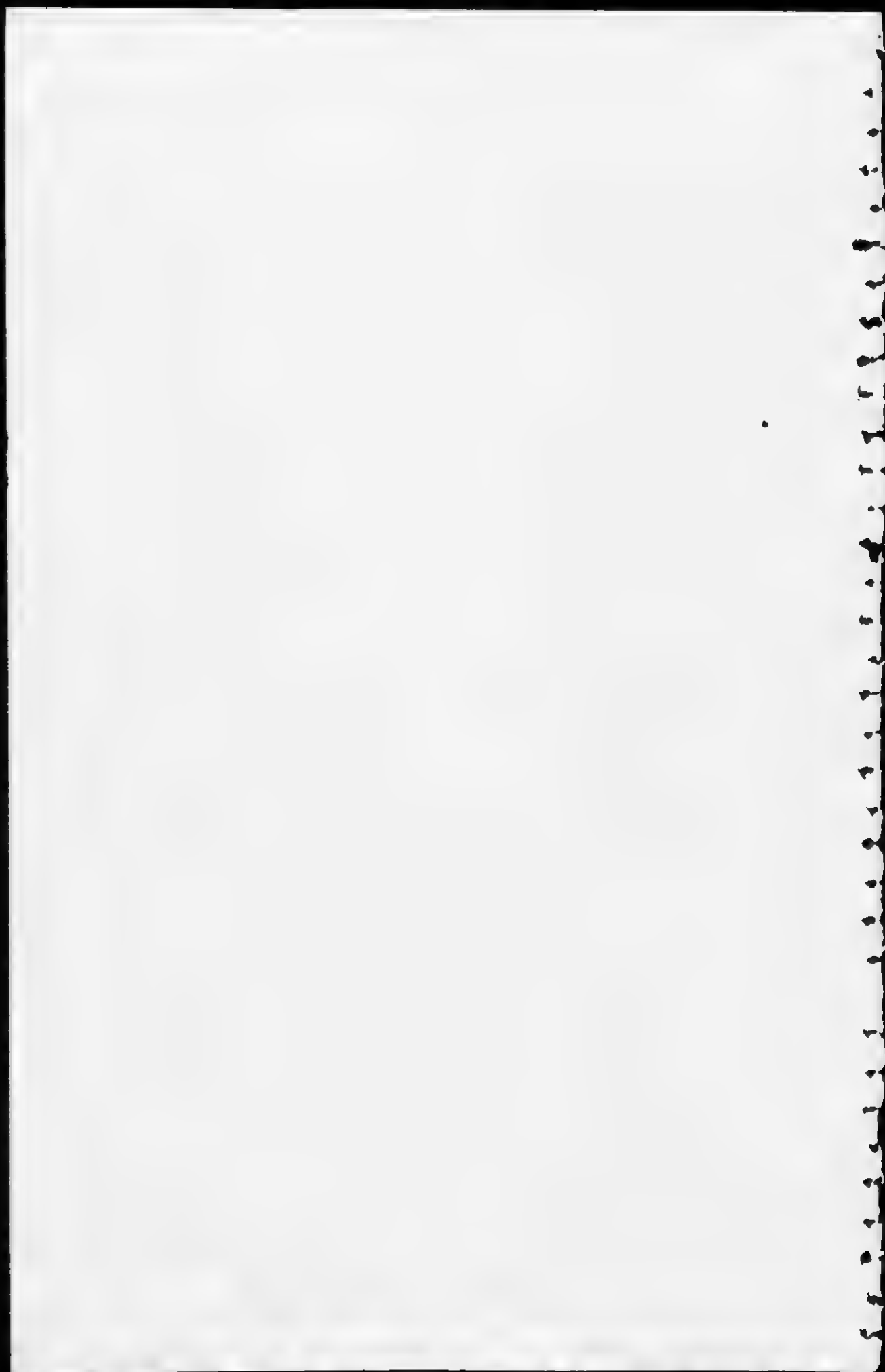
Accordingly, if this Honorable Court rules that Cody et al. is awarded priority on the basis that a reduction to practice was proven and the Patent Office decision was found, conclusively, to be in error, then, a ruling is requested that the counts are unpatentable to Cody et al. as based on inoperative and incomplete claims under 35 USC 112 and/or that Cody et al. is barred from obtaining a patent under the provisions of 35 USC 102(b).

LAURENCE R. BROWN
for Appellants

Of Counsel:

JOHN H. LEWIS, JR.
STEVENS, DAVIS, MILLER & MOSHER

APPENDIX



APPENDIX

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

CIVIL ACTION No. 1654-67

JOHN F. CODY ET AL., *Plaintiffs*

v.

AKTIEBOLAGET FLYMO ET AL., *Defendants*

Motion for Summary Judgment

COMES NOW the Plaintiffs in the above identified cause and pursuant to Rule 56, Federal Rules of Civil Procedure, hereby moves for summary judgment in favor of the Plaintiffs.

The grounds upon which this motion is based are as follows:

1. The undisputed facts, contained in the record transferred from the Patent Office, show that the Plaintiffs built a machine in 1960 which included the structure to support the counts in interference. This was found by the Board of Interference Examiners.

2. The machine built by Cody et al., which meets the counts in interference actually cut grass, cutting more toward the center of the machine. (Cody Q120, Sites Q40).

3. The satisfactory operation of the machine to cut grass was corroborated by three witnesses, Daniel Martin, John Neill, and James Howard Ageton.

4. The Defendants are limited to their effective filing date of 1961 under Title 35 United States Code, Section

104. Plaintiffs are therefore entitled to a judgment in their favor, as a matter of law.

Respectfully submitted,

GEORGE M. HOPKINS
George M. Hopkins
NEWTON, HOPKINS & ORMSBY
711 Candler Building
Atlanta, Georgia 30303

Of Counsel:

LAWRENCE L. COLBERT
National Press Building
Washington, D. C. 20004

**Memorandum in Support of Plaintiffs' Motion
for Summary Judgment**

THE FACTS

The Plaintiffs have brought this action as an appeal from a decision, dated March 23, 1967, of the Board of Interference Examiners in the United States Patent Office. The decision awarded priority of the counts of interference to the Defendants.

The Board of Appeals and the undisputed record before this Court shows that Cody et al., the Plaintiffs, built a machine which met the counts in the interference in 1960. The undisputed testimony also shows that the machine did in fact cut grass and cut more toward the center of the machine. This is corroborated by three independent witnesses, Daniel Martin, John Neill, and James Howard Age-ton. All of this evidence is uncontradicted.

The Defendants, on the other hand, are limited to their filing date because the invention was reduced to practice in a foreign country, 35 U.S.C. Sec. 104. Hence, the Defendants are limited in their proof to a filing date of their first foreign application, in 1961.

The sole issue presented by this motion for summary judgment is whether, as a matter of law, the Plaintiffs are entitled to a judgment since the Plaintiffs have proved, through a preponderance of evidence, that the machine reduced to practice in 1960 did "cut grass" and was acceptable for that purpose.

The Board of Interference Examiners held that due to further experimentation, the machine was not shown to operate "satisfactorily".

It is the position of the Plaintiffs that, regardless of how crudely the machine operated, nevertheless, it met the counts of interference which broadly called only for a "grass cutting machine", (Not a law mower or mowing machine).

ARGUMENT

The question of what constitutes reduction to practice of the invention has been the subject of many decisions; however, the preamble to a claim should control the amount of reduction to practice which is involved. In other words, a count for "a grass cutting machine" is met by a machine which satisfactorily cuts grass and is otherwise defined by the counts. The amount of grass that is cut and whether it cuts a wide swath or a narrow swath is immaterial.

In certain cases, where the devices are so simple in their construction that they show upon inspection that they are capable of performing the intended function, actual use is not necessary to establish the fact of reduction to practice. *Loomis v. Hauser*, 99 O.G. 1172; *Roe v. Hanson*, 99 O.G. 2550; *McDermott v. Hildreth*, 14 Gour. 88-17, (Nov., 1902); *Mason v. Hepburn*, 84 O.G. 147, 1898 CD 510; *Lindemeyer v. Hoffman et al.*, 95 O.G. 838, 1901 CD 353.

With respect to what constitutes appropriate testing to support a reduction to practice of the invention, there are two leading Supreme Court cases. The first is *Dolbear v.*

American Bell Tel. Co., 126 U.S. 1, 8 Sup. Ct. 778. In that case, the patent of Alexander Graham Bell was sustained wherein one claim read "the method of transmitting vocal or other sounds telegraphically" and the other claim said "the apparatus for transmitting vocal or other sounds telegraphically". The Court pointed out at page 782:

"The particular instrument which he had, and which he used in his experiments did not under the circumstances in which it was tried reproduce the words spoken so that they could be clearly understood; . . ."

However, the Court held this to be a reduction to practice.

The second case is *Hildreth v. Mastoras*, 257 U.S. 27, 42 Sup. Ct. 20. In this case the Court said:

"It is not necessary, in order to sustain a generic patent, to show that the device is a commercial success. The machine patented may be imperfect in its operation; but if it embodies the generic principal and works it is, if it actually and mechanically performs though only in a crude way, the important function by which it makes the substantial change claimed for it in the art, it is enough."

In the present situation the undisputed facts are that the machine of Cody et al. meets the terms of the claims or counts in interference and that the machine did and is capable of "cutting grass". It was therefore a grass cutting machine and did a quite substantial job of "cutting grass".

In *Herman v. Fullman*, 109 O.G. 1888, it was held that where a full size machine was made for making blueprints and it was testified that the machine did actually make a blueprint, that was sufficient to show a reduction to practice.

In *Laas et al. v. Scott et al.*, 161 F. 122, 126 (D Wis., 1908), it was held that in reducing an invention to practice

it is not necessary to prolong the test until its commercial value has been established, but if it accomplishes the end desired, it is a perfected invention although it may prove of little or no commercial value.

In *Pool v. Dunn*, 151 O.G. 450 (App. DC, 1909) it was held that it was not necessary in order to establish reduction to practice that the test of the device relied upon should be one of complete accuracy. It is seldom that an inventor reaches perfection on the first device constructed. The test should be to ascertain whether or not the device reasonably meets the requirements of the specifications, and, if it does not measure up to this test can it be made to meet it by the introduction of mere mechanical changes? If it can, it should be regarded as a reduction to practice.

In *Honner v. Stine*, 95 USPQ 373, the Board of Interference Examiners in 1952 held that the word "seal" does not necessarily require an hermetic or gas tight seal, and proof of the use of a pliofilm wrapper as a fluid-seal means for curing cheese was held sufficient to show a reduction to practice.

In *Lustig v. Legat*, 154 F.2d 680, 69 USPQ 345 (CCPA, 1946) it was held that a self-locking slider for a slide fastener was tested sufficiently to constitute a reduction to practice by pulling cross-ways on two tapes connected by the slider to determine whether the slider would lock. Here, numerous people have testified that the machine of Cody et al. was tested by causing it to cut grass. It is respectfully submitted that this is sufficient.

In *Howard v. Humphreys*, 97 F.2d 616, 38 USPQ 129, (CCPA, 1938), it was held that operating a small laboratory still was sufficient to constitute a reduction to practice of the methods count where the still was operated successfully.

All of these cases simply go to show that if a machine cuts grass and severs it satisfactorily, that is all that is

required to constitute a reduction to practice of a claim which calls for a "grass cutting machine". To the same effect, for example is *Adams and Ennis v. Stuller*, 94 F.2d 403, 36 USPQ 341, (CCPA, 1938) wherein the Court said:

"It is well established that, to constitute a successful reduction to practice of an invention, the device need not be perfect in its operation; but it is enough if it actually and mechanically performs, though in a crude way, the function for which it was designed."

Undoubtedly, the machine which was built by Cody et al. in 1960 did in fact function in more than a crude way to cut grass.

In *Hedenskoog v. Backus*, 48 F.2d 408, 8 USPQ 436, (CCPA, 1931) the Court held that a pen cutting machine constructed and operated to set one or two pens was a reduction to practice although it was never operated in a bowling alley and it was commercially unsatisfactory because it was too noisy in operation.

Of particular significance is the case of *Honda v. Brace*, 24 F.2d 446, 369 O.G. 731 (App. DC, 1928). The Court held that the counts in interference were not limited to magnets of any particular shape or configuration and, therefore, a reduction to practice was achieved though the pieces tested were not of a shape and dimension suitable for use as permanent magnets in instruments. This case also stands for the proposition that where, as here, the count is quite broad in its terminology, an equally broad testing would be involved.

In *Downs v. Andrews*, 25 F.2d 218, (App. DC, 1928) the Court of Appeals held that while reduction to practice requires that the invention be so tested that its efficacy and utility are demonstrated, it is not necessary that a practical embodiment of the idea of the invention should be mechanically perfect, since if the operative means accomplishes the desired end, reduction to practice is established although

the elements of the device should have been made stronger or given better shape, arrangement, or adjustment.

The undisputed facts presented from the record of the Patent Office in the present case is that Cody et al built the elements in operative relationship which are called for in the counts in interference and that these elements functioned in 1960 to cut grass and to cut it fairly well. Under the ruling in the *Downs* case, the award of priority should have been to the party Cody et al.

Nor does it matter whether the device was subsequently altered by Cody et al. In *Winkley v. Cogswell*, 19 F.2d 680, (App. DC, 1927), the Court held that it is well settled that a commercial test is not necessary to constitute a reduction to practice. A successful test of a machine although later altered for the purpose of causing the machine to respond to higher speeds and involving only mechanical skill, was a reduction to practice of the invention.

It is significant to note that the original machine is present for the Court to examine, even though it is partially dismantled. The parts are in evidence. In *Smith v. Brooks*, 112 O.G. 953, it was held that where the inventor and a witness skilled in the art testified that the operation of the machine was successful in 1896, and the machine in its present condition, although partly dismantled by the removal of parts, supports the allegation as to it, it was held that it must be regarded as a reduction to practice.

In *Michael v. Beach*, 353 O.G. 268 (App. DC, 1926), it was held that the evidence of the construction of a device responding to the terms of the claims together with the testimony of the inventor corroborated by one witness that the machine was tested at that time and was successful, is sufficient to establish reduction to practice.

Furthermore, the mere fact that the inventors attempted to improve the device which they had constructed and operated, does not prove that the device as first constructed

was not a reduction to practice; as in almost every art the pioneer invention is a crude affair. *Pierson v. Beck*, 40 F.2d 769, 5 USPQ 359, (CCPA, 1930).

Indeed, in *Gardner v. Zillger*, 102 F.2d 203, 40 USPQ 661 (CCPA, 1939), it was held that a television receiver which received an unclear image was a reduction to practice at that state in the development of the art. The Court further pointed out that the reception of a picture which could be distinguished as that of a person is about all that could have been expected. Here, the grass that was cut was over a relatively wide swath even though a "narrow swath" with respect to the entire blade.

In *Ericson et al. v. Jorgensen et al.*, 180 F.2d 180, 84 USPQ 176, (CA Eighth, 1950) it was held that in an interference the fact that the inventors were dissatisfied with the original device is not evidence of failure to reduce the invention to practice.

It is thus submitted that the Plaintiffs, Cody et al. built a machine in 1960 which performed sufficiently to reduce the invention to practice and to meet the counts in interference. This reduction to practice is corroborated by three independent witnesses. Also, the Defendants should be limited to their effective date of filing in 1961 under Title 35, United States Code, Section 104. And, under the circumstances, the Plaintiffs are therefore entitled to a judgment in their favor as a matter of law.

Respectfully submitted,

GEORGE M. HOPKINS
George M. Hopkins
711 Candler Building
Atlanta, Georgia 30303

Defendants' Opposition to the Plaintiffs' Motion for Summary Judgment and Motion for Summary Judgment in Favor of Defendant

Now come the Defendants in this cause, through Counsel, Pursuant to Local Civil Rule 9(b) and (h) opposing Plaintiffs' Motion for Summary Judgment and moving for a Summary Judgment in Favor of the Defendants under FRCP 56.

Plaintiffs in their Motion for Summary Judgment are required under Local Civil Rule 9(h) to state all material facts in genuine issue, and have put in issue only the claim that a machine was built purportedly to satisfy the requirement for a reduction to practice upon which Plaintiffs might be awarded priority.

The record from the United States Patent Office has been entered by Plaintiffs.

The counts of the Interference 94824 in issue are as follows:

Count 1. (Claim 2 of Defendants' Patent)

A grass cutting machine comprising a housing having a bottom opening, the peripheral edge of which is located substantially in a plane, a rotary air impeller mounted on a shaft in said housing, a rotary cutter mounted in said housing below said air impeller on the same shaft, and driving means for said rotary air impeller and said rotary cutter, said air impeller being constructed to expel air through said bottom opening along paths and at rates suitable for slightly elevating said housing and parts carried thereby from the ground by ground effect.

Count 2. (Claim 5 of Defendants' Patent)

A grass cutting machine comprising a hood having a top cover portion and a skirt portion, the latter being substantially shaped as a vertically disposed cylinder terminated at its bottom with a supporting rim, a motor attached

to said top cover portion, said motor having a vertical shaft extending into the space within said skirt portion, an air impeller mounted on said shaft, a rotary cutter mounted on said shaft below said air impeller, an air inlet opening disposed centrally of said top cover portion, said air impeller being constructed to suck in air through said air inlet opening and to expel air through the open bottom of said hood at a rate sufficient to slightly elevate the assembly of said hood, motor, air impeller and rotary cutter from the ground by ground effect.

Count 3. (Claim 12 of Defendants' Patent)

A wheelless grass cutting machine having a power operated rotary cutter and commonly driven air impelling means for producing ground effect to support said machine on a cushion of air at a distance above the ground.

I. Plaintiffs' Motion is opposed on the ground that there are issues of fact and law to be determined before any judgment can be made on the basis proposed by Plaintiffs, and therefore a Motion for Summary Judgment is immature and untimely.

II. Plaintiffs' Motion is opposed on the basis that the claim of Plaintiffs is based upon misstated facts interspersed with erroneous conclusions of law not supported by facts of record, and that no claim, proof or presentation is set forth upon which this Honorable Court may grant relief.

III. Now come Defendants and move for Summary Judgment in Favor of Defendants on the following grounds set forth in Defendants' Answer as Affirmative Defense grounds and supported by facts in the Record from the United States Patent Office:

—Defendants' Defense (6), (7)—

1. That Defendants' Patent 3110996 has been issued by the Commissioner of Patents, has been sustained in a favorable ruling by the Commissioner of Patents on a decision

of fact within the jurisdiction of the Commissioner of Patents, and therefore the Patent is presumed valid and rightfully issued under 35 USC 282 and is not subject to review without a showing of reversible error in the finding of facts by the Commissioner of Patents.

—Defendants' Affirmative Defense 2.—

2. That the Plaintiffs are the Junior Party in the Interference Proceeding below having been spurred on after Defendants' Patent had issued and Defendants' device was marketed and having copied claims of an issued Patent of Defendants and therefore have the burden of proof, and they have not sustained their burden of proof, and this burden of proof should be proof beyond reasonable doubt when Plaintiffs are spurred into Action to first claim the counts after Defendants patent has issued, and Plaintiffs have not even obtained a ruling below in their favor on the basis of preponderance of the evidence.

—Defendants' Affirmative Defense 3.—

3. That the Plaintiffs disclosed in their application a grass cutting machine operating on a different principle than Defendants' machine requiring certain deflector elements between a propellor and the cutting blade to prevent blowing the grass down, a device inoperable when the deflector elements are removed, and therefore Plaintiffs are estopped from copying the claims of Defendants' Patent on the basis of 35 USC 112 and Manual of Patent Examining Procedure MPEP 706.03(d), (f), which require disclosure of an operable device and claims defining elements essential to operability of the disclosed device, whereby Plaintiffs have eliminated from their claims an essential element of their device, namely the air deflector elements between the fan and the grass, without which their disclosure is inoperative.

—Defendants' Defense (S), Defendants' Affirmative
Defense 4, 5, 6, 10, 11—

4. That the Plaintiffs are estopped from copying claims from Defendants' Patent for the first time on July 30, 1964 under 35 USC 102(b), (c), more than one year after publication and patent bars identified in the record, namely, Exhibit A. Belgium Patent 615,141, granted March 30, 1962; Exhibit B. the Swedish publication, Industrial Teknik, Nov. 1, 1962; and Exhibit C, Final Report, ARF P-651 of the Outdoor Power Equipment Institute, March 11, 1963, and therefore have constructively abandoned any invention defined by the Interference Counts in issue, even if they had established a right on a further basis, by lack of action before a publication and patent statutory bar became effective on the invention copied from Defendants' Patent.

Respectfully submitted,

LAW OFFICES OF
LAURENCE R. BROWN

By
LAURENCE R. BROWN
Counsel for Defendants

**Memorandum in Support of Defendants' Opposition to the
Plaintiffs' Motion for Summary Judgment and in Support
of Defendants' Motion for Summary Judgment in Favor
of Defendants**

I. *Opposition to Plaintiffs' Motion for Summary Judgment*

Plaintiffs' motion is deficient under Local Civil Rule 9(h) in that there is no statement of the material facts to which a contention of no issue is made.

1. The first ground of opposition is that the Plaintiffs do not state all the genuine issues in this case, and a summary judgment cannot resolve the issues of the Affirmative Defense stated in Defendants' answer:

a. One such issue is the degree of proof that must be established by Plaintiffs in questions of priority, a matter to be resolved from survey of this Honorable Court of the record of the Plaintiffs and the determination whether Plaintiffs had in fact claimed the issues of the Counts before issue of Defendants' patent, since the state of the law establishes a burden beyond reasonable doubt before a Junior Party to an Interference can overcome a patented claim if he has not made that claim before the patent issued.

b. Other such issues of record in the Affirmative Defenses of Defendants' answer and supported by evidence in the Patent Office record entered in this case, are Defendants' defenses that Plaintiffs cannot make the counts under the provisions of 35 U.S.C. 112, 35 U.S.C. 102(a), (b), (c) and (f) and that Plaintiffs are estopped by abandonment and laches for lack of any timely claim to the invention defined by the Counts in the Interference before they were copied from the issued patent of Defendants, and that the Counts of the Interference are not patentable to the Plaintiffs (party Cody et al.).

Thus, it is respectfully submitted that Plaintiffs have not answered and overcome the defenses of Defendants and have come untimely and prematurely with their Motion for Summary Judgment without resolving issues that are pertinent to this case.

2. A further ground of opposition to the Motion for Summary Judgment by Plaintiffs is that the claim is based upon misstated facts interspersed with conclusions of law not based upon facts of record, and that no claim or proof or presentation is set forth upon which the Honorable Court may grant relief.

II. Background, Law and Facts Relating to Defendants' Opposition to Plaintiffs' Motion for Summary Judgment

1a. The Burden of Proof of the Junior Party Cody, et al. In the decision of the Board of Patent Interferences in the U.S. Patent Office a ruling was made that the burden of

proof of Cody et al is by a preponderance of the evidence. The decision is based upon the ground that the "Cody et al's application was filed prior to the issuance of the senior party's patent, and has a sufficient disclosure to support the patent claims copied by Cody et al. within one year after the issuance of this patent.—See Winkler v. Perkins et al., 44 CCPA 1005; 114 U.S.P.Q. 284; 1957 C.D. 385; 245 F(2d) 502 and Paivinen v. Sands, 52 CCPA 906; 812 O.G. 1313; 339 F(2d) 217; 144 U.S.P.Q. 1; 1965 C.D. 131."

It is urged that this portion of the decision of the U.S. Patent Office Board of Interference Examiners is in error for the following reasons:

No weight was given to the decisions cited below by Defendants. Pages 10, 11 and part of page 12 of the Brief for Dahlman are reproduced hereinafter for facility of reference:

"BURDEN BEYOND REASONABLE DOUBT FITS CODY ET AL. FACTS

"Dahlman therefore insists that the subject matter of these counts was first fairly claimed only after the patent of Dahlman had issued and therefore that the co-pendency of the applications is not the criterion upon which the degree of proof should rest, but the time that Cody et al. actually converted their case over to claim Dahlman's invention for the first time, which was after the issuance of the patent. Some representative decisions supporting the premise that a Junior Party is under burden of proof beyond reasonable doubt since he claims the contested invention first only after the patent issues are as follows:

"The right to copy claims must be with all doubts resolved against a Junior Party applicant, *Damaskus v. Hamann et al.*, 141 USPQ 923.

"In *Smith v. Burlew*, 1870 CD 41, the principle was established that 'when a party has made his applica-

tion and obtained his patent, it would seem that his priority in point of time should entitle him to some consideration as against later and less diligent competitors.—he is entitled to the benefit of the doubt.’

“*Hunter v. Jenkin*, 1891 CD 157, 56 OG 1705, specifically states,

‘**APPLICANT VERSUS PATENTEE**—When one of the contestants has a patent for the invention in dispute and the other is an applicant for a patent, the latter, in order to prevail, must present a case, both as to conception and as to reasonable diligence, which does not admit of a reasonable doubt. That is as it should be. The issue of a patent is an event that is deliberate, certain, and official in a high sense. It ought not to be lightly set aside. The courts have agreed that in all attacks upon it of this same general nature—i.e., on the ground of public use, prior use, abandonment, or prior invention—a case, in order to succeed, must be made out beyond a reasonable doubt.’

“*Williams v. Ogle*, 14 App. DC 195, 1899 CD 367 states that ‘*prima facie* evidence that the patentee is the first inventor of the device described in the patent and of its novelty; that *prima facie* effect can only be overcome and defeated by clear and indubitable evidence’.

“Possibly closer in point because of the relationship to ‘co-pending’ cases where doubts existed that the interfering subject matter had been amply conceived, disclosed, or claimed before the patent issued are the following:

“*MacFarren v. Morgan*, 1928 CD 189, 375 OG 209, requires that the operation must be similar and incidental disclosure is not enough. Thus, the necessity for baffles and air deflectors in Cody et al. to make it operative makes the broader claims not specifying

these necessary elements a different invention which is only incidentally shown but not operative in Cody et al.

“No rim in a single plane in the sense of the counts was ever disclosed or found operative by Cody et al. who relied upon a flexible fibre skirt. *Fausek v. Vincent*, 25 CCPA 770, 1938 CD 184, requires the copending case to have such essential elements referred to in the counts.

“In view of the record and evidence introduced by Dahlman during the motion period establishing a prima facie case, there is a burden upon the Junior Party to both show that there was no bar to making claims at a late date and that the invention was operable consistently in the scope of the counts without baffles or deflectors being a pertinent feature in operation (MPEP 706.03(n); 35 USC 112). *The Cody et al. machine could not have been made to operate successfully by those skilled in the art without including baffles or deflectors and therefore this is an essential feature that must be included in any claims made by Cody et al.* (MPEP 608.01(p))

“Even with a preponderance of evidence, not only must evidence overcome opposing evidence but it must overcome all presumptions in the opponent's favor. *Reise and Ceasar*, Section 465. Such presumptions would include the presumption of validity of an issued patent, *Smith v. Burlew*, 1870 CD 41 and the presumption that the Junior Party had been spurred into action by the activity of the Senior Party Dahlman in the field. The record shows publications by Dahlman before the filing of Cody et al. and the copying of claims directly from the Dahlman patent, facts which establish this presumption in favor of Dahlman.

“ANY DOUBTS MUST BE CONSTRUED AGAINST CODY ET AL.

“It is a settled principle of patent law that all doubts as to the right to make a claim or as to the proofs presented by the Junior Party must be resolved against the Junior Party. See the decision *Damaskus v. Haman et al.*, 141 USPQ 923 (cited by Cody et al.), *Jepson v. Coleman*, 136 USPQ 647, *Bierly v. Happoldt*, 96 USPQ 406, *Harrison v. Sternan* 149 USPQ 63, *Smith v. Burlew*, 1870 CD 41 or *Revise and Caesar*, *Interference Law and Practice*, Sections 464 and 467. The decision *Crome v. Morragh*, 112 USPQ 49 holds that it is not sufficient that a person following the disclosure might obtain the result set forth in the counts but that ‘it must inevitably happen’.

The decisions relied upon below in the ruling in question are distinguished as follows:

Winkler v. Perkins et al. required that a claim corresponding to the count had to be made within a year of the issuance of the patent “*if the disclosure in fact supports the count*” (italics added).

In the instance case it is clear that the Plaintiffs here, party Cody *et al.* could not make an operable and complete claim as required under 35 U.S.C. 112 because his mode of operation disclosed necessitated baffles in the air path to keep grass from being blown down, whereas Defendants’ mode of operation worked without baffles and there was no necessity to claim these on the part of Defendant. All the claims relevant to the complete mower combination as defined in the counts of the Interference appearing in the Cody *et al.* application before copying the claims from Defendants’ patent had the baffles included as a material part of the invention.

The Manual of Patent Examining Procedure Section 706.03(f) relating to 35 U.S.C. 112 is quoted here as pertinent:

"Incomplete

"A claim can be rejected as *incomplete* if it omits essential elements, steps or necessary structural co-operative relationship of elements, such omission amounting to a gap between elements, steps or necessary structural connections. Greater latitude is permissible with respect to the definition in a claim of matters not essential to novelty or operability than with respect to matters essential thereto."

It is clear the presence or absence of the baffles were clearly pertinent in this case to both the novelty and the operability and that the rules prescribed for operation within the Patent Office were not applied in the decision below.

Similarly the *Paivinen v. Sands* case relied upon below requires that *clear* support must be found in the junior interference party's disclosure for the counts to escape proof "beyond a reasonable doubt".

Nothing in the decision below rules that the *Cody et al.* disclosure is operative without the baffle, or shows that the Board of Interference Examiners made any decision relating to the 35 U.S.C. 112—MPEP 706.03(f) requirements in reaching their conclusion.

Thus reversible error below is indicated in this respect and a decision on these points is necessary here if it is found by this Court on any other grounds that Plaintiffs had a proper reduction to practice, particularly on the basis of the record in Defendant Dahlman's reply to Plaintiffs' request for reconsideration where it is stated that these grounds "were not reached by the Board because the holding against *Cody et al.* on the above mentioned grounds of lack of proof of reduction to practice made this unnecessary.—it being understood that Dahlman specifically retains the right to so comment later after further study if such comment should prove necessary or desirable."

1(b). The Board of Interference Examiners in essence made no decision "on the grounds (1) that the junior party's disclosure was not sufficient to support the breadth of the Counts, and, (2) that the Counts are unpatentable to the junior party." since they say the Examiner denied the motion (1) and (2) the junior party copied the Counts within one year from the issue as provided under 35 U.S.C. 135.

The Examiner below in his decision Paper No. 13, March 21, 1966, did not fairly make a decision but evaded the issues stating Cody "presented broad claims, such as claim 3, which did not require baffles, and the Counts in issue similarly do not require the specific use of baffles." No ruling was made on sufficiency of disclosure, it being held only that "the Counts are readable on the Cody *et al.* disclosure." Neither was a ruling made on (2) which was evaded by holding that the Counts were copied from the patent within the one year period.

At no time below has the Examiner of the Board of Interference Examiners considered the law and made a ruling on these issues. Thus reversible error is clearly set forth.

For ready references, the pertinent portion of the record pages 28-34 of the Brief for Dahlman in the record before this Court is reproduced here:

"A. Cody *et al.* Have No Right To Make the Counts

"This motion was presented by Dahlman by setting forth facts showing that the Cody *et al.* mower was inoperable without the baffle structure and therefore failed to comply with 35 USC 112 and MPEP 706.03 (d)(f) and that Cody *et al.* had no right to make Counts 1-3 without the definition of such feature necessary to make their structure operable.

"The Examiner in his decision obviously did not consider this position of Dahlman and merely states that 'Cody *et al.* have continuously presented broad

claims, such as Claim 3 which did not *require* baffles' (emphasis added) while concluding without reason and contrary to fact that baffles need not be defined in the claims, and without determining or ruling on the matter of necessity of certain elements to assure operability of the only embodiment disclosed by Cody et al., and furthermore without recognizing or acknowledging that Claim 3 is directed to the handle structure and jet assist guidance principle of Cody et al., a restricted and narrow aspect of the invention, rather than the broad concept of a mower not requiring baffles or deflectors.

"Dahlman's position here is significantly enhanced by the Cody et al. record where positive admissions were made that the device was in fact inoperable without baffles, etc. (Cody 120-122; Neill 26; Sites 40, 46, 56-59)

"Furthermore, it is clear that 35 USC 112 practice makes it mandatory to claim more than just something which can be read upon the disclosure as the Examiner reasons, but rather an operative device supported by the disclosure.

"Accordingly, a ruling is requested and should be made that Cody et al. have no right to make Dahlman's counts on this basis and in fact that Dahlman is the prior inventor of the first operative device not necessitating such baffles and air deflectors of the scope defined in Counts 1-3.

"Furthermore, it is clearly established under sound patent law principles that when to copy claims an applicant must rely upon inherent or incidentally shown features that all doubts must be resolved against the copier and that it is not sufficient that the disclosure *might* obtain the result set forth in the counts, *it must inevitably happen*. *Dreyfus et al. v. Sternan*, 149 USPQ 63.

"Note in this instance two modes of operation are required by the respective parties. Dahlman has a centrifugal blower which avoids blowing the grass by passing air in a path along the upper inside surface of the housing to generally radially pass out under the supporting rim located in a plane horizontal to the earth. However, Cody has disclosed only a vertical blower that blows air from a propeller directly downwardly onto the grass. This necessitates the use of baffles and air deflectors in the Cody device as disclosed in his patent application to make it operative in its only purpose of properly cutting grass. It is established in patent law that 'a party to an interference cannot rely upon an alleged inherent mode of operation of the device disclosed in his application, when the application clearly indicates that the party did not intend that his device should operate in that manner', *Minton et al v. Thomas*, 18 CCPA 1153; 9 USPQ 51.

"*Hansgirk v. Kemmer*, 26 CCPA 937, 40 USPQ 665 holds that the disclosure must be 'sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function' (emphasis added) as a basis for making a claim. Certainly Cody's principle of operation does not justify operability or natural flowing results at least until deflectors or baffles are included.

"B. Counts Are Not Patentable to the Party Cody et al.

"Based upon the provisions of 35 USC 102(b) reading 'A person shall be entitled to a patent unless— (b) the invention was patented or described in a printed publication in this or a foreign country,—more than one year prior to the date of the application for patent in the United States'. (emphasis added) Dahlman urges that the 'application for patent' for this invention defined in the counts was not made by Cody et al.

until Cody et al. actually copied the counts on July 30, 1964, more than one year after the Belgium patent, 615.141 of March 30, 1962, the Swedish publication, *Industriell Teknik* of November 1, 1962, and the *Final Report ARFP-651* distributed in the United States by the Outdoor Power Equipment Institute with the date of March 11, 1963, all of record.

"In defense of this position Cody et al. 'ducked the issue' and merely stated that they had copied the claims within one year of the issuance of the U.S. patent 3,110,996 of Dahlman. Again the Examiner erroneously refused to dissolve the interference by completely ignoring Dahlman's position and holding without reason or consideration of any of Dahlman's reasons, facts or law 'that there is no estoppel as argued by the party Dahlman because the counts in issue were copied from the patent within the one year period provided by Statute, 35 USC 135 (2nd paragraph).'

"This statute section is quoted as follows:

" '(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.'

"It is extremely bad law to permit to stand any decision holding that this statute permits one to copy a claim of a patent in spite of and *notwithstanding any other bar* that exists by operation of 35 USC 102, which is the interpretation given by the Examiner. This statute section 35 USC 135(b) is clearly and unequivocally intended only to exclude any person copying a claim more than one year after the issuance of the patent and surely only reiterates more definitely in the case of an interference that 35 USC 102 applies.

"Furthermore, this statute section 35 USC 135(b) emphasizes in support of Dahlman's position that 35 USC 102 is interpreted to mean the 'application for patent' is the act of making a claim in an application.

"In fact, *Kane v. Podlesak*, 1918 CD 207 cited by Dahlman restricts the principle of statute 35 USC 135(b) and points out Dahlman's position to the extent that the original publication (patent) is a bar when claims are copied from a patent. In the facts of this case, the original publication was the initial patent and the claims were copied from the reissue patent.

"There is no difference in principle that one should move promptly after constructive notice of knowledge as defined by 35 USC 102 and he is estopped whether the publication is a patent or otherwise. This is similarly stated in *De Ferranti v. Harmatta*, 1921 CD 226, with similar facts where the court held that an inventor is clearly estopped when he does not act within the period defined by the earliest patent (or publication).

"Dahlman's position is that there is no claiming of the instant invention defined by the counts in the Cody et al. application before he copied the claims, and the Cody et al. Claim 3 referred to by the Examiner as 'broad' defines a specific invention to an air supported mower limited to 'means for controlling the tilting of said housing body' with reference to the brace or handle affixed to the frame having two dispersed lever arms that are manually used to overcome the gyroscopic leveling action of the machine by tilting to force with jet action more air out of one side than the other in the hopes for propelling the machine.

"The Supreme Court decision, *Chapman et al. v. Wintroath*, 1920 CD 465, 252 U.S. 126 deals with such cases where an application may disclose but does not claim a conflicting invention and recognized this prin-

ciple of publication or patent bar effective before claims are presented, and carefully distinguished that 'There is no suggestion in the record that—the—application—was not prosecuted strictly as required by the statutes had the rules' before granting relief on other grounds. Another Supreme Court decision, *U.S. v. American Bell Telephone et al.*, 167 U.S. 224 also states that 'No court can disregard any statutory provisions in respect to these matters' when considering a patent case.

"Nowhere has it been found evident that any right to make claims supersedes and replaces the requirement of constructive estoppel defined by 35 USC 102 (RS 4886) and particularly not in the case of 35 USC 135(b) as held by the Examiner.

"Furthermore, the Supreme Court in *Chapman* (supra) carefully held: 'While not intending to intimate that there may not be abandonment which might bar an application within the two-year period allowed for filing—' and proceeded to hold that based upon the record no such information had been entered. This case is established as the precedent for the use of intervening statutory bars when claiming something not clearly claimed theretofore such as may be shown in an original case and first claimed in a divisional case and this concept should not be narrowly construed as stated in *Webster v. Splitdorf*, 264 U.S. 463.

"Thus, the position of Dahlman in this respect is sound, and it should be held, to avoid a standing decision of the Examiner of an unsound principle of law, that Cody et al. are estopped from making Dahlman's claims; since they did not assert the claims until more than one year after a patent had issued and descriptions of the invention were published.

"Here it is noted that Cody et al. had every opportunity that the constructive notice provision gives any

person to assert new matter in the form of claims of the scope and subject matter of the counts during pendency of their application and before a statutory bar under 35 USC 102, while Dahlman had filed a timely case without delay, laches, questions of estoppel, or any inference of being moved into action by another, which is in the interest of public policy as contrasted with the deliberate withholding action of Cody et al.

"A CCPA case somewhat in point, *Southgate v. Greene*, 13 USPQ 160 considered seriously the effect of a magazine article as a publication bar toward making counts but found as a matter of fact both that the 'claims had been continuous and he has been active in their pursuit' since before the publication and that the published disclosure was not a sufficient teaching. They also point out that an intervening public use or sale could have prevented copying the claims, which lends support to Dahlman's position.

"*Dwight et al v. Greenwalt*, 27 F(2d) 823 similarly reasoned that in divisional cases an intervening public use could bar any 'new matter' introduced. That Cody et al. introduced new matter on July 30, 1964, seems clear from the facts since he had concentrated his claims on a handle-tilt-jet directional control (Claim 3) and clear limitations to the necessary baffles in the air stream and had disclosed no concept of an operable device without the baffle structure. It is clear from the subsequent record that Cody et al. disclosed only an embodiment inoperable in the broader mode expressed by the counts as clearly established by positive testimony in their record as above noted. All of the applicable law seems clear in a requirement that clear and unequivocal disclosure and uninterrupted claiming is necessary in order to prevail over an intervening publication or patent.

"Clearly Cody et al. could not meet this test of overcoming the publication and bar imposed by 35

USC 102, and they should be held estopped by abandonment of their invention no matter if they had clearly proven priority otherwise without question on basis of fact, thus resulting in a holding and award of priority to Dahlman."

It is clearly evident that a ruling on these issues must be made also before a motion for Summary Judgment could be made for Plaintiffs.

2. Reference is made to Plaintiffs' Motion for Summary Judgment and Memorandum. Plaintiffs allege "undisputed facts" and the building of a machine "which included the structure to support the Counts in interference" to be found by the Board of Interference Examiners. Also they allege the "machine built by Cody et al., which meets the Counts in interference actually cut grass, cutting more toward the center of the machine" and the *satisfactory* "operation of the machine to cut grass was corroborated." Terms such as "indisputed record", "met the counts", "undisputed testimony", "evidence is uncontradicted" are used throughout to amount to conclusions of law not evidenced in the record rather than to be a fair statement of the facts and issues to be presented before this Honorable Court.

In order to have a basis for summary judgment, there should be only material facts asserted in good faith relating to a genuine issue, Local Civil Rule 9(h). It is not seen that any genuine issue based upon facts and evidence of record is presented by Plaintiffs upon which a decision can be made in favor of Plaintiffs.

The statements and conclusions of Plaintiffs are not admitted nor agreed with by Defendants, and in fact are controversial and questionable in many respects including those specifically referred to hereinafter.

In the proofs of record referenced by the junior party Plaintiffs, it is clear that the burden of proof required to

establish the right of Plaintiffs to overcome the presumption of validity of the Grant of Defendants' patent or to show reversible error in the proceedings below has not been established whether on the basis of a preponderance of evidence or a more extensive degree of proof.

Therefore it is respectfully submitted that there is not any basis upon which this Honorable Court can grant a Judgment to Plaintiffs.

The Plaintiffs' Motion, Ground 1 is deficient as a basis for Summary Judgment for many reasons including those hereinafter set forth.

The allegation that the facts are "undisputed" is questioned. In the Record Brief for Dahlman, pages 23 and 24 establish that there is a dispute of the facts that any machine built in 1960 by Plaintiffs included the necessary structure to support the Counts of the interference.

In the party Dahlman's (Defendants here) reply to the Plaintiffs request for reconsideration below it is quoted "the record does not support the fact that the machine built in 1960 was acceptable for the purpose intended and that from the record *there was no showing when and which parts were included in the machine* that resulted in satisfactory operation" (italics added).

There is certainly no substance in this ground for a summary judgment in favor of Plaintiffs, since the burden of proof of a junior party requires not that a machine be built, but that a machine so built must be successfully operated.

The Plaintiffs' Motion, Grounds 2 and 3 comes to conclusions of law not supported by the record since it alleges the machine cut grass by "satisfactory operation" and this was "corroborated" by three witnesses. If the junior party had operably used the machine as alleged it would have been a simple matter to demonstrate the machine at

the time of taking testimony. Instead they got relatives and others to give vague and questionable testimony many years after the fact after they knew what they wanted to establish. Even then the "satisfactory" aspects of the grass cutting was never established, nor corroborated, to meet the junior party's burden of proof. The inventors clearly testified the machine never worked satisfactorily. The Board of Interference Examiners established this in their decision found in the record on pages 4, 5 and 6 (Paper No. 23, March 23, 1967).

Plaintiffs make a conclusion of law not supported in the decision below or the record that they have proved a reduction to practice.

They allege that the requirement for proving a model works is not important and that even if it only cuts a little at the center, has too much torque to handle well and does not float properly (facts all clearly established in the record) it "satisfactorily" cuts grass.

This is not the status of Patent Law as defined in case decisions in point.

The Status of the Law on the Issue of What Constitutes Proof of a Reduction to Practice by a Junior Party.

Below excerpted are pertinent portions of cases relating closely to the issue stated in this heading and facts of record established by the junior party Plaintiffs.

Gaiser v. Linder, 253 F. 2d 433, 117 USPQ 209 CCPA 1958. Unless laboratory tests accurately duplicate flight conditions, there is a definite possibility that some factor not present in the laboratory may cause failure in actual use. * * * We agree with the board that the minimum testing required would involve conditions simulating those of actual use.

There is no corroboration of inventors' testimony that specific devices were so constructed as to conform to re-

quirements of counts; hence, orders for such devices afford no evidence that tests thereof amounted to reduction to practice.

Elmore v. Schmitt, 278 F. 2d 510, 125 USPQ 653 (CCPA 1960). It is a general rule that party seeking to prove actual reduction to practice must show that invention worked as intended to work in its practical contemplated use; sufficiency of laboratory tests to effect reduction to practice depends on circumstances of the particular case including, inter alia, simplicity or complexity of device and nature and character of tests; as well as conditions to which device is subjected in practical use.

Taylor v. Swingle, 136 F. 2d 914, 58 USPQ 468 (CCPA 1943). The tests in order to constitute reduction to practice should have been such as to establish utility beyond probability of failure admits of no argument. The question involved here is a technical one and we should not feel justified in reversing the board's holding upon the basis of mere argument.

Radio Corporation of America v. Philco Corporation, DCD New Jersey 265-64, July 11, 1967, 154 USPQ 570—275 F. Supp. 172. Reduction to practice must produce something of practical use, coupled with a knowledge, preferably by actual trial, that the thing will work practically for intended purpose, and if, as a matter of practice, a conception falls short of success, it is not a sufficient reduction to practice notwithstanding it may give rational hope of future fulfillment of purpose at which it aims.

Where, following alleged reduction to practice, party was dissatisfied with results and was forced to depart from techniques which it had been using, such evidence negates the alleged success.

Eastern Rotorcraft Corp. v. U.S., Court of Claims 14-65, Oct. 13, 1967, 155 USPQ 729, 384 F. 2d 429. Requires that testing be made under the intended environmental condi-

tions, and requires that the tests show the invention worked as intended in its contemplated use and is able to perform its intended purpose beyond a probability of failure.

Kirkham et al v. Arden et al, CCPA 6974, Apr. 25, 1963, 50 CCPA 1205, 137 USPQ 370, 316 F. 2d 242. Following tests of device, it was disassembled and abandoned; thereafter work was done on a different device; in absence of clarifying evidence, conclusion is inescapable that first device was not reduced to practice by tests sufficient to demonstrate practical utility.

Evidence must show reduction to practice of device meeting every limitation of count.

Walkup v. Greig, CCPA 7053, June 11, 1964, 51 CCPA —, 141 USPQ 777, 332 F. 2d 800. Testimony taken in 1961 as to success of 1950 experiments alleged to constitute reduction to practice is not entitled to same weight as statements made more nearly contemporaneously with experiments which indicate that there was serious doubt at that time that experiments demonstrated that device was practical.

Subsequent conduct with respect to invention is properly considered where there is doubt that activities relied upon constitute reduction to practice.

"In any event the activities subsequent to Carleton's experiments do nothing to relieve the serious doubt inherent in the record that such experiments satisfied Walkup on the others involved of the practicality of the subject matter here in issue".

Distinguishing Cases Relied Upon by Plaintiffs

The attempt by Plaintiffs to establish that a lawn mower, which has critical air flow paths necessitating critical baffles so that it does not blow down the grass while it provides a ground effect so that it flies without contact with the ground, while it cuts under moist and dry conditions, etc.,

is a simple device that does not require a showing of reduction to practice is so blatant a departure from reality that the proposition hardly needs an answer. The record below is replete with specific references by Plaintiffs as inventors that grass was blown down and the machine didn't fly properly and that torque was a problem so that it is an indisputable fact, this machine was not so simple that a showing of a reduction to practice was unnecessary.

Plaintiffs' attempt to relate generally and vaguely the requirements of a lawn mower operating on a new principle to excerpted statements of a few cases to try and show the test of reduction to practice can be met by an inoperative device. This cannot overcome the burden on the junior party Plaintiffs to establish clearly that the explicit and carefully considered decision below is in error, particularly when none of the cases were contested in Interference proceedings copying claims out of a patent for an operable machine.

Note for example the *Hildreth v. Mostoras* case requires the machine to *embody the generic principal and work*. Nowhere has Plaintiffs' burden of showing the machine flew properly off the ground without blowing down the grass been met, and the fact that incidentally some grass was cut at the center of the swath certainly does not amount to a proof of the generic principal of a ground effect machine that keeps the grass under the blades.

The relationship of making a blueprint in *Herman v. Fullmer* can hardly be compared with operating a flying lawnmower with a propellor directed downwardly at the grass to try to get enough flying power which also tends to blow the grass down to the ground rather than to sustain it suspended to let the rotary blade chop it off. The principle of the flying of the mower without flattening the grass was never established on the record by Plaintiffs as required for establishing their burden of proof. The end desired was not accomplished as required by Plaintiffs' reference to *Laas et al v. Scott et al*.

If Plaintiffs in the *Pool and Dun* citation are attempting to rely upon the fact that only slight mechanical changes would be necessary to make their device operable, the record shows otherwise. The inventors knew that correction was necessary but the record shows many unsuccessful experiments without proving one operable machine even at the time of testimony seven years later. (See Board Decision pp. 4-5.)

Any attempt in *Honner v. Stine* to relate the mower problems is not in point any more than the operation of a still in *Howard v. Humphreys*, or the magnetic structure of *Honda v. Brace*.

Lustig v. Legat requires a showing of a probability that the device proven will not fail, and the test data in this case was more severe than required in actual use as contrasted with the unsuccessful test less severe than in actual use of Plaintiffs on their flying effects and mower.

A test of a tire chain in *Adams and Ennis v. Stuller* is no fair comparison with a mower.

Mechanical perfection in *Downs v. Andrews* is not held necessary perhaps but a demonstration of efficacy and utility is required. Plaintiffs have not gone this far. Any attempt by Plaintiffs' brief to establish the grass was cut "fairly well" "acceptably" or "satisfactorily" is not supported by evidence in the record. Only at most is there a vague and not well defined oral statement by witnesses without written records that the grass was cut established by memory extending back over about seven years and it is presented without any explanation of the conditions, the structure used, the amount of grass cut, the type of grass, the flying and torque conditions, etc. and is accompanied by a clear denial by both inventor Plaintiffs that the machine did not work satisfactorily in the manner intended or expected.

Thus no error is established in the case below by Plaintiffs and they never at any time have sustained their burden of proof of overcoming as a Junior party the already patented counts for a machine operating successfully and in widespread commercial production in the United States.

Thus the Motion for Summary Judgment by Plaintiffs if it goes forward must be denied, and denial of Plaintiffs' claims is respectfully requested.

*Further Support of Defendants' Motion for
Summary Judgment.*

Support for Grounds 1, 2, 3 and 4 is set out in discussions hereinbefore because of the relevance to the premature timing of Plaintiffs' Motion for Summary Judgment before these genuine issues are decided.

In furtherance of the aforesaid discussions certain relative cases of law are emphasized hereinafter:

Relating to the Patent, Publication and Prior Public Use bars under 35 USC 102, the law now defines a statutory term of one year to replace the former two year period defined in the following case.

Chicago Pneumatic Tool Company v. Hughes Tool Company, Court of Appeals, Tenth Circuit No. 4153, Decided November 12, 1951, 91 USPQ 227, 192 F. 2d 620.

[5] An applicant for a patent cannot enlarge his pending application in such manner as to embrace and include for the first time the essential elements of an article, device, or structure which has been in public use more than two years. A patent obtained in that manner does not represent patentable invention. It is mere appropriation of the inventive skill of another. *Railway Co. v. Sayles*, 97 U.S. 554; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47 [39 USPQ 242]; *Hazeltine Research v. General Motors Corp.*, 170 F. 2d 6 [79 USPQ 201], certiorari denied, 336 U.S. 938 [81 USPQ 573].

The Issue Presented Here in View of the Holdings Below

A rule of law exists that an applicant cannot copy claims out of a patent more than one year after its issue. This is essentially a more definitive statement of 35 U.S.C. 102(b):

A person shall be entitled to a patent unless—

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,

wherein the ruling is extended to cover the addition of claims in an application that was filed before the bar, as in the case of a patent bar: *Winkler v. Perkins et al.*, CCPA, 1957, 114 USPQ 284.

In accordance with this principle the motion made in the Patent Office below is reproduced here for convenience and is reasserted.

II. MOTION THAT THE COUNTS ARE NOT PATENTABLE TO
THE PARTY CODY ET AL

It has been noted in fact that the first time the counts were asserted to cover the broad or generic aspects of the invention was in the amendment of July 10, 1964. Thus the party Cody et al is estopped from asserting such claims in view of publication and patent bars of one or more of the articles hereinafter presented, which are published more than one year before the assertion of the counts and therefore the effective application date, 35 USC 102 (b).

Reference A—Belgium patent 615,141 granted on March 30, 1968 to Karl R. Dahlman as based upon the common parent Swedish application 2027/1961 from

which the U. S. patent now in interference was derived. Copies of the cover sheet, the first page and the drawing of this patent are enclosed as *Exhibit A* for ready reference.

Reference B—The Swedish publication, *Industrial Teknik*, November 1, 1968 describing Dahlman's ground effect mower. Copies of the index sheet and article appearing on page 344 are enclosed as *Exhibit B* for ready reference.

Reference C—A publication distributed in the United States by the Outdoor Power Equipment Institute, March 11, 1963, as Final Report, ARF P-651. Copies of the cover sheet, and pages 43 and 44 disclosing an air cushion ground effects mower without baffles upon which the counts may be read are enclosed as *Exhibit C* for ready reference.

In each of these instances the publication was more than the one year statutory period before the counts were first asserted by Cody et al, and the subject matter was that identified with the scope of the invention defined in the counts rather than that being previously asserted by Cody et al.

Based upon these facts it is clear that the counts are not patentable to the party Cody et al but has been abandoned in favor of the public by untimely assertion of the subject matter constituting laches and estoppel to the party Cody et al. This is borne out by the status of prevailing law with cases relating thereto being noted hereinafter.

A leading case supporting this view is *Kane v. Podlesak*, 46 App. D. C. 11, 18 CD 207, wherein claims were copied by Kane from a reissue application of Podlesak, and it was held that Kane was estopped on the basis of the disclosure of the original patent which was published more than the statutory period (then two years) before the claims were copied.

Similarly claims were refused when copied when within the statutory period (one year) a claim was in the pending case fairly directed to the subject matter of the copied claims, and it was held that there must be continuity of assertion of such claims, and a cancelled claim would result in loss of continuity in *Ex parte Johnson*, 73 USPQ 270.

Thus the motion is brought for dissolving the interference on the basis of facts and well established law that rights to an invention must be asserted before a publication bar exists in order to prevent abandonment to the public. The case law cited establishes that claims copied for different matter than previously asserted are effective only at the date entered into the application. It is clear that Cody et al has no right to make the counts at this late date but is estopped and that therefore there is no interference in fact.

The ruling below denying this motion (Paper #13, March 21, 1966) is deemed to be reversible error, the basis of the holding being stated as follows:

"that Cody et al has continuously presented broad claims, such as Claim 3, which did not require baffles."

In the first instance, this Claim 3 was to a completely different invention than the concept of a ground effect mower per se. Rather it was directed to an improvement over a basic ground effect mower, a subcombination of the Cody et al device that was limited to an invention not defined in Defendants' patent and restricted to details of turning by jet action when a mower with a flexible skirt is tilted, a feature not in any way related to Dahlman's disclosure or the invention defined in the counts of interference.

In the second instance, the case was presented that Cody et al had no right to make the counts under 35 USC 112,

etc., because without the unclaimed baffles necessary therein to come between the propellor and ground in their mower, it would blow the grass down below the cutting blade and would be inoperative. The facts and law for this are set forth hereinbefore and a motion (I. Motion that Cody *et al* has no right to Make Counts) was made by Dahlman in the Patent Office. No decision was made of record below that the party Cody *et al* could or could not make the counts on the basis of 35 U.S.C. 112 and when brought before the Board of Interference Examiners they relied upon the Examiner's decision merely that the counts were "readable on the junior party's disclosure" without determining the effect of 35 U.S.C. 112.

Also, in the Second Ground, the Examiner merely stated "that the junior party copied the counts in issue from the Senior party's patent within the one year period provided by 35 U.S.C. 135", reproduced as follows:

"(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted."

It is clearly reversible error below to hold this statute permits a claim to be copied after a statutory bar where it serves only the purpose of defining the statutory bar of the patent itself, and does not grant permission to copy claims at any time during that year regardless of other statutory bars. See discussion hereinbefore set forth.

A Supreme Court case in point supporting Defendants' views is as follows, wherein the referenced cases therein such as *Railway Co. v. Sayles*, etc., are most pertinent:

Supreme Court of the United States

The Scriber-Schroth Company v. The Cleveland
Trust Company, Chrysler Corporation;

The Aberdeen Motor Supply Company v. Same;
 The F. E. Rowe Sales Company v. Same
 Nos. 3-5 Decided November 7, 1938, 39 USPQ 242, 305
 US 47

Patents—Amendments to application for patent—New
 matter: Construction of specification and claims—By
 specification and drawings—In general; Specifica-
 tion—Sufficiency of disclosure—In general—

Object of R.S. 4888 is to require patentee to describe
 his invention so others may construct and use it after
 expiration of patent and to inform public of limits of
 monopoly: patent monopoly does not extend beyond in-
 vention described and explained as statute requires; it
 cannot be enlarged by claims not supported by descrip-
 tion: application for patent cannot be broadened by
 amendment so as to embrace invention not described in
 application as filed, at least when adverse rights of
 public have intervened.

Patents—Amendments to application for patent—New
 matter; Prior adjudication—In general—

As filed, specification described webs as extremely
 rigid; after flexible webs became commercial and ap-
 plicant's assignee knew that H. patent claimed flexible
 webs, application was amended to state that webs were
 laterally flexible; drawings showed no dimensions; in
 interference with L., Court of Customs and Patent Ap-
 peals held amendments not to be new matter; that
 flexibility is inherent in metal suggests it was but skill
 of art and not invention; amendments were new matter;
 decision of Court of Customs and Patent Appeals is
 not controlling.

The Gulick application, which was filed November
 30, 1917, contained no reference in terms to laterally
 flexible webs or to the function of the webs in securing
 flexibility of the skirt. The specifications pointed to

no inadequacy in the structure or function of webs of the prior art which would be remedied by the webs specified and to no function to be performed by them other than as a means of connecting and holding head and skirt so as to maintain the air gap between them and to support the wrist pin bearings and their bosses as both were shown in Spillman and Mooers. On the contrary, Gulick's application described the webs as "extremely rigid" and stated that an object of the invention was "to rigidly support the piston pin bosses of a piston from the piston walls."

In 1922, after the Long piston, whose webs concededly were laterally flexible, was in commercial use, and Hartog, to the knowledge of Gulick's assignee, had specified and claimed a yieldable web, Gulick copied the Hartog claim—

The object of the statute is to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent and "to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not." *Permutit Co. v. Graver Corporation*, 284 U.S. 52, 60 (11 USPQ 118). *It follows that the patent monopoly does not extend beyond the invention described and explained as the statute requires.* *Permutit Co. v. Graver Corporation*, *supra*, at 57; *that it cannot be enlarged by claims in the patent not supported by the description*, *Snow v. Lake Shore Railway*, 121 U.S. 617; *cf. Smith v. Snow*, 294 U.S. 1 (24 USPQ 26); *and that the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened.* *Railway Co. v. Sayles*, 97 U.S. 554, 563, 564; *Powers-Kennedy Co. v. Concrete Co.*, 282 U.S.

175, 185-186 (7 USPQ 122); cf. Webster Electric Co. v. Splittdorf Electrical Co., 264 U.S. 463; Permutit Co. v. Graver Corporation, *supra*; Crown Cork & Seal Co. v. Gutmann Co., 304 U.S. 159 (37 USPQ 351).

Respondent earnestly argues,—that the changes in Gulick's application were not alternations in the description of his invention but were at most a permissible clarification of its description of the flexible web element which was present, or at least plainly suggested, in the specifications and drawings of the Gulick application.—

—If invention depends on emphasis of one quality over the other, as the court below found was the case with the laterally flexible webs in the Gulick device, the statute requires that emphasis to be revealed to the members of the public, who are entitled to know what invention is claimed. That is not accomplished either by naming a member having inherent antithetical properties or by ascribing to it one property when the other is meant.—

Gulick also failed to explain the principle of his machine so as to distinguish it from the prior art. Webs having the inherent properties both of rigidity and flexibility were familiar elements in piston structure. The court below, after pointing out that the slots of the Franquist skirt rendered it capable of limited constriction, found a distinguishing feature of Gulick's piston to be a web relatively flexible laterally, so as to accommodate the constriction of skirt to thermal expansion, the combination operating to secure a "balanced flexibility" of the skirt. But that principle-facilitating skirt constriction rather than obstructing it—was first explained and its embodiment in the flexible-webbed device was first claimed by the amendments to the application.—

We recognize the weight to be attached to the determinations in the interference proceedings in which the Court of Appeals of the District of Columbia and the Court of Customs and Patent Appeals sustained the Gulick amendments. Cf. *Radio Corporation v. Radio Laboratories*, 293 U.S. 1, 7 (21 USPQ 353). But the decisions in those cases are not controlling here.—

—We conclude that respondent can take no benefit from the flexible web element added by amendment to the Gulick application.—

Wherefore it is respectfully submitted that Defendants have established clearly the facts and law showing that Plaintiffs' Motion for Summary Judgment cannot be granted and that Plaintiffs have no right to the counts granted to Defendants, and therefore that the Motion for Summary Judgment proposed by Defendants in their favor may be granted in accordance with the applicable facts and laws.

Thus a holding for Defendants with a dismissal of this case is respectfully petitioned.

Respectfully submitted,

LAW OFFICES OF
LAURENCE R. BROWN

By _____
Laurence R. Brown
Counsel for Defendants

**Statement of Genuine Issues by Defendant in Opposition to
Motion by Plaintiff for Summary Judgment**

Now come Defendants in this case under Local Civil Rule 9h and Federal Rule 56(c) stating there are facts in which genuine issues are necessary to be litigated if the sole issue

stated by Plaintiffs "whether, as a matter of law, the Plaintiffs are entitled to a judgment since the Plaintiffs have proved, through a preponderance of evidence, that the machine reduced to practice in 1960 did 'cut grass' and was acceptable for that purpose," and thereby Defendants pray that the Summary Judgment proposed by Plaintiffs be denied.

BACKGROUND

This case is an appeal under 35 USC 146 from a decision of the Commissioner of Patents awarding priority to Defendants in a Contested Patent Interference proceeding.

Defendant filed an application in the U.S. Patent Office which was issued as Patent No. 3,110,996 on Nov. 19, 1963 and was thereafter cited against a pending application of Plaintiff, who modified his case, copied claims of the patent and asked for this interference.

Defendant was the Senior Party and the Burden of Proof to overcome Defendant has always been upon Plaintiff.

STATEMENT OF ISSUES

The hereinbefore stated quotation from Plaintiffs' memorandum summarizes the status of Plaintiffs' motion for summary judgment.

The Patent Office ruled below:

- (1) That the Plaintiffs were not entitled to a Judgment.
- (2) That the Plaintiffs did not prove by a preponderance of evidence a reduction to practice.
- (3) That the machine brought out in testimony did not satisfactorily cut grass and was not acceptable for that purpose.

Plaintiffs have not sustained any of their Burden of Proof in showing reversible error in the decisions on the facts below, and rely solely upon the record below.

Defendants object to the conclusions of law and fact proposed by Plaintiffs and disagree with the premises stated, and submit that a Summary Judgment is not proper under Federal Rule 56(c) while these genuine issues exist.

**Statement of Material Facts by Defendant in Support of
Defendants' Motion for Summary Judgment**

Now come Defendants with a Statement of Material Facts under provisions of Local Civil Rule 9h with a statement of the material facts that Defendant contends there is no genuine issue.

BACKGROUND

This case is an appeal under 35 USC 146 from a decision of the Commissioner of Patents awarding priority to Defendants in a Contested Patent Interference proceeding.

Defendant filed an application in the U.S. Patent Office which was issued as Patent No. 3,110,996 on Nov. 19, 1963 and was thereafter cited against a pending application of Plaintiff, who modified his case, copied claims of the patent and asked for this interference.

Defendant was the Senior Party and the Burden of Proof to overcome Defendant has always been upon Plaintiff.

Defendants have now moved for summary judgment on the grounds that Plaintiffs have not made a showing of reversible error in the rulings of The Commissioner of Patents against them and that Plaintiffs are estopped from copying the claims of Defendants' patent because of insufficient showing of structure in their application and they were spurred into action by Defendants' patent after statutory bars existed.

STATEMENT OF FACTS WHICH PRESENT NO GENUINE ISSUE

The hereinafter listed facts are submitted by Defendant as those in which there is no genuine issue:

1. Defendants' Patent 3,110,996 has been duly issued by the Commissioner of Patents.
2. Defendants' Patent 3,110,996 has been duly sustained by the Commissioner of Patents after an Interference Proceeding below.
3. Plaintiff is a Junior Party to the interference and therefore has the burden of proof.
4. That the Commissioner of Patents below on a finding of fact ruled that Plaintiff had not sustained his burden of proof in overcoming the senior party's patent.
5. That Plaintiffs first copied the claims in interference from the issued patent of Defendants.
6. That The Commissioner of Patents requires each and every claim in an issued patent to be for a different and distinct invention from any other patent or unpatented claim.
7. That Plaintiffs had not had the claims which they copied to institute the interference in their application before July 30, 1964.
8. That the structure of the Plaintiffs' mower as described in their application was different than that of Defendants' structure.
9. That Plaintiffs' application stated certain deflector blades were required between a blower device and the cutting blade to prevent grass from being blown down so that the cutting blade would not cut the grass properly.
10. That Defendants' mower operated on a different principle which did not require intervening deflector blades between the blower device and the cutting blade.
11. That Defendants' mower was commercially sold in the United States under the Brand name "Toro".

12. That Plaintiffs in their testimony taken to prove their right to Defendants' claims have never demonstrated any operable mower.

13. That the Plaintiffs Cody and Sites testified and put exhibits in the record showing that many modifications were made over a period of several years to change the structure and performance of the model alleged to be made before Defendants' effective filing date of March 16, 1961.

14. That more than one year before July 30, 1964, the date Plaintiffs first copied Defendants' patented claims, Belgium Patent 615,141 was granted, the Swedish Publication Industriell Teknik described Defendants' mower structure in substantially the same scope as their patent application disclosure, and Final Report ARFP-651 of the Outdoor Power Equipment Institute was published.

15. That the record below has been entered in this case by the Plaintiffs.

16. That the record contains the articles referred to in paragraph 14.

17. That the Commissioner of Patents below made no explicit and specific ruling referring to consideration of facts and arguments on the issue of operability of Plaintiffs' mower with the deflector blades removed.

18. That the Commissioner of Patents below made no explicit or specific ruling of law determining whether the provisions of 35 USC 135 (2nd paragraph) voids the provisions of 35 USC 103 and permits a Junior Party to copy claims from a patent within one year after issue even if statutory bars were present.

Plaintiffs' Response to Defendants' Opposition to Plaintiffs' Motion for Summary Judgment

Plaintiffs brought a motion for summary judgment based upon the record in the Patent Office. The entire record includes only testimony in behalf of the Plaintiffs and no testimony by Defendants.

The Defendants, in opposition to Plaintiffs' motion for summary judgment assert merely that there are affirmative defenses which are interposed by Defendants. There were no affidavits submitted to the Court by Defendants in support of their position.

Proper Case for Summary Judgment for Plaintiff

It is respectfully submitted that where, as here, the Defendants have submitted no affidavits, this Court can, as a matter of law, determine the Interference in favor of Plaintiffs.

There has been no proffer of proof as to any defense asserted by Defendants and, therefore, the affirmative defenses which Defendants advance are mere argumentative defenses. As is stated in Moore's Federal Practice, Vol. 6, § 56, page 2167:

"Summary judgment should be rendered even though an issue may be raised formally by pleadings, where the supporting affidavits and opposing affidavits, if any, show that there is no genuine issue of material fact.

"Stubborn reliance upon allegations and denials in the pleadings will not alone suffice, when faced with affidavits or other materials showing the absence of triable issues of material fact."

Section 56.11(3) of *Moore's* went on to state on page 2174 with respect to the party opposing the motion for summary judgment:

"But he may not hold back his evidence until trial, he must present sufficient materials to show that there is a triable issue."

In support of the proposition that the Defendant may not hold back his evidence until trial, *Moore's* cites *Ring Engineering Co. v. Otis Elevator Co.*, 179 F.2d 812 (CA. DC., 1950), and many other cases.

It is respectfully submitted that all in the world that Defendant is doing is to present a sham, on which no evidence is or can be produced.

As Justice Hutcheson so aptly put in *Whitaker v. Coleman*, 115 F.2d 305 (CA 5, 1940):

"* * * summary judgment procedure is not a catch-penny contrivance to take unwary litigants into its toils and deprive them of a trial, it is a liberal measure, liberally designed for arriving at the truth. Its purpose is not to cut litigants off from their right of trial by jury *if they really have evidence which they will offer on a trial*, it is to carefully test this out, in advance of trial, by inquiring and determining whether such evidence exists." (Emphasis added)

Also in the Fifth Circuit case of *Bruce Construction Corp. v. United States*, 242 F.2d 873, (CA 5, 1957) Judge Brown observed the following:

"... when a moveant makes out a convincing showing that genuine issues of fact are lacking, we require the advisory adequately demonstrate by receivable facts that a real, not formal controversy exists, and, of course, he does not do that by mere denial or holding back evidence."

It is evident that the facts in this matter are clear and unrefuted by any affidavits by Defendants. Under the circumstances, it is believed that the Court can now proceed to render summary judgment for the Plaintiffs. The argument of the Defendants in their voluminous brief is incoherent. Apparently, all that is argued is that, as a matter of law, the Plaintiffs are not entitled to a judgment in their favor. There was, however, no cross-appeal and no *answer* by the party now asserting ownership. In other words, the owner of the Dahlman patent is in default.

To place the Defendants' argument in some type of coherent fashion, the following appeared to have been argued by Defendants.

1. The device which Plaintiff built was inoperative. It is respectfully submitted that there was no affidavit from the Defendants that the device was inoperative and no testimony to that effect.

2. The Defendant also claims that the Plaintiffs are estopped from copying the claims because of the grant of a Belgium patent on March 30, 1962. This is purely a question of law and there is no affidavit to show the existence of a Belgium patent. The fact remains that the Plaintiffs, (as found by the Patent Office) consistently claimed the flying lawn mower and its elements. Therefore, Cody et al.'s claims date from the filing date of the application. A determination of estoppel along these lines is purely a question of law and no amount of evidence will vary the facts.

3. Lastly, the Defendants claim abandonment of the invention by the Plaintiffs. No affidavits showing abandonment have been introduced and hence, there is no factual support of this assertion.

Since both "the right to make the count" and whether or not there is support in the Cody application for the counts, have been thoroughly briefed for the Board of Appeals in the Patent Office, and the Board of Appeals held for Cody et al., in both instances, it is believed to be redundant to argue the matter at this point, except to submit to this Court the same brief which was submitted to the Board of Appeals. This Brief is attached hereto, marked Exhibit A. Unless clearly erroneous, the finding of fact of the Patent Office should not be disturbed.

Late Claiming

The case of *Wrikler v. Perkins and Bennett*, 245 F.2d 507, (CCPA, 1957) 114 USPQ 284, 44 CCPA 1005, 1957 C.D. 385, relied on by Defendants on page 2 of their brief,

should be noted. This case is directly in point, holding that it is immaterial when a claim is first asserted in an application, provided the disclosure supports the claim. Of course, it is the position of the Plaintiffs that they have been claiming essentially the same structure, as the counts in interference, throughout the prosecution of the Cody et al. application. A more detailed quotation from *Wrikler v. Perkins, supra*, is found on page 12 of Exhibit A.

Burden of Proof

As to the burden of proof which rests upon the party Cody et al., it is quite well settled that since Cody et al.'s application was filed prior to the issuance of the senior party's patent, and has a sufficient disclosure to support the patent claims copied by Cody et al., within one year after the issuance of this patent, Cody et al.'s burden of proof need only be by the preponderance of the evidence. Again, the case of *Wrikler v. Perkins et al.* supports this proposition. Also, the Court's attention is called to *Paivinen v. Sands*, 339 F.2d 217, (CCPA, 1965) 144 USPQ 1, 52 CCPA 906, 1965 C.D. 131.

The cases cited by the Defendants on page 3 of their brief for the proposition that the burden of proof is beyond a reasonable doubt are cases in which there was no co-pendency between the respective applications of the litigants.

Operability

As to the claim of inoperability, suffice it to state that all of the testimony presently before the Court and apparently all of the evidence which will be introduced in this case, shows clearly that the Defendants are in error when they contend that the Cody device will not operate without a baffle. This is not an issue, however, since Defendants do not contend that the disclosed structure in the Cody application is inoperative.

Again, the case of *Wrikler v. Perkins et al.*, *supra*, is in opposition to the party Dahlman's position. In that case, the following is stated:

"The law is well settled that once an applicant has selected language which is somewhat broader in its scope, he runs the risk that others with specifically different structures may be able to meet the language selected and he will not be allowed to urge later that the language which he selected should only be read in the light of his disclosure merely because it originated with him."

What Dahlman is doing is saying that while the machine of Cody et al. contains all of the elements set forth in the claims, operating in the same way with the same results, nevertheless, since Dahlman originated these claims with slightly different structure, the claims can only be read in light of Dahlman's disclosure and not in the light of the disclosure of Cody et al.

The differences between the disclosures of the two applications is that Dahlman uses a centrifugal blower with shields on the cutter blades and Cody et al. uses an impeller or propeller and a baffle to oppose the torque created by the impeller or propellers. In other words, the baffles of Dahlman are located on the blade and the baffles of Cody et al. are located on the housing. It is respectfully submitted therefore, that the criticism by the Defendants of the Cody device as to operability applies equally to the Dahlman device.

Priority

It is respectfully submitted that the sole issue before this court is a question of priority, in other words, which party conceived and reduced to practice the counts in interference first. All the other matters which have been raised by the Defendants relate to patentability of Plaintiff's application. These questions are nonancillary to the

question of priority and should not be reviewed by this Court.

In other words, the question of whether or not the Cody et al. disclosure is operative and whether or not Cody et al. has abandoned the application and whether or not Cody et al. can make the count are all *ex parte* matters which have been ruled on by the Patent Office. On appeal, these matters are not in issue. As is stated in *Glass v. Deroo et al.*, 239 F.2d 402, (CCPA, 1956) 112 USPQ 62, 44 CCPA 723:

"Appellant availed himself of the procedure under the Patent Office rules for attacking the patentability of the count without success. The statutes do not provide for any review by this court of rulings in the Patent Office that a claim is patentable. We consider patentability only in *ex parte* appeals from the decisions holding claims unpatentable.

"Our power of review in patent interferences is set forth in 35 U.C.S. 141 (sic) in the following words: " * * * a party to an interference dissatisfied with the decision of the Board of Patent Interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals. * * *"

Thus, priority is the item to be reviewed by this Court, not patentability.

Conclusion

In conclusion, it appears that what the Defendant is seeking in the way of a summary judgment and what the Plaintiffs are seeking in the way of summary judgment are two entirely different things. The Defendants wish the Court to decide factual matters based upon opinions expressed by the attorney for the Defendants, in opposition to testimony which refutes these opinions, namely the testimony in behalf of the party Cody et al., to the effect that

the Cody machine did work without the baffles, and in opposition to the facts of the case that the interference was provoked within one year of the issuance of the Dahlman patent.

On the other hand, the Plaintiffs are requesting summary judgment based upon a question of law. It does not seek to have a determination of fact changed with respect to the Patent Office decision. Instead, the Plaintiffs contend, as a matter of law, that when a claim such as the counts in interference call for a grass cutting machine and when it is proven that the Plaintiffs have built and operated a grass cutting machine, the mere fact that the machine did not cut a wide swath and required improvements, as a matter of law, should not operate to prevent an award of priority to Plaintiffs.

It is therefore respectfully submitted that while summary judgment should not be awarded to the Defendants, nevertheless, summary judgment can and should be awarded to the Plaintiffs.

Respectfully submitted,

GEORGE M. HOPKINS
711 Candler Building
Atlanta, Georgia 30303

Of Counsel:

LAWRENCE COLBERT, ESQUIRE
National Press Building
Washington, D. C. 20004

Hearing on Cross-Motions for Summary Judgment

[2]

PROCEEDINGS

The Clerk: John F. Cody, et al. v. Flymo, et al., 1654-67.

Mr. Hopkins: Ready for the Plaintiffs, Your Honor.

The Court: One of you were coming up from Georgia.

Mr. Hopkins: Yes, sir, and I got here. I appreciate the indulgence of the Court here. I didn't know whether I was going to arrive today or not. The automatic pilot got broken on the airplane and I understand these pilots can't fly nowadays without it.

The Court: Now, gentlemen, this is obviously a matter that the Court ought to take under advisement and study the papers with more care than the Court has been able to do up to this time. I only have a general familiarity with the problem. What would be most helpful to me would be an argument on both sides that pointed toward the key issues and tended to focus on what I have to have in mind when I look through the file.

Do you understand what I am saying to you? Rather than an extensive argument of all the authorities, I am anxious to be sure I understand the art and the precise issue as the claims read against the article or the machine, or whatever it is that is here.

Mr. Hopkins: If it please the Court, Your Honor, this is not an appeal on the question of patentability, as such.

[3] The Court: It is infringement, I gather.

Mr. Hopkins: No, sir, it is what is called an interference.

The Court: An interference. I understand that then.

Mr. Hopkins: I realize you get a lot of these cases from the Patent Office, but let me digress a minute, if I may, to explain what an interference is.

An interference is where two or more people or parties are claiming the same invention, and the Patent Office sets up this interference by suggesting to one party that they—

The Court: One fellow copies the other man's claims, he sets it up, and you are on your way.

Mr. Hopkins: Yes, but that wasn't the way this occurred. This occurred because the Patent Office issued a patent to Flymo—I will refer to them as Flymo, because I can pronounce that—and my client, Cody, et al., copied the claims from the patent.

The two patent applications were co-pending in the Patent Office. Title 35, Section 135 of the United States Code provides that a claim in a patent may be copied within one year's time, which we did. Then there was an interference set up, and the inventor of the patent, that is, Dahlman, is from Sweden, and under our laws, specifically Title 35, Section 104, he is precluded from proving a conception or reduction to practice in a foreign country.

[4] The Court: He is stuck with his date here.

Mr. Hopkins: He is stuck with his date here or an effective date that he may have.

Now, he had an earlier effective date because he had filed some foreign applications and had based his United States application on these foreign applications. So he is stuck with the date of 1961. I believe it is March or April, some time in there and he can't go behind that.

Now, all of our testimony which was taken in the Patent Office in behalf of Cody relates to activities in 1960, which was the year before the effective filing date, and if we could prove a conception and reduction to practice of the invention then we would win the counts in interference.

Now let me digress a minute and explain what the machine is that we are talking about. I think Your Honor may have some experience with these machines. They are lawn mowers.

The Court: The old-fashioned reel type?

Mr. Hopkins: No, sir, this is the rotary—

The Court: Rotary blade type.

Mr. Hopkins: —blade type. This is what I refer to as a flying lawn mower.

In other words, the counts in interference set out a housing—I am paraphrasing here; the counts stand for

themselves—a motor that sits on top, a shaft that projects down through the housing, and a blade, a long grass-cutting [5] blade that is at the end of the shaft and is rotated around.

Now the new part that is involved in this is a blower which is mounted above the grass-cutting—

The Court: Which blows the grass out to one side through a funnel in the housing.

Mr. Hopkins: It blows down and raises the entire housing up.

The Court: Oh, I see.

Mr. Hopkins: Sufficiently by what is called ground effect. You may have seen these various things that use the ground effect to travel only a short distance above the ground. And that is all in the world there is to it. It is a fairly simple invention.

Now our client has shown a regular propeller above the cutting blade, and has shown some baffles to counteract the torque, and has shown some additional small baffles to create a vacuum so that it picks up the grass a little bit.

The Court: That is what was reduced to practice when?

Mr. Hopkins: In 1960, is all of our testimony.

Now, we do not have exact dates as to when the baffles were put on there, but the claims do not call for baffles. The claims are broad enough to—as a matter of fact, they are extremely broad and call for just the two-blade arrangement and a housing.

The patentee Dahlman, Flymo, discloses a slightly [6] different structure from that of my client, and that is they show an impeller blade or a—

What would you call your type of blade?

Mr. Brown: It is a radial impeller.

Mr. Hopkins: A radial impeller that slings the air out radially and then it goes down on all sides. It is sort of like one of these centrifugal blowers which sucks the air in the middle and then throws it out. They have that baffled so as to direct the air outwardly and downwardly on the inside of the shell.

Now the testimony taken in behalf of the Party Cody is quite well documented, and I don't think there is any dispute here that the Party Cody built a machine corresponding to the counts in interference in 1960. We have cancelled checks, we have testimony of a man that built the shell, and invoices to show that the shell was built; and we have the testimony of several people that witnessed this machine being used.

Now the issue, and the reason we are the Plaintiff, and the reason we are appealing is that I stopped taking testimony when they testified that it cut grass. The claims are not to a law mower, as such, but to a grass-cutting machine. And the testimony shows that the machine in 1960 would cut a narrow swath, as opposed to a broader swath.

Aside from proof, we look at the commercial machine [7] of the Defendants and we find that he has got a small blade and a wide pan or housing, and so he cuts a relatively narrow swath, too. But that is not in proof.

The Court: What were the grounds of the Patent Office action?

Mr. Hopkins: The Patent Office gave the counts in interference to the senior party, on the basis that we had not proved satisfactory operation of the machine.

The Court: You mean that it was not commercially acceptable?

Mr. Hopkins: No, sir.

The Court: Or that it just wouldn't work?

Mr. Hopkins: No, sir.

The Court: What did they say?

Mr. Hopkins: On Page 4 of the decision, it says—I will start reading on the bottom of Page 3. It says:

“Junior Party Cody, et al. bases his claim for award of priority on the contended actual reduction to practice during the spring and fall of 1960. Three witnesses, Daniel Martin, John Neill and James Howard Ageton, have testified to having seen the machine built by Cody, et al. during 1960. We find their testimony to establish that the

machine built by Cody, et al. in 1960 included structure to support the counts. However, in [8] order to prove actual reduction to practice, it is not only necessary that the party prove that the constructed physical embodiment which is relied upon shows every feature of the invention as defined in the counts in interference, but also it must be proved that the machine operated in an acceptable manner for its intended purpose.

“The intended purpose of the invention here in issue is to cut grass. All of the above-named witnesses testified to the fact that the machine did cut grass. However, we do not find from the record that the results of the machine in 1960 were ‘acceptable.’ ”

Those are my quotations.

Now, I see you frowning, and I frowned, too, when I read the thing.

The Court: That must be some kind of vague, commercial standard that is implied in that. I don't mean by that that it has been sold but that it would operate in a manner that would permit the inference that it could be sold or could be used.

Mr. Hopkins: There is not a case—

The Court: I did not think the law ever said that.

Mr. Hopkins: There is not a case that I can find that says that.

[9] The Court: Now, you went on within the Patent Office. You had an Examiner's action, I take it, on this.

Mr. Hopkins: There was a three-man Board of Interference.

The Court: You went through the other steps in the Patent Office?

Mr. Hopkins: Sir?

The Court: Did you have more than one ruling within the Patent Office?

Mr. Hopkins: I asked for reconsideration of this and was refused.

The Court: But no further opinion or elucidation?

Mr. Hopkins: No, sir. Then I took an appeal to the District Court for the District of Columbia. I contemplated going to the Court of Customs and Patent Appeals, but since I could put on additional proof as to the fact that this machine was cutting grass all over—

The Court: Yes, that is why we get a lot of them.

Mr. Hopkins: —I came to you folks.

The Court: I understand that.

Mr. Hopkins: But their reasoning was that one of the inventors said they realized immediately that they could improve the way this machine worked, and set about to improve it, and that we don't have proof of precisely when those improvements were installed. That is contained on—

[10] The Court: So your basic position is that the standard applied by the Patent Office is not a proper legal standard, and that in any event, if it is a standard, putting aside the semantics, you met it by proving that you could cut grass.

Mr. Hopkins: Yes, sir, as a matter of law, I feel that the evidence shows that we have reduced the invention to practice.

The Court: That is the key issue.

Mr. Hopkins: Yes, sir. I have a few comments on some cases or would you rather—

The Court: Are those in the briefs?

Mr. Hopkins: No, sir, just looking through the law I found an old case in 1894.

The Court: Why don't you tell me about that when you come back with a little rebuttal after I hear from your opponent.

Mr. Hopkins: All right, sir.

Mr. Brown: Good morning, Judge. Laurence Brown, attorney for the defense, Dahlman, et al.

Your Honor, so you can understand it a little bit, I brought a scale model of the device. This lawn mower was properly described by my opponent, I think. The

essential thing here is that it uses no wheels. It drives on an air cushion.

[11] The Court: It really goes along on a cushion.

Mr. Brown: The problem of making this work is to get enough air downward to support the thing without blowing the grass down so that the blade doesn't cut the grass.

Now, this was developed in Sweden. It was shown in the Brussels European World's Fair and won a gold medal there.

It was filed in Sweden; it was published abroad. It was filed in Sweden in 1961 and I agree with the opponent, that is the earliest date we can establish outside this country.

The Court: Yes.

Mr. Brown: During 1961 and '62, there were various publications on these sorts of machines. In 1962, within the year of invention date allowed, we duly filed in the United States and the patent issued in 1963. This was cited against the opponent's case in the prosecution of his patent. And in 1964 he copied claims out of this patent.

Now let me tell you what I think is pertinent, a little bit of the differences between this machine of ours and the machine of the opponent.

The Court: Is that the portion of the Patent Office action that was read to the Court from Pages 3 and 4 which seems to be a finding by the office that Cody's structure is within the claims.

Mr. Brown: All right.

[12] The Court: As I listened to it, that is what it seemed to be saying.

Mr. Brown: Well, this was the holding of the Patent Office. There was some issue taken, of course, with this holding by defense. That is a matter of record. However, let me go back a little bit more to the Patent Office procedure.

When a claim is copied out of the patent by a junior party, the burden of proof is on the junior party.

The Court: Clearly. Particularly in this case. You had a patent issued in this case, with all the presumptions that carries.

Mr. Brown: So the burden of proof is on the junior party to establish enough proof to overcome the senior party's case.

The Court: I am clear on that.

Mr. Brown: The ruling in the Patent Office, as I understand it, is that he did not bear this burden of proof.

One of the problems of some of these mowers is the business of blowing the grass down so it doesn't appear beneath the blades, and this is where there is significant difference between this machine and the others. You may have seen this advertised in the United States. It was extensively marketed here under the Toro brand name.

The Court: I never read ads. I am disgusted with [13] them.

Mr. Brown: There were over 60,000 of these sold in the United States under the Toro brand name. This is a commercial operable device. The reason that ours works is because the radial impeller blows the air around the edges of the mower and, therefore, it does not blow the grass down so that it doesn't hit the blades.

Now the difference between this and the opponent's, he had an ordinary propeller that moved straight downwardly against the grass, and he had the problem of blowing the grass down so the blade wouldn't cut it. To solve this problem, he put in certain deflectors above the blade to give some sort of an effect that would hold the grass up temporarily so the blade could cut it off.

In the Patent Office, he was claiming his case with these deflectors in. Now this is pertinent because the claims that he copied out of our case do not include these deflectors. For the first time he claimed our invention—and let me explain to Your Honor—

The Court: I think I understand what you are saying. In other words, the deflectors, you would contend, are necessary to make his invention work.

Mr. Brown: Right.

The Court: And without them, his invention does not work.

[14] Mr. Brown: Right.

The Court: And that that is really what is being referred to in the portion that was read to me with respect to the insufficiency of the evidence.

Mr. Brown: Well, no, not exactly, sir. The insufficiency of the evidence I think goes to the proofs. They did not prove that this would cut grass on dry and wet ground and under various conditions. Taking the thing out in a field and saying, oh, it cut off a few blades, is not proof of the fact that this would work under all the conditions that the lawn mower is supposed to work.

The Court: Did your claim so specify that you could go up and down hill and around stones?

Mr. Brown: Your Honor, it is a matter of record in the Patent Office, before they would grant this patent, we had to make a demonstration of operability before the Examiner, which was done.

The Court: In the degree you suggested? I mean, over rough terrain, and all the others?

Mr. Brown: Over the Patent Office lawns. The Examiner and the staff were there witnessing this and they were satisfied that we had an operable device. He raised this objection of the blower blowing the grass down and that it did not cut over a full swath.

So the background here is ours was demonstrated before the Patent Office. At no time did the Plaintiff in this [15] case ever demonstrate a machine. He only relied on vague oral testimony as to many years back after he knew what he wanted to prove.

Now, the things that are pertinent about this, there are several laws. The Patent Office says every claim is a distinct invention.

The Court: Yes.

Mr. Brown: He had to make new claims over our distinct invention in order to set up this interference. The first time he did this was in 1964.

Now, 35 U.S.C. 102 statute bears on making a first claim to a patent more than one year after publication. This is one phase of the basis of our motion for summary judgment. So that there were publications out in the Patent Office.

Now, in the Patent Office they made a ruling that there was a permissive statute, 35 U.S.C. 135. I believe that says you may copy the claims in a patent at any time within a year after the patent is issued. And the Patent Office did not go to the trouble of going behind this and looking at our proofs to see whether the statutory bar in the interim would stop this. So there is a matter of comparison of 35 U.S.C. 102, which puts a patent bar on the case, and the permissive statute that permits you to copy the claims within one year.

Now, there is another aspect of the case. 35 U.S.C. 112 says claims can only be put into such form that it covers [16] an operable device. Now our premise is if his device is operable, it must include the baffles and, therefore, he is not entitled to make our claims because of the difference in construction, because if he does, it is not operable in his disclosure.

Now this is covered very nicely in the Supreme Court case, *Schriber v. Cleveland Trust*, which is of record as 305 U.S. 47.

So that basically our motions are the fact that even if he could by a preponderance of evidence introduce in this Court new proof and overcome our filing date, he is still barred and not entitled to get the patent for these claims for these reasons.

Thank you.

The Court: Now, Mr. Hopkins, what is this ancient case you discovered through the alert attention of one of your young men?

Mr. Hopkins: Your Honor, the Court of Appeals case in 1894, on a tobacco stemming machine, which is pretty close to what we—

The Court: What is your citation?

Mr. Hopkins: That is 3 App. D.C. 497, 1894, C.D.—that is Commissioners Decisions—384, 680 G, 279 O.G. The only one I assume you have is Appeals D.C.

The Court: 3 App. D.C. is all right with me. I can [17] work with that.

Mr. Hopkins: In that case that related to tobacco stemming machines and the device operated fairly well, but didn't take the stems out of some of the leaves, and the Court pointed out that these leaves could be thrown back in later.

The Court: What do you say about these deflectors?

Mr. Hopkins: Sir?

The Court: What do you say about these deflectors?

Mr. Hopkins: I say simply this: They have got deflectors as well as we have.

May I borrow the model?

Now, bear in mind, Your Honor, that they were careful not to put the blade on here.

The Court: I understood they were doing that so I could see clearly what it was like.

Mr. Hopkins: Here is their deflector right here that deflects the air out. They have deflectors; we have deflectors. Also, in our patent application, we have a description of the fact that when the propeller creates a down-draft, that it creates a vortex with a vacuum inside that swirls down and directed outwardly by centrifugal force, and there is a vacuum created inside which causes the blade of grass to be lifted up on the inside and blown down on the outside.

That was the reason our early machine was cutting a [18] narrow swath rather than the wide swath. Then we adapted the baffles later and we got a wider swath.

Now, that description is in the application and contrary to what my opponent has to say, we were claiming

essentially the same thing they were initially. And the Examiner rejected us; and after that we said, Well, these baffles are pretty important and we will put in some claims to the baffle.

There is a case of *Wrikler v. Perkins*, 245 F. 2d 507, which was cited in our brief, that says it doesn't matter what was being claimed. It is whether or not the claims which are in interference read on the structure disclosed in the specification.

There is no doubt about those claims reading on our structure. And the other cases hold that where one inventor claims an invention broadly, that he can't be heard to complain that because he claims it broadly enough others with distinctly different structures can make that claim. You can bet your bottom dollar they would be jumping on us for infringement if we hadn't been in interference with them.

There are two questions—

Excuse me, Your Honor.

The Court: Very well. I thought you had concluded. Go ahead.

Mr. Hopkins: There are two distinct questions [19] presented here. One is an attack on patentability—

The Court: Excuse me just a minute.

You may proceed.

Mr. Hopkins: Thank you.

—the attack on patentability made by Mr. Brown here, and the issue involved which is an issue of priority. Now that is the issue that is before the Court. A question of patentability is an ex parte matter which you take up with the Patent Office and the Patent Office determines whether or not this is patentable to you, whether you can make these claims, and everything. But the application will go back to the Patent Office for consideration of anything that they may have overlooked.

Now, the Defendants have raised this issue of patentability or operability initially in this case. Normally it is not present in interference proceedings because it is

not ancillary to the question of priority. Here perhaps it is.

The Court: Perhaps because of the unique nature, peculiar nature of the invention.

Mr. Hopkins: But my point is this: That here we brought a motion for summary judgment. They have said: This machine is inoperative. And they have produced no testimony whatsoever and there is a presumption that the machine is operable.

Now, they don't say that our machine with the baffles [20] is inoperative. What they are saying is that if you take the baffle off both of these machines, they won't work. The truth of the matter is that their machine without the baffles won't work and ours will. But be that as it may, tweedledum and tweedledee, the claims in a mechanical case can be as broad as the prior art permits you to make them.

I think it is entirely a moot question as to whether the baffles make it more operative or not. The testimony in the case shows clearly that without the baffles we were cutting a narrow swath, and this is a grass cutting machine. If I have a pair of scissors that I snip a blade of grass with, that is a grass cutting machine.

The Court: I understand your position on that. Both of you gentlemen have brought the matter into just the type of focus I wanted for purposes of decision and I imagine that many of these points are developed in your briefs and papers.

Off the record.

(Discussion off the record.)

The Court: I will study the file with care and these arguments have been very helpful.

Mr. Hopkins: There are a couple more points that I would like to make by way of rebuttal.

The Court: Briefly you may, sir.

Mr. Hopkins: Thank you, Your Honor.

[21] One is the fact that the Defendants are claiming they have got a patent, therefore, you can't touch it, or it is presumed to be valid, and that sort of thing.

Where the two applications were co-pending in the Patent Office, and one application issued to patent, which they will do if there is over three months difference in the filing dates, then there is no presumption that that patent was issued rightfully as against a co-pending application, and the burden of proof is on us only by preponderance of the evidence.

The Court: I am clear as to the latter point.

Mr. Hopkins: Sir?

The Court: I am clear as to your latter point. Is there not some difference and dispute as to your first point?

Mr. Brown: Yes, sir.

The Court: In the cases. My impression has been that there are some cases that have said what you have indicated to me but other cases that go quite to the contrary and say these presumptions run even against someone who had a co-pending application in the Patent Office. I don't believe that that law is crystal clear.

Mr. Hopkins: All right, sir. I will cite numerous cases to that effect, Your Honor.

Of course, we are still the junior party. We have still got the burden of proof.

[22] The Court: I understand that and I think the preponderance of the evidence is the test.

Mr. Hopkins: Where it is necessary to prove beyond a reasonable doubt your case is where you file an application after the issuance of the patent.

The Court: Yes.

Mr. Hopkins: I will cite numerous cases. There are numerous cases, and I don't know of any cases to the contrary, to tell you the truth.

The Court: The Court, recalling other patent matters, believes there are some cases the other way. Have you gentlemen covered that point in your papers?

Mr. Brown: Yes, Your Honor, I think that is adequately covered.

If I might say, just in connection with these last two points, the preponderance of evidence and the status of the patent, the presumption of validity in this case should not be in question because the opponent has had a chance below to adequately come in and contest this and there is a decision against him. I propose that the decision of the Commissioner of Patents against him at this point of the game is certainly a presumption of validity of this patent.

The Court: I understand what you are saying.

Mr. Hopkins: Those are the salient features that I wanted to cover, Your Honor. Thank you, sir.

[23] The Court: I will try to get at this as quickly as I can, gentlemen.

You are not in commercial production, are you?

Mr. Hopkins: It is hard for me to answer that question. I don't know as of the moment. There has been some movement toward that end. Also, Toro has a license from both these parties. They want to be on the safe side. They are the ones in commercial production. They wanted to find out who they were going to pay the royalties to. I hope they are going to pay them to us.

The Court: I gathered that was what the basic issue was.

Thank you very much, gentlemen.

Mr. Hopkins: Thank you, Your Honor.

(Whereupon the hearing on the motions was concluded.)

Memorandum Opinion

This matter comes before the Court on cross-motions for summary judgment. Plaintiffs (Cody) who are residents of various states sue residents of Sweden (Flymo) under 35 U.S.C. § 146 challenging a decision of the Board of Patent Interferences dated March 23, 1967. The Board

rejected the claims of Cody, the junior party, which had been set up in interference with a patent awarded Flymo.

The invention here relates to a wheelless grass cutting machine having a commonly driven rotary cutter and air impelling means. The air impelling means produces a fluid force against the ground to support the machine on a cushion of air at a distance above the ground during the cutting operation. The ultimate object of the invention is a grass cutting machine without wheels which is held off the grass by air pressure generated in such fashion that the machine remains in proper posture for cutting without the air pressure flattening the grass to a point that makes cutting impractical.

Flymo had a filing date of March 16, 1961, and could not go behind that date. Cody's claims were based on a structure developed in 1960. The Board found that the machine built by Cody in 1960 included structure to support the counts of the interference and showed every feature of the invention as defined in the counts. The Board, however, denied Cody's claims because Cody had failed to prove by a preponderance of the evidence that the Cody machine was "acceptable" or "satisfactory" in operation. On reconsideration by the Board this view of the proofs was stated somewhat differently. The Board indicated there had not been an actual reduction to practice which was explained in the following terms:

No doubt the tests in April of 1960 and at later unproven dates were of an encouraging nature and may have justified a prediction that the invention would probably be successful if and when it could be put to practical use. However reduction to practice requires more than that. What is required is not a mere basis for prediction but an actual demonstration. See *Elmore v. Schmidtt*, 47 CCPA 958; 757 O.G. 288; 278 F. 2d 510; 125 U.S.P.Q. 653; 1960 C.D. 296 (300). [P. 340]

These determinations are erroneous in law and fact. The type of wheelless grass cutting machine involved in the interference was potentially a basic development of considerable consequence in the absence of prior art. The central issue before the Board was whether Cody, the junior party with the earlier conception date, had a machine of practical efficacy and utility. *Callison v. Dean*, 70 F.2d 55 (10th Cir. 1934); *Burson v. Vogel*, 29 U.S. App. D.C. 388 (1907). Efficiency cannot be questioned. The Cody machine cut grass satisfactorily under operating conditions although the width of the cut was not in relation to the length of the blade at the optimum desired. The machine also had utility in that it was not a frivolous idea but was capable of being applied in practical affairs and had an apparent industrial value. The fact that further experimentation and refinement was deemed necessary for the machine to reach its full potential is of no consequence. The inventor was not proceeding on laboratory theory; there was actual physical practice because it was shown that the invention worked. The interference counts did not specify the width of cut and the validity of Cody's position is not destroyed by the inventor's recognition that improvements were desirable. *Hildreth v. Mastoras*, 257 U.S. 27 (1921).

The Board's reliance on *Elmore v. Schmitt*, *supra*, is misplaced. Without reviewing the facts of that case in detail, it is clear that the Court of Customs and Patent Appeals rejected the counts in interference because the invention had not been reduced to an actual demonstration such as encountered in its practical use but was supported solely on a basis of prediction founded on laboratory tests. The nub of the invention in this instance is a machine that cuts grass and Cody's machine cuts grass in actual fact. Flymo's counts were not based upon the utility of Flymo's invention under any specified operating conditions of terrain, slopes, type of grass or the like. Accordingly, it was not proper for the Board to reject the Cody

claims merely because the Board apparently felt that Flymo's machine would work better than Cody's. Cody has the prior conception date and his structure embodies all of the major elements of the claims in interference.

Other defenses are urged by Flymo challenging the rationale of the Board's decision but these were not developed in any detail before the Board. It is not for the Court in this proceeding to re-examine all aspects of the Board's decision but only to review the Board's ruling on the central issue of priority. Priority was clearly established and there was a sufficient reduction to practice as a matter of law.

Summary judgment will be granted for the plaintiffs and defendants' cross-motion for summary judgment is denied. The Board's determination is reversed and the matter is remanded to the Board for further proceedings consistent with this judgment.

Counsel shall submit an appropriate order.

(Signed) GERHARD A. GESELL
United States District Judge

June 19, 1969.

**Order Granting Plaintiffs' Motion for Summary Judgment and
Denying Defendants' Motion for Summary Judgment**

Cross motions for Summary Judgment having been regularly made by both Plaintiffs and Defendants herein on the grounds that there is no genuine issue of any material fact and that the respective parties are entitled to judgment as a matter of law; Now, on considering the Record of the Patent Office in Interference No. 94,824, and the briefs submitted herein and after hearing counsel for the respective parties and due deliberation having been had, and the decision of the Court herein having been filed, it is:

ORDERED, that Defendants' Motion for Summary Judgment be dismissed and that Judgment be entered herein in Plaintiffs' favor awarding priority of the Counts in Interference No. 94,824 in the United States Patent Office, to the Plaintiffs and reversing the decision of June 1, 1967, of the Board of Patent Interferences in Interference No. 94,824.

IT IS FURTHER ORDERED that this case be remanded to the Board of Patent Interferences in the Patent Office for further proceedings consistent with this judgment and that costs and disbursements be taxed by the Clerk, in favor of Plaintiffs and against Defendants.

Dated:

GERHARD A. GESELL
United States District Judge

[FILED July 18, 1969]

Order

Cross-motions for summary judgment having been regularly made by both plaintiffs and defendants herein on the grounds that there is no genuine issue of any material fact and that the respective parties are entitled to judgment as a matter of law; Now, on considering the record of the Patent Office in Interference No. 94,824, and the briefs submitted herein and after hearing counsel for the respective parties and due deliberation having been had, and the decision of the Court herein having been filed, it is

ORDERED, that plaintiffs' Motion for Summary Judgment be granted and that defendants' Cross-Motion for Summary Judgment be denied. The determination of the Board of Patent Interference on the issue of priority is

72a

reversed and the matter is remanded to the Board for further proceedings consistent with this judgment. No costs shall be assessed by either party.

(s) GERHARD A. GESELL
United States District Judge

July 18, 1969.

Notice of Appeal

Notice is hereby given that the Defendants named above hereby appeal to the United States Court of Appeals for the District of Columbia from the summary judgment order entered in this case action on the 18th day of July, 1969.

August 15, 1969

LAURENCE R. BROWN
800 National Press Building
Washington, D. C. 20004
Attorney for Defendants

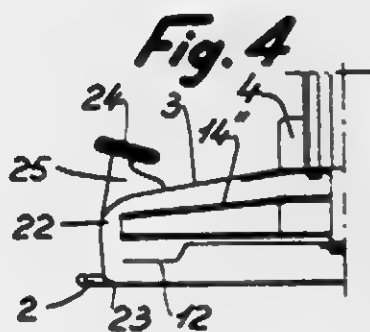
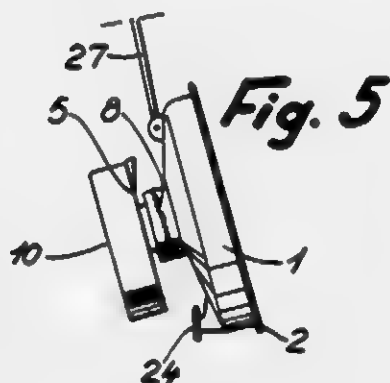
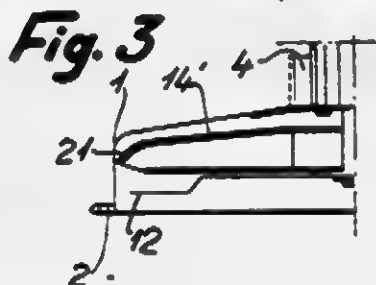
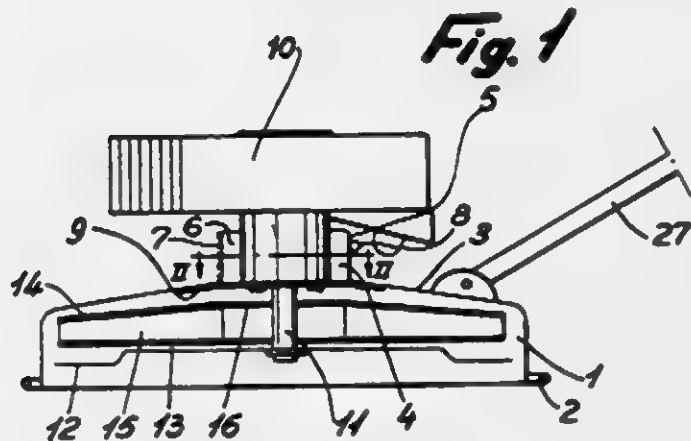
Nov. 19, 1963

73a
K. R. DAHLMAN

3,110,996

GRASS CUTTING MACHINES

Filed March 12, 1962



INVENTOR
Karl R. Dahlman
BY
Walter Cole, Attorneys
ATTORNEYS

United States Patent Office

3,110,996

Patented Nov. 19, 1963

1

3,110,996

GRASS CUTTING MACHINES

Karl Rudolf Dahlman, Malmö, Sweden, assignor to Aktieförbundet Flytt, Malmö, Sweden, a corporation of Sweden

Filed Mar. 12, 1962, Ser. No. 173,543

Claims priority, application Sweden Mar. 16, 1961

13 Claims. (Cl. 56-25.4)

This invention relates to a grass cutting machine of the type used as a lawn mower or a crop harvesting machine.

More particularly, the invention relates to a grass cutting machine of the type having a power operated cutter. Such grass cutting machines are usually constructed with a frame surrounding the operating area of the cutter and said frame being supported on rollers to keep the cutter at a suitable distance above the ground. The said frame and rollers are of considerable inconvenience in various respects. Thus, they form an obstacle to the cleanliness of cutting around trees and along walls, borders of a lawn etc. Moreover, the frame and rollers add considerably to the weight and manufacturing costs of the grass cutting machine. A further disadvantage is that the cutting result will depend very much on the smoothness of the ground. Also in the case of rugged or stony ground, it is difficult to control the movement of the grass cutting machine. It may be mentioned, also, that in the case of grass cutting machines in which the cutter is surrounded by an open bottomed hood, it is usually necessary to arrange the supporting rollers in such a manner as to keep the bottom edge of the hood at a considerable distance above the ground in order to prevent accidental bumping of the hood into the ground. It is therefore often felt necessary to provide protective screening means to prevent access to the interior of the hood under the bottom edge. Such screening means further add to the encumbrance, weight and manufacturing costs of the machine.

It is an object of the invention to provide a grass cutting machine in which the above mentioned drawbacks are eliminated or reduced.

According to the invention, in order to eliminate the necessity of supporting rollers or similar supporting structure, use is made of the so-called ground effect, i.e., the physical phenomenon that an object can be supported at a distance above the ground on a cushion of air produced by a flow of air generally directed towards the ground beneath the object. Thus, according to the invention, a grass cutting machine of the type referred to is provided with an impelling means to produce such a cushion of air under the machine.

Other features, objects and advantages of the invention will be apparent to those skilled in the art from the following detailed description of one embodiment thereof and various modifications and reference being made to the accompanying drawings in which:

FIG. 1 shows a grass cutting machine partly in section.

FIG. 2 is a section along the line II-II in FIG. 1.

FIG. 3 is a partial section through the hood and the ventilator wheel showing a somewhat modified construction of the latter.

FIG. 4 illustrates the provision of an auxiliary supporting roller on the top of the hood of the machine, and

FIG. 5 illustrates the transportation of the machine in tilted position with stationary motor.

In the drawing, 1 is a hood which is constructed substantially in the form of a short cylinder. At one end of the hood, the edge of the latter is bent outwards and rolled upon itself to form a supporting rim 2 surrounding the open bottom of the hood. At its other end, the hood comprises a slightly domed roof or cover portion 3. Cen-

2

trally of the cover portion 3 there is provided an opening 4, which is surrounded by an axial flange 5 forming an air inlet chamber. An air inlet opening 6 is provided along part of the circumference of the flange 5, said opening being covered by a protecting grid 7 which is held in position around the flange 5 by means of a spring 8. Two mutually parallel supporting bands 9 are mounted on the inner side of the cover portion 3 of the hood 1 in positions to extend across the opening 6, said supporting bands serving for the attachment of a motor 10 such as a gasoline operated engine. The shaft 11 of the motor 10 extends centrally into the hood 1 and carries a ventilating wheel and a cutter 12. According to FIGURE 1, the ventilating wheel or blower consists of two circular discs 13 and 14 having a plurality of substantially radially extending ventilator blades 15 mounted therebetween. Each of the ventilator blades 15 is wider at its end facing the shaft 11 than at its end remote therefrom. The upper circular disc 14 is provided with a central opening 16 for the intake of air.

FIGURES 3 and 4 show diametrical sections through two different forms of the ventilating wheel and the hood. In FIG. 3, the upper circular disc 14' is bent downwards at its periphery at 21, whereby a more powerful downward flow of air is obtained. In FIG. 4, the upper disc 14'' is slightly conical and the wall of the hood is constructed with a rounded portion 22 at the transition between the cover portion 3 and the cylindrical skirt portion extending downwards therefrom. Moreover, the bottom end of the hood is bent slightly inwards at 23 so that the mouth of the hood becomes somewhat restricted. In this manner the wall of the hood has a slight inward inclination along its inner edge and the flow of air discharged from the ventilator is deflected by the rounded portion 22 and the inclined wall portion of the hood towards the centre of the grass cutting machine, whereby the grass coming in under the flange 2 is automatically lifted so that the cutter 12 will cut more cleanly and efficiently.

FIG. 4 also illustrates the provision, on the top of the hood, of an inclined auxiliary supporting roller 24 which is mounted on the hood by means of a bracket 25. The supporting roller 24 is intended for facilitating the transportation of the grass cutting machine when its motor is stationary. The grass cutting machine is then tilted in such a manner that the whole of the machine is supported on the supporting roller 24, as illustrated in FIG. 5.

The hood is constructed with a handle bar 27 which is preferably connected to the portion of the hood diametrically opposite to the air intake opening 6 or 18 and the supporting roller 24.

In operation, when the motor of the grass cutting machine is started, a cushion of air is formed under the machine by the so-called ground effect, whereby the machine is supported on said air cushion at a small distance above the ground. The machine can easily be manoeuvred by means of the handle bar 27, and a certain stabilization in the lateral direction is obtained by the fact that the air intake is directed in the presumed principal direction of movement of the machine.

It will be seen that in the embodiment shown, the air effect is produced by means of a ventilator in the form of the centrifugal blower having distinct radial passages opening at a small distance from the peripheral wall of the hood, while the ends of the blades of the cutter, which form the principal cutting zone, are located substantially directly below the discharge openings of the passages. This fan is a radial discharge type blower as the conical-plate fan type described in FIGURE 6 of page 135 in the publication Engineers' Illustrated Thesaurus, published 1952 by Chemical Publishing Co., Inc., New York, N.Y.

3

It might be expected that the power required for the operation of the ventilator or air impelling means would necessitate the use of a bigger and heavier motor than in known machines of the type considered, but in practice it has been found that this is not at all so. On the contrary, it has been found that a machine according to the invention, when equipped with a motor of a certain size, has a cutting capacity at least equalling that of a known machine supported on rollers, when equipped with an identical motor.

It has also been found that with a grass cutting machine constructed as described, ground effect of an appreciable value will be produced even if part of the area of the bottom opening of the hood is at a considerable distance from the ground, e.g. when grass is to be cut along the edge of a lawn which is elevated relative to the surroundings, or when grass cutting is to be effected on a curved or irregular surface of the soil. The reason for this probably is that the radial passages of the blower will produce positive flows of air down along the cylindrical wall of the hood so that ground effect will be produced along such edge portions of the hood as are at a small distance from the ground.

The supporting roller 24 need not necessarily be provided, but on the contrary will usually be superfluous in the case of lawn-mowers for ordinary garden work, since these will be sufficiently light-weight for carrying by hand. For larger size machines, however, the supporting roller is of interest though other means may also be used for the transportation of the machine. E.g., the machine may be constructed with a special carrying handle for transportation by one or two persons.

It will be understood that it is an advantage of the grass cutting machine according to the invention that no supporting means have to be provided outside the hood of the machine so that the machine may be run closer to trees and other obstacles than machines constructed with such supporting means. Moreover, special screens or other safety arrangements to prevent access to the interior of the hood under the bottom edge thereof are superfluous because in operation the edge will only be lifted slightly from the ground. For the same reason there is no danger of stones being hurled out from under the machine so that no safety measures have to be taken to safeguard against accidents arising therefrom.

The grass tops cut off by means of the blades will be blown out from under the machine by the same flow of air as that producing the ground effect, and will therefore be uniformly spread over a large area and will not collect in heaps necessitating raking of a lawn after it has been mowed.

Additional advantages of the new grass cutting machine are its simplicity of construction permitting the machine to be manufactured at low cost, as well as the reduced encumbrance of the machine for a certain cutting capacity, its low weight and its ease of operation.

I claim:

1. A grass cutting machine comprising a housing having a bottom opening, the peripheral edge of which is located substantially in a plane, a cutter mounted in said housing, driving means for said cutter, and a radial discharge type fan driven by said means for producing a flow of air radially to strike the housing and flowing out through said bottom opening therefrom along the peripheral edge at rates suitable for keeping said peripheral edge at a small distance above the ground by ground effect.

2. A grass cutting machine comprising a housing having a bottom opening, the peripheral edge of which is located substantially in a plane, a rotary air impeller mounted on a shaft in said housing, a rotary cutter mounted in said housing below said air impeller on the same shaft, and driving means for said rotary air impeller and said rotary cutter, said air impeller being constructed to expel air through said bottom opening along paths and

4

at rates suitable for slightly elevating said housing and parts carried thereby from the ground by ground effect.

3. A grass cutting machine as in claim 2, in which said impeller is constructed to discharge into a zone in said housing located above said cutter and substantially radially outside the operating area thereof.

4. A grass cutting machine comprising a housing having a substantially vertical cylindrical wall defining a cylindrical compartment within said housing and terminated at its bottom with a substantially circular edge, a centrifugal blower mounted substantially co-axially in said cylindrical compartment and constructed with radial passages having their outlet ends located at a small distance from said cylindrical wall, a rotary cutter mounted in said cylindrical compartment below and co-axially with said blower, common driving means for said centrifugal blower and said rotary cutter, said rotary cutter being constructed with blades having their ends located at a small distance from said cylindrical wall, said centrifugal blower being constructed to discharge air at a rate sufficient for slightly elevating said housing and parts carried thereby from the ground by ground effect.

5. A grass cutting machine comprising a hood having a top cover portion and a skirt portion, the latter being substantially shaped as a vertically disposed cylinder terminated at its bottom with a supporting rim, a motor attached to said top cover portion, said motor having a vertical shaft extending into the space within said skirt portion, an air impeller mounted on said shaft, a rotary cutter mounted on said shaft below said air impeller, an air inlet opening disposed centrally of said top cover portion, said air impeller being constructed to suck in air through said air inlet opening and to expel air through the open bottom of said hood at a rate sufficient to slightly elevate the assembly of said hood, motor, air impeller and rotary cutter from the ground by ground effect.

6. A grass cutting machine comprising a hood having a top cover portion and a skirt portion, the latter being terminated at its bottom with a supporting rim, a rotary radial discharge type fan air impeller mounted in said hood, a rotary cutter mounted in said hood below said air impeller, means for driving said rotary air impeller and said rotary cutter, an air inlet on the top of said top cover and connecting with a central opening thereof, said air inlet having a laterally disposed air intake opening, said air impeller being constructed to suck in air through said air inlet to discharge the air radially against said skirt portion and to expel air through the open bottom of said hood at a rate sufficient to slightly elevate the assembly of said hood, driving means, air impeller and rotary cutter from the ground by ground effect.

7. A grass cutting machine as in claim 6 comprising a protecting grid to cover said lateral air intake opening.

8. A grass cutting machine comprising a hood having a top cover portion and a skirt portion, the latter being terminated at its bottom with a supporting rim, a rotary air impeller mounted in said hood, a rotary cutter mounted in said hood below said rotary air impeller, driving means for said rotary air impeller and said rotary cutter, a radially disposed inlet passage provided outside said top cover and connecting with a centrally disposed opening thereof, said radially disposed passage having an intake opening at the end thereof remote from said opening of the cover portion, said rotary air impeller being arranged to suck in air through said passage and said opening of the cover portion and to expel air through the open bottom of said hood at a rate sufficient to slightly elevate the assembly of said hood, driving means, air impeller and rotary cutter from the ground by ground effect.

9. A grass cutting machine as in claim 8 comprising a protecting grid to cover said air intake opening.

10. A grass cutting machine as in claim 1 comprising a handle bar pivoted to said housing for pivoting about a substantially horizontal axis.

11. A grass cutting machine as in claim 1 and further

5

comprising an auxiliary supporting wheel mounted on the top of said housing and having its axis directed at an angle to permit said housing to be supported on said roller in a tilted position for transportation.

12. A wheelless grass cutting machine having a power operated rotary cutter and commonly driven air impelling means for producing ground effect to support said machine on a cushion of air at a distance above the ground.

13. A grass cutting machine comprising a hood having a top cover portion and a skirt portion, the latter being terminated at its bottom with a smooth supporting rim located in a plane and being of a cross-sectional shape suitable for sliding on the ground, a radial discharge type

6

blower mounted in said hood on a shaft perpendicular to the plane of said rim, a rotary cutter mounted on said shaft below said blower, and a driving motor for said shaft.

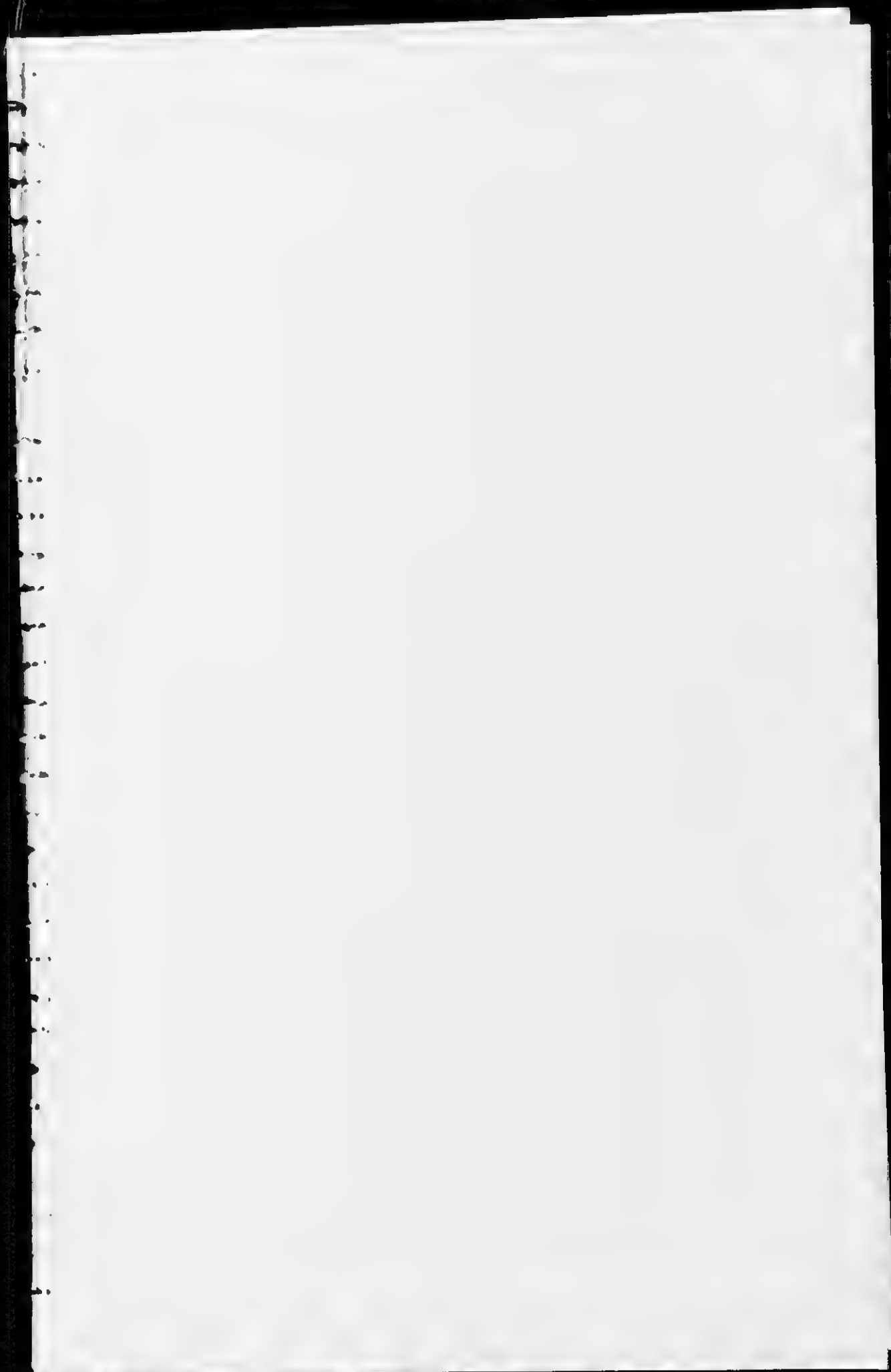
References Cited in the file of this patent

UNITED STATES PATENTS

2,796,714	Denney	June 25, 1957
2,862,376	Thelander	Dec. 2, 1958
3,050,146	Crim	Aug. 21, 1962

FOREIGN PATENTS

219,133	Australia	Nov. 24, 1958
---------	-----------------	---------------



BRIEF OF THE APPELLEE

IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 23575

Appeal From the United States District Court for the
United States Court of Appeals
for the District of Columbia

FILED APR 13 1970

Nathan Paulson

CLERK
Of Counsel:

EDWIN L. REYNOLDS
NEWTON, HOPKINS & ORMSBY

GEORGE M. HOPKINS
for Appellee

NEWTON, HOPKINS & ORMSBY
711 CANDLER BUILDING
ATLANTA, GEORGIA 30303

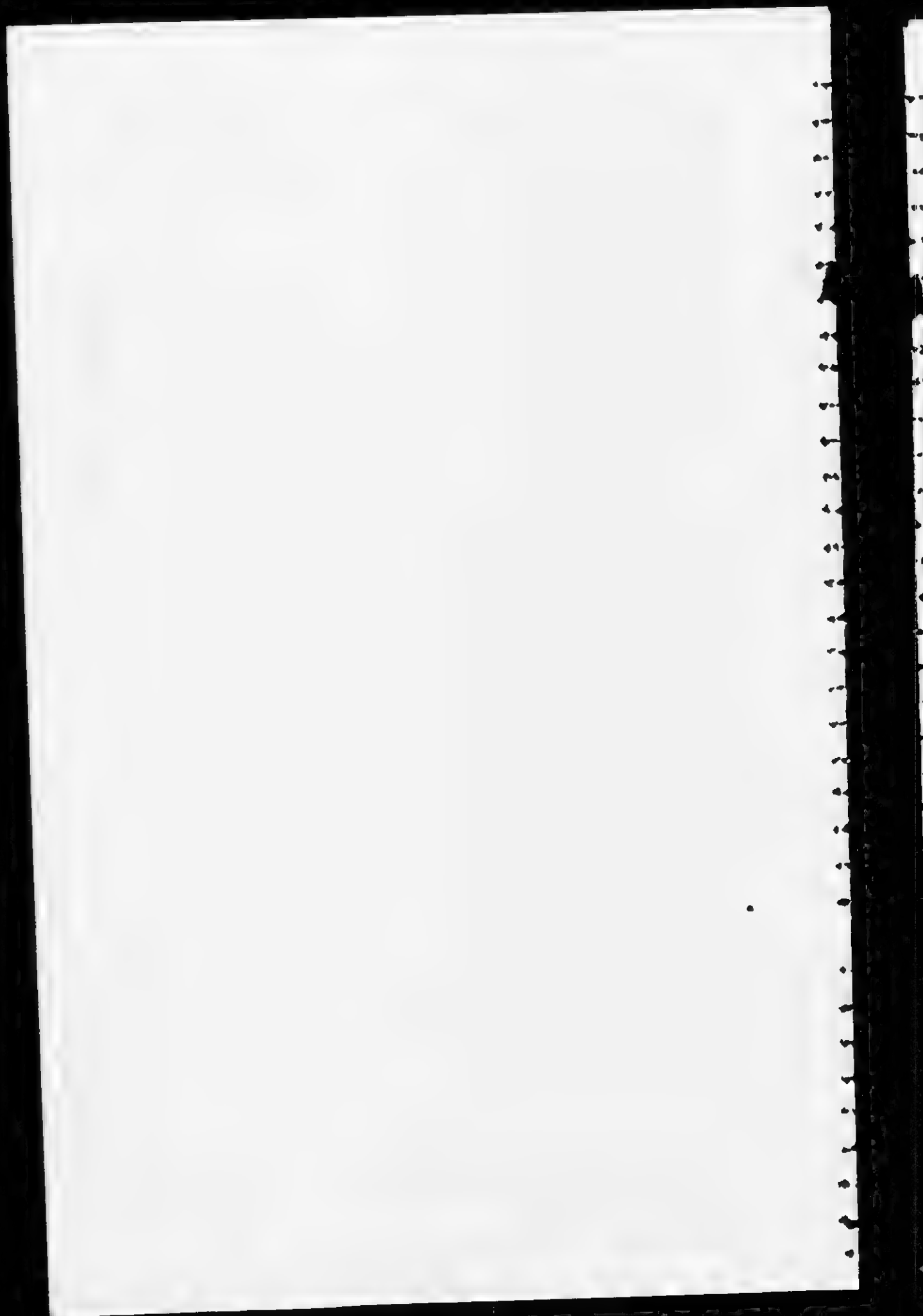


TABLE OF CONTENTS

	Page
STATEMENT OF THE CASE	1
Patent Office Proceedings	2
Decision of the Patent Office	2
Case Before the District Court	3
Record Before the Court	3
PROPER CASE FOR SUMMARY JUDGMENT FOR PLAINTIFF ..	4
ARGUMENTS OF FLYMO ARE IMMATERIAL	5
COUNTER AFFIDAVITS BY FLYMO REQUIRED	6
OTHER FALSE STATEMENTS BY FLYMO	7
ASSERTION BY FLYMO ABOUT BAFFLES—IMMATERIAL	8
BURDEN OF PROOF	10
DE NOVO TRIAL	12
REDUCTION TO PRACTICE	12
PROOF OF SATISFACTORY OPERATION	13
OPERABILITY	23
NO STATUTORY BAR	25
CONCLUSION	26

INDEX OF CITATIONS

CASES:

Adams and Ennix v. Stuller, 94 F.2d 403, 36 USPQ 341, (CCPA, 1938)	20
* American Anode v. Lee-Tex Rubber Products Corp., 136 F.2d 581 (CA 7, 1943)	25
* American Cable Co., Inc. et al v. John A. Roebling's Son's Co. et al 65 F.2d 801, 62 App D.C. 168	6

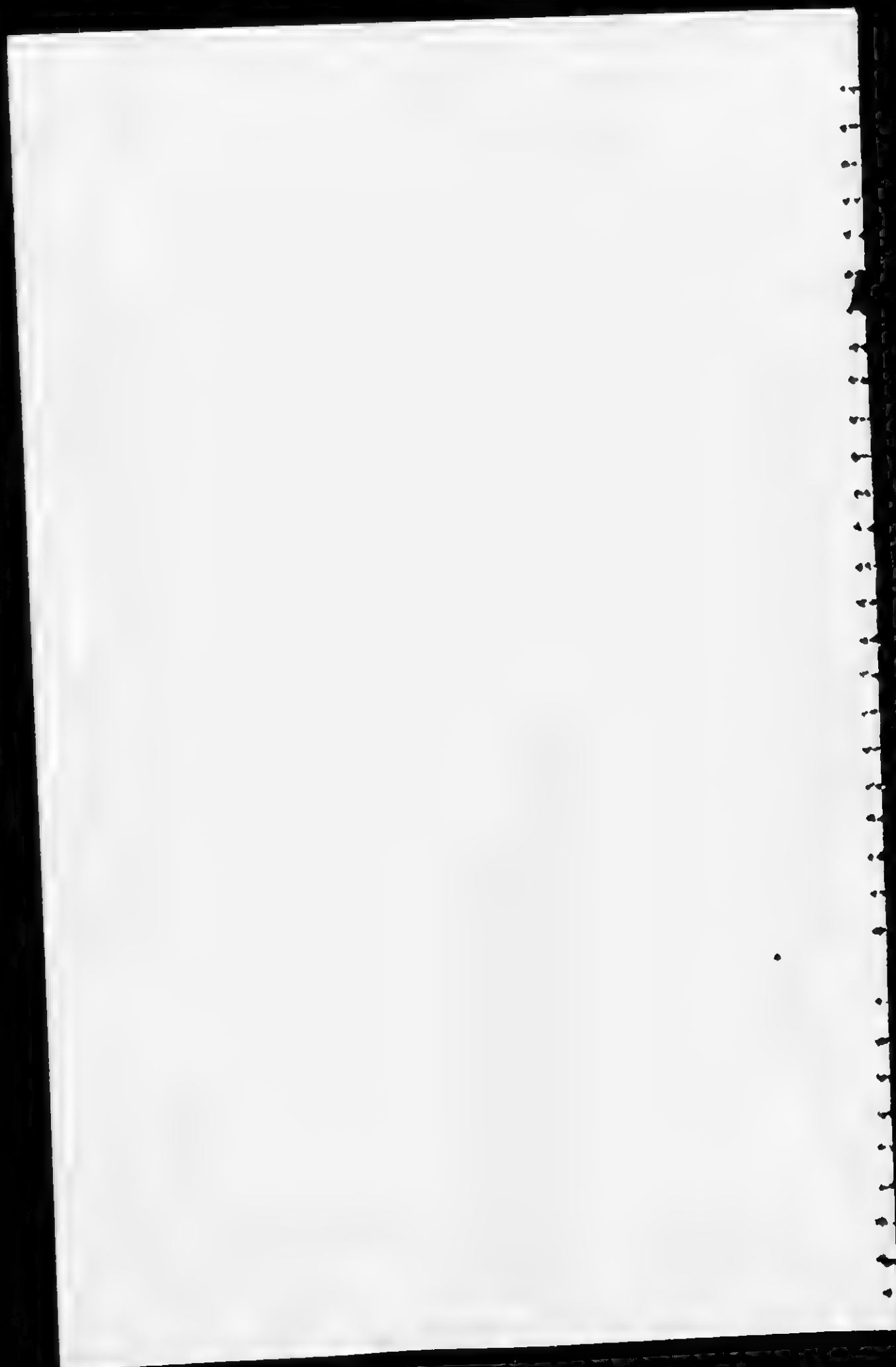
	Page
Bruce Construction Corp. v. United States, 242 F.2d 873, (CA 5, 1957)	6
* Burson v. Vogel, 29 App. D.C. 388; 107 C.D. 669; 131 O.G. 942	14
Deering v. Winona Harvester Works, 155 US 286 15 S.Ct. 118 (1894)	8
Dolbear v. American Tel. Co., 126 U.S. 1,88 Sup. Ct. 778	18-19
Downs v. Andrews, 25 F.2d 218 (App. DC, 1928)	21
Ericson et al. v. Jorgensen et al., 180 F.2d 180, 84 USPQ 176, (CA Eighth, 1950)	23
Gardner v. Zillger, 102 F.2d 203, 40 USPQ 661 (CCPA, 1939)	23
Hedenskoog v. Backus, 48 F.2d 408, 8 USPQ 436, (CCPA, 1931)	20
Herman v. Fullman, 23 App. DC 259 109 O.G. 1888	22
Hildreth v. Mastoras, 257 U.S. 27, 42 Sup. Ct. 20	19
* Honda v. Brace, 24 F.2d 446, 369 O.G. 731 (App. DC, 1928)	20
Honner v. Stine, 95 USPQ 373	19
Howard v. Humphreys, 97 F.2d 616, 38 USPQ 129 (CCPA, 1938)	20
John D. Pierce Foundation et al v. Penberthy Injector Company (D.C. Del. 1941) 49 USPQ 225, 229	12
Kravig and Johnson v. Henderson, 362 F.2d 1015, 150 USPQ 377, (CCPA, 1966)	13
Laas et al. v. Scott et al., 161 F. 122, 126 (D. Wis., 1908)	22
Leichsenring, Jr. v. Freeman (CCPA, 1939) 41 USPQ 478, 28 CCPA (Pat.) 1153, 103 F.2d 378	16
Leichsenring, Jr. v. Freeman Supra	17
Lindemeyer v. Hoffman et al., 95 O.G. 838, 1901 C.D. 353	18
Loomis v. Hauser, 99 O.G. 1172	18
Lustig v. Legat, 154 F.2d 680, 69 USPQ 345 (CCPA, 1946)	19
Mason v. Hepburn, 84 O.G. 147, 1898 C.D. 510	18
McCormick v. Cleal, 12 App. D.C. 335; 1898 C.D. 492; 83 O.G. 1514	15
McDermott v. Hildreth, 14 Gour. 88-17, (Nov., 1902) ..	18
Michael v. Beach, 353 O.G. (App. D.C., 1926)	21
Morgan v. Daniels, 153 US 14 S. Ct. 772 (1894)	11

Table of Contents Continued

iii

Page

Paivinen v. Sands, 339 F.2d 217, 144 USPQ 1, 52 CCPA 906, 1965 C.D. 131 (CCPA, 1965)	11
Pierson v. Beck, 40 F.2d 769, 5 USPQ 359, (CCPA, 1930)	22
Pool v. Dunn, 34 App. DC 132 151 O.G. 450 (App. D.C., 1909)	22
Power Patents Co. v. Coe, 110 F.2d 550 71 App. D.C. 369 (App. D.C., 1940)	25
Ring Engineering Co. v. Otis Elevator., 179 F.2d 812, 86 App. D.C. 411 (CA D.C., 1950)	4
Roe v. Hanson, 99 O.G. 2550	18
Schmierer and Valin v. Newton, 158 USPQ 203, 55 CCPA 1362, 397 F.2d 1010, 863 O.G. 651	11
Smith v. Brooks, 112 O.G. 953	21
in re Tanke 213 F.2d 551, 41 CCPA (Pat.) 919 (CCPA 154)	25
Whitaker v. Coleman, 115 F.2d 305 (CA 5, 1940)	4
Winkley v. Cogswell, 19 F.2d 680, (App. D.C. 1927) ..	21
Wirkler v. Perkins & Bennett (C.C.P.A. 1957) 44 C.C. P.A. 1005, 245 F.2d 502, 114 USPQ 284, 286	9
* Wirkler v Perkins & Bennett 44 CCPA 1005, 245 F.2d 502, 114 USPQ 284, 286; 35 USC 135 (b)	25
TEXT:	
Interference Law and Practice, Section 70	9
Interference Law and Practice by Revise and Caesar Section 75	9
Interference Law and Practice by Revise and Caesar Section 675	14
Moore's Federal Practice, Vol. 6, Sec. 56	4
Patent Interference and Practice zq Hugo M. Wikstrom	10
FEDERAL RULES OF CIVIL PROCEDURE:	
52	11
56(c)	6
STATUTES:	
35 USC 102 (b)	25
35 USC 135 (b)	1, 25
35 USC 146	3



IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 23575

JOHN F. CODY ET AL., Appellees,

V.

AKTIEBOLAGET FLYMO, KARL RUDOLPH DA
AND FLYMO SOCIÉTÉ ANONYME, /

Appeal From the United States District Court for the
District of Columbia

BRIEF OF THE APPELLEE

STATEMENT OF THE CASE

This is a patent interference case wherein the appellee (hereinafter referred to as Cody) copies three claims Counts 1, 2 and 3 from an issued patent No. 3,110,996 to the appellant (hereinafter referred to as Flymo) within one year after issuance of this patent, as permitted by 35 USC 135(b).

Patent Office Proceedings

In the interference proceedings, in the Patent Office, *only* Cody took testimony. Nothing in any of the testimony in behalf of Cody was refuted by Flymo and Flymo took no testimony in support of its claim of priority or operability or to support any other of its assertions.

II

Decision of the Patent Office

The Board of Patent Interferences and the undisputed record before this Court shows that Cody et al., built a machine which met the counts in the interference in 1960 (A 141). The undisputed testimony also shows that the 1960 machine did in fact cut grass (A 292, 295, 331, 333, 364, 366, 379, 380, 391, and 394) and cut more toward the center of the machine (A 334). This is corroborated by three independent witnesses, Daniel Martin, John Neill, and James Howard Ageton. All of this evidence is uncontradicted.

It is important to emphasize that Flymo has never seriously questioned the fact that Cody built a machine corresponding to the counts in interference in 1960 (while Flymo is limited by its preliminary statement (A 277) in its date of conception and reduction to practice to its earliest foreign application, filed in 1961). Nor has Flymo contended that the machine built in 1960 by Cody was not a "grass cutting machine" as set forth in the counts.

Indeed, no witnesses were cross-examined by Flymo on how well the machine cut grass. Instead, all defenses by Flymo were technical defenses and were afterthoughts, attacking how well the machine of Cody would operate. The motions of Flymo as to patentability of the counts to Cody were ignored by the Board. The Board, while holding that the machine of Cody "cut grass", held that

the machine was not proved to be "satisfactory" (A 143, 144).

III

Case Before the District Court

Cody then appealed to the District Court for the District of Columbia from this adverse decision of the Board under 35 USC 146 on the question of priority. Cody then moved that the testimony and exhibits from the Board be admitted in evidence according to 35 USC 146. Accordingly, such testimony and exhibits i.e., the record of Cody was admitted.

Thereafter, a motion for summary judgment was brought by Cody (Flymo brief p. 1.a) resulting in the District Court's opinion (Flymo brief p. 67a) awarding priority to Cody and reversing the decision of the Board of Patent Interferences.

IV

Record Before the Court

It is believed and respectfully urged that only the testimony and exhibits permitted by 35 USC 146 i.e., the transcript of Cody (A Vol. III) are properly before this Court for review and since no affidavits were filed by Flymo in support of its cross motion, and no stipulation exists which permit uncertified material to be brought in, Volume I, II, IV and V of the Appendix are not properly a part of this Appendix and cost for this extraneous matter should be assessed against Flymo, regardless of the outcome of this appeal. It is to be emphasized that Flymo, in opposition to Cody's motion for summary judgment, asserts merely that there were affirmative defenses which were interposed by Flymo. There were no affidavits or certified copies of anything submitted to the Court below by Flymo in support of their position.

PROPER CASE FOR SUMMARY JUDGMENT FOR PLAINTIFF

It is respectfully submitted that where, as here, Flymo has submitted no affidavits, the Court below could, as a matter of law, determine the Interference in favor of Cody.

There has been no offer of proof as to any defense asserted by Flymo and, therefore, the affirmative defenses which Flymo advanced were mere argumentative defenses. As is stated in Moore's Federal Practice, Vol. 6, Sec. 56, page 2167:

"Summary judgment should be rendered even though an issue may be raised formally by pleadings, where the supporting affidavits and opposing affidavits, if any, show that there is no genuine issue of material fact. Stubborn reliance upon allegations and denials in the pleadings will not alone suffice, when faced with affidavits or other materials, showing the absence of triable issues of material fact."

Section 56.11(3) of *Moore's* went on to state on page 2174 with respect to the party opposing the motion for summary judgment:

"But he may not hold back his evidence until trial, he must present sufficient materials to show that there is a triable issue."

In support of the proposition that the Defendant may not hold back his evidence until trial, *Moore's* cites *Ring Engineering Co. v. Otis Elevator Co.*, 179 F.2d 812, 86 App D.C. 411 (CA D.C., 1950), and many other cases.

It is respectfully submitted that all in the world that Flymo was doing was to present a sham, on which no evidence is or can be produced.

As Justice HUTCHESON so aptly put in *Whitaker v. Coleman*, 115 F.2d 305 (CA 5, 1940) at page 307:

" * * * Summary judgment procedure is not a catch-penny contrivance to take unwary litigations into its

toils and deprive them of a trial, it is a liberal measure, liberally designed for arriving at the truth. Its purpose is not to cut litigants off from their right of trial by jury *if they really have evidence which they offer on a trial*, it is to carefully test this out, in advance of trial, by inquiring and determining whether such evidence exists. (Emphasis added)

Also in the Fifth Circuit case of *Bruce Construction Corp. v. United States*, 242 F. 2d 873, (CA 5, 1957) Judge Brown observed the following:

"... when movant makes out a convincing showing that genuine issues of fact are lacking, we require the advisory adequately demonstrate by receivable facts that a real not formal controversy exists, and, of course, he does not do that by mere denial or holding back evidence."

It is evident that the facts in this matter are clear and unrefuted by any affidavits or probative material by Flymo.

The argument of Flymo in their brief is incoherent. Apparently, all that is argued is that, as a matter of law, Cody is not entitled to a judgment in his favor. There was, however, no cross-appeal and no *Answer* by the party now asserting ownership. In other words, the owner of the Dahlman patent is in default.

ARGUMENTS OF FLYMO ARE IMMATERIAL

Throughout the brief of Flymo there are references to extraneous matters which are (1) non-ancillary, (2) were introduced ex parte, (3) are not supported by affidavits and (4) are wholly immaterial herein.

It is important that the Board made no determination with respect to the various Motions of Defendants which were before it and Defendant made no request for reconsideration of such motions. Nor was there a cross-appeal filed requesting review on the motions. Under these circumstances, it appears that the only question before this Court is the question of priority.

In *American Cable Co., Inc. et al v. John A. Roebling's Sons' Co. et al* 65 F 2d. 801, 62 App D.C. 168 it was held:

"An interference proceeding is solely to determine priority and the only final order that can be entered in such a proceeding is a determination of priority. Motions to dissolve go to a determination of whether or not the interference is properly declared. A decision, therefore, on such a motion is purely interlocutory."

In other words, since there was no determination, one way or the other, on the motions to dissolve brought by Defendants in the Patent Office, it is still an interlocutory matter which is not subject to review.

All of the issues raised, in the Flymo brief on pages 5 and 9, the matter of the baffle, page 19 and the matters on pages 23-29 are such interlocutory matters.

Out of an abundance of precaution, however, the issues raised by Flymo will be answered hereinafter on their merits.

COUNTER AFFIDAVITS BY FLYMO REQUIRED

Rule 56(e) F.R.C.P. requires affidavits "on personal knowledge" and "certified copies" and is quite specific, stating:

"When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of his pleadings, but his response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. *If he does not so respond, summary judgment, if appropriate, shall be entered against him.*" (Emphasis added)

No certified copies or affidavits were presented by Flymo.

Now, by cluttering the Appendix with various and sundry trivia, Flymo seeks to cloud the issue of priority.

By way of example, on page 4 of the Flymo Brief is a reference to an operable machine winning a gold medal. There is no proof in this case of such and even if Exhibit III, p. 271 were taken at face value, it is *hearsay*.

The ex parte prosecution of the Flymo patent application, its being licensed to Toro and its extensive marketing (Flymo Brief p. 5) are also not supported by the record in this case, but are extraneous matters included without justification as part of the fabricated Appendix.

OTHER FALSE STATEMENTS BY FLYMO

The assertion on page 5 of the Flymo Brief that the machine of Cody works on a different principle is unsupported by facts or affidavits as is the claim that the grass is blown flat so that the blade "would not cut" unless bafflers were installed. This is directly contrary to all proof in this case! As pointed out above, each witness i.e. Cody, Neill, Sites, Ageyton and Martin said the 1960 machine of Cody did cut grass (A 292, 295, 331, 333, 334, 366, 379, 380, 391, 394) and on cross examination Cody explained that centrifugal action, swirling air eddies, etc. (A 359) would not cause the air to act in the manner claimed by the Flymo brief on page 7-9.

On page 9 of the Flymo Brief, Flymo asserts:

1. Cody never showed an operative machine—this is false! As pointed out above, the 1960 machine did cut grass.

2. Cody did not show how, where or the effectiveness of the grass cutting. This too is false. Numerous persons identified the airport as where and Ageyton identified rye grass (A 393) while Neill said "it did fly good and it performed good and it did good" (A 364).

ASSERTION BY FLYMO ABOUT BAFFLES—IMMATERIAL

The Flymo Brief is replete with assertions about baffles being necessary in the Cody device and that, therefore, the claims are too broad for Cody to make. This assertion is readily answered as follows:

1. Both the Flymo patent and the Cody application show baffles. The baffles of Flymo are the two circular disc 13 and 14 of patent no. 3,110,996 (Flymo Brief 73a) hence, if the claims are too broad for Cody they are also too broad for Flymo. This argument of Flymo borders on the absurd since the Supreme Court in *Deering v. Winona*, 155 US 286 (1894) at page 302 said:

“Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described in the patent as rendering it operative must be read into the claim. If Steward were in fact the first to invent the pivotal extension to a butt-adjuster, he is entitled to a patent therefor, * * *”

2. The original claims of the application of Cody filed in 1962 were not limited to baffles. Hence, the unintroduced, untranslated foreign Belgium patent and Swedish publication are not statutory bars, even under the warped theory of Flymo set forth on pages 8 and 9 of its brief.

Original Claim 3 has never been amended and reads as follows:

“3. A mowing machine comprising a housing body having an upper edge and a bottom edge defining a chamber at its bottom portion, a top across the upper edge of said housing body, said top defining an upper opening for the ingress of air into said chamber, a shaft extending through said upper opening into said shaft, a propeller carried by said shaft adjacent said opening for rotation with said shaft, said propeller driving air into said chamber upon rotation of said shaft, a blade on the lower end of said shaft, said blade

being disposed in a transverse plane normal to the axis of said shaft and adjacent the lower edge of said housing body, and means for controlling the tilting of said housing body."

It is just about the same as the counts in interference.

3. As a matter of law it doesn't matter when a claim is first introduced when it generally relates to the same subject matter.

Section 75 of *Interference Law and Practice*, by Revise and Caesar, page 201, states:

"As a general rule, an inventor may couch his claims in such broad terms as to include within their scope substantial variations of the device or thing which he has disclosed in the specification, provided the claims are not so broad as to be indefinite or vague, or to read upon prior constructions and practices. Furthermore, as was stated in Section 57, a claim involved in interference will ordinarily be given as broad an interpretation as its language will reasonably support. It would seem to follow that in order to support a broad claim, the disclosure of a party involved in an interference need only disclose a single embodiment upon which the claim will read."

Also, in Section 70 of *Interference Law and Practice*, page 173, the following is stated:

"If the issue of an interference has adequate basis in the disclosure of both parties, it is not necessary to enter into a technical research in the methods of operation of the respective devices. Furthermore, it is wholly immaterial that the device disclosed by one of the parties is superior to that of his opponent * * *"

The entire issue, however, is quite moot in view of the decision in *Wirkler v. Perkins & Bennett* (C.C.P.A. 1957) 44 C.C.P.A. 1005, 245 F. 2d 502, 114 USPQ 284, 286, wherein the Court said:

"It is immaterial that Perkins et al did not start claiming the subject matter in issue until after the

issuance of the Wirkler patent so long as they asserted a claim corresponding to the count within a year of the issuance of the patent, which they did, if the disclosure in fact supports the count. In other words, the test is disclosure and not what has been claimed."

In *Patent Interference and Practice* by Hugo M. Wikstrom, page 614, Section 8.02(3), the following is stated:

"A motion to dissolve based on a right to make the court must be decided in terms of the disclosure of the party challenged. What the party has been claiming is not the test to be applied. Thus, the fact that a party places more emphasis on claims other than that involved in the interference count is not a reason for dissolving the interference on the question of the right to make the claims if the disclosure of the party challenged adequately supports the claims constituting the interference count. If an applicant selects language which is broad in scope to describe his invention, he runs the risk that others with specifically different structures may be able to meet the language selected. The applicant will thereafter not be permitted to dissolve the interference by contesting the opponent's right to make the claims involved in the count on the basis that the count language should be interpreted in the light of the specific embodiment in his application merely because the count originated from his application. Thus, for example, if the count is cast in terms of means plus function, a disclosure of a structure in which the means include a plurality of elements will support the count."

BURDEN OF PROOF

On page 14 of the Flymo Brief, it claims that Cody must prove its case beyond a reasonable doubt. This is incorrect. Cody's application was filed prior to the issuance of the senior party's patent, and has a sufficient disclosure to support the patent claims copies by Cody et al., within one year after the issuance of this patent. Cody et al.'s bur-

den of proof, therefore, need only be by the preponderance of the evidence. The case of *Wirkler v. Perkins et al.*, *supra*, supports this proposition. Also, the Court's attention is called to *Paivinen v. Sands*, 339 F. 2d 217, 144 USPQ 1, 52 CCPA 906, 1965 C.D. 131 (CCPA, 1965) and *Schmierer and Valin v. Newton*, 158 USPQ 203, 55 CCPA 1362, 397 F. 2d 1010, 863 O.G. 651 which held that Cody's proof need be only by a preponderance of the evidence.

This issue, however, is quite moot since all of the evidence is in behalf of Cody and is unrefuted.

On page 15 of its Brief, Flymo relies upon *Morgan v. Daniels*, 153 US 120 (1893) for the proposition that the findings of fact made by the Patent Office should not be disturbed. This 19th century case can be distinguished by the fact that in the Supreme Court case there were disputed facts. Here there are no disputed facts.

The 19th century Supreme Court decision was also prior to the Federal Rules of Civil Procedure in which Rule 52 states with respect to the District Court's decision:

"Finding of fact shall not be set aside unless clearly erroneous"

The District Court has found the decision of the Patent Office to be:

" . . . erroneous in law and fact"

and concluded as a fact:

"The Cody machine cut grass satisfactorily under operating conditions although the width of the cut was not in relation to the length of the blade at the optimum desired." (Flymo Brief p. 69a)

This finding of fact by the District Court should not be overturned "unless clearly erroneous".

DE NOVO TRIAL

On pages 16 and 17 of its brief Flymo is building a strawman to be knocked down. What difference does it make with respect to this appeal that Cody intended later to bring in additional evidence? What evidence is there with respect to Flymo being "seriously damaged" or that it has lost "critical timing"? These matters are obviously moot and based on speculation.

REDUCTION TO PRACTICE

On page 18 through 23 of its Brief, Flymo finally gets down to the crux of this appeal, namely, did Cody show a reduction to practice of the invention?

In order to show no reduction to practice, several additional straw men were built by Flymo:

1. A machine to operate must have baffles.
2. It must have a skirt.
3. It must have a certain amount of power.
4. It must have have sharpened blades throughout the length.
5. It must not have torque.
6. It must have rings.
7. It must have double walls.

Each of the counts (Flymo Brief p. 14) of the interference has none of these elements.

In *John D. Pierce Foundation et al v. Penberthy Injector Company* (D.C. Del. 1941) 49 USPQ 225, 229, the Court pointed out that such straw men are to be disregarded saying:

"Defendant has attempted to introduce his own test requirements by asserting that unless a device was

capable of coping with a vacuum of 15 inches of mercury or more, the device would be unsuccessful and would not constitute a reduction to practice. There is nothing in the interference counts which call for any degree of vacuum."

In like manner there is nothing in the counts of this interference which call for any factors such as baffles, power, skirts, sharpened, torque, rings, double walls, etc.

The material thing is that the machine built by Cody in 1960 is defined by *the Counts in interference* and not even Flymo is disputing this. Indeed, the Board of Patent Interferences, speaking of Cody's witnesses, said:

"We find their testimony to establish that the machine built by Cody et al. in 1960 included structure to support the counts."

This was affirmed by the District Court and appears not to be in dispute at all.

PROOF OF SATISFACTORY OPERATION

It is also significant that the counts call for "a grass cutting machine" not necessarily a lawnmower which might imply an ability to cut a "wide swath" but a "grass cutting machine" and where the witnesses Cody, Sites, Martin, Neill, and Agerton, all testified that the machine cut grass and was satisfactory, more than conjecture is necessary to overcome this positive testimony. That this constituted a reduction to practice is supported by the case of *Kravig and Johnson v. Henderson*, 362 F.2d 1015, 150 USPQ 377, (C.C.P.A. 1966) where the Court said:

"The fact that Henderson expended much additional time and effort before he obtained the machines operating on the principle proved by his first machine which were commercially satisfactory does not negate the finding of reduction to practice since it is well

established that commercially satisfactory performance is not necessary to an actual reduction to practice."

Also directly in point is *Burson v. Vogel*, 29 App. D.C. 388; 107 C.D. 669; 131 O.G. 942 which stated:

"A machine may be crude in construction but if it contains all the essential elements of the invention of the issue and in its operation successfully demonstrates its practical efficacy and utility, reduction to practice is accomplished . . . The mere fact that mechanical improvements may be suggested and made in the course of operation, that tend to perfect the operation of the machine and increase its practical efficiency, while retaining the essential elements of the invention which it puts in practice, does not impair the effect of the original demonstration of utility, if established satisfactorily. . ."

At this point, it is most significant to note that the counts in interference call for a "grass cutting machine" in two of the counts, and "a wheelless grass cutting machine" in the other count. Therefore, if the machine of Cody et al. cuts grass (which it did), it would be sufficient to prove reduction to practice. In Section 675, *Interference Law and Practice*, by Revise and Caesar at page 2665, the following is stated:

"In *Harlan v. Bergman*, 17 C.C.P.A. 949; 1930 C.D. 312; 396 O.G. 374; 39 Fed. Rep. (2nd) 494 (C.C.P.A. 1930), the fact that the alleged reduction to practice device, which was in evidence, was crude, was held not to overcome testimony that it has been successfully tested."

Undoubtedly the testimony and *all* the testimony shows that Cody built a machine which cut grass satisfactory.

On page 333 of the Appendix is the following testimony of Cody:

"114. Would you describe that test flying of the machine as you call it?

A. Well, the machine flew and OPERATED SATISFACTORILY with the exception of the fact that it was underpowered and too heavy and these things we knew that we could work out with the better engine and lighter materials but the machine did fly and did operate. WE WERE VERY PLEASED WITH THE RESULTS OF IT." (Capital Letters Added)

In responding to question 114, Cody was testifying about the machine which was completed in April, 1960. On cross-examination, not one question was directed toward the operation of the machine. Hence, apparently, FLYMO was satisfied that the machine did, in fact, operate satisfactorily. Indeed, FLYMO took no testimony to show that the machine did not operate properly and did not even cross-examine on this issue. The evidence, therefore, appears to be undisputed that the April, 1960, Cody machine operated properly, and that Cody was pleased with the results.

In *McCormick v. Cleal*, 12 App. D.C. 335; 1898 C.D. 492; 83 O.G. 1514, the party Cleal objected to certain documents produced by McCormick on the ground that they were merely secondary evidence. However, he did not cross-examine the witnesses who identified them. The Court states, *inter alia*:

"... We cannot indulge any other presumption than that he was at the time satisfied in respect to the genuineness of the record of their dates."

This testimony of Cody that the machine operated satisfactorily and he and Sites were very pleased with the results, is corroborated by the testimony of John Neill, a

distinterested witness, on pages 364 and 366 of the Appendix. The testimony of Neill is as follows:

"18. How did the machine operate?

A. The machine—actually, I thought the first machine flew just as well as the one they build today. It wasn't as near as good looking in appearance, but the airplane—airplane, as I call it—the lawnmower did fly good and it performed good and it did cut good."

"28. Yes, sir; and it was cutting grass?

A. It definitely was cutting grass. Like I say, I think the first one did as GOOD A JOB, or a better job, as some of the ones he produced later, up to the one which I think he has right now." (Capital Letters Added)

The testimony of Cody was also corroborated by the testimony of Martin, on page 292 of the Appendix wherein the following is found:

"20. Would you describe what it was that you saw?

A. Well, I seen a machine on the airport CUTTING GRASS that wasn't touching the ground, it was a flying lawnmower, which astonished me and I asked question about it then." (Capital letters added)

In *Leichsenring, Jr. v. Freeman* (C.C.P.A. 1939) 41 USPQ 478, 28 C.C.P.A. (patents) 1153, 103 F.2d 378, the Court at page 482, said:

"The witness Jacobson was quite positive in the statement that 'it performed what it was supposed to perform to hold the car on the grade, without holding your foot on the brake pedal' and that 'it worked very nice'.* The length of time one wishes to hold a vehicle naturally varies with the circumstances and we deem the showing made to be sufficient in that regard. So far as the amount of load is concerned, we take that as a matter of degree which the counts do not define. It is fairly inferable that a greater

pressure would have to be maintained on a heavier loaded truck than on a light passenger car, loaded or unloaded, but the counts seem to us to be satisfied where the holding of any automotive vehicle is satisfactorily demonstrated."

There is a striking resemblance between the foregoing statement: "The lawnmower did fly good and it did cut good" and the language from the *Leichsenring, Jr. v. Freeman* case:

"it performed what it was supposed to perform and 'it looked very nice'".

On page 378, 379 of the Appendix is the following testimony of Sites:

"40. Let's go back to the first machine you built without the skirt and you tried it. I believe you told me it actually cut grass; is that right?

A. Yes, sir; it cut grass. It had a torque problem and it didn't cut the grass to the best possible, what you'd really want. I mean it wasn't the ultimate in cutting grass but it did cut grass. It made a fair swath, but it wasn't giving us exactly what we wanted so we went inside and had a torque problem which we tried correcting and did correct the torque by putting air deflectors in it."

Sites, also said, (A380) with respect to the 1960 machine:

"46. I'm talking about the first one, now.

A. The first one, yes, it would displace its own weight, not sufficient but we had the heavy engine, but it would pick it up and it would cut grass. It wasn't as efficient as what we wanted and wasn't what we would want to put on the market."

On page 391 of the record of Cody is the testimony of Agerton who witnessed the machine in the fall of 1960 and corroborated the testimony of Sites as follows:

"S. What year was that?

A. That was in the fall of '60.

9. All right, sir; well, now, think about the time that George—he's also known as Bill, isn't he?

A. Yes, sir; that's right.

10. At the time that George was out there, did you see the machine operate?

A. Yes, sir.

11. Did it cut grass?

A. It cut grass; yes, sir."

The above testimony certainly shows satisfactory testing. What more could be asked for?

Thus, any contention that the machine would not cut grass or did not operate properly is without merit.

The question of what constitutes reduction to practice of the invention has been the subject of many decisions; however, the preamble to a claim should control the amount of reduction to practice which is involved. In other words, a count for "a grass cutting machine" is met by a machine which satisfactorily cut grass and is otherwise defined by the counts. The amount of grass that is cut and whether it cuts a wide swath or a narrow swath is immaterial.

In certain cases, where the devices are so simple in their construction that they show upon inspection that they are capable of performing the intended function, actual use is not necessary to establish the fact of reduction to practice. *Loomis v. Hauser*, 99 O.G. 1172; *Roe v. Hanson*, 99 O.G. 2550; *McDermott v. Hildreth*, 14 Gour. 88-17, (Nov., 1902); *Mason v. Hepburn*, 84 O.G. 147, 1898 C.D. 510; *Lindemeyer v. Hoffman et al.*, 95 O.G. 838, 1901 C.D. 353.

With respect to what constitutes appropriate testing to support a reduction to practice of the invention, there are two leading Supreme Court cases. The first is *Dolbear v.*

American Tel. Co., 126 U.S. 1, 8 Sup. Ct. 778. In that case, the patent of Alexander Graham Bell was sustained wherein one claim read "the method of transmitting vocal or other sounds telegraphically" and the other claim said "the apparatus for transmitting vocal or other sounds telegraphically". The Court pointed out at page 782:

"The particular instrument which he had, and which he used in his experiments did not under the circumstances in which it was tried reproduce the words spoken so that they could be clearly understood; . . ."

However, the Court held this to be a reduction to practice.

The second case is *Hildreth v. Mastoras*, 257 U.S. 27, 42 Sup. Ct. 20. In this case the Court said:

"It is not necessary, in order to sustain a generic patent, to show that the device is a commercial success. The machine patented may be imperfect in its operation; but if it embodies the generic principle and works it is, if it actually and mechanically performs, though only in a crude way, the important function by which it makes the substantial change claimed for it in the art, it is enough."

In *Honner v. Stine*, 95 USPQ 373, the Board of Interference Examiners in 1952 held that the word "seal" does not necessarily require an hermetic or gas tight seal, and proof of the use of pliofilm wrapper as a fluid-seal means for curing cheese was held sufficient to show a reduction to practice.

In *Lustig v. Legat*, 154 F.2d 680, 69 USPQ 345 (CCPA, 1946) it was held that a self-locking slider for a slide fastener was tested sufficiently to constitute a reduction to practice by pulling cross-ways on two tapes connected by the slider to determine whether the slider would lock. Here numerous people have testified that the machine of Code was tested by causing it to cut grass. It is respectfully submitted that this is sufficient.

In *Howard v. Humphreys*, 97 F.2d 616, 38 USPQ 129 (CCPA, 1938), it was held that operating a small laboratory still was sufficient to constitute a reduction to practice of the method counts where the still was operated successfully.

All of these cases simply go to show that if a machine cuts grass and severs it satisfactorily, that is all that is required to constitute a reduction to practice of a claim which calls for a "grass cutting machine". To the same effect, for example is *Adams and Ennis v. Stuller*, 94 F.2d 403, 36 USPQ 341, (CCPA, 1938) wherein the Court said:

"It is well established that, to constitute a successful reduction to practice of an invention, the device need not be perfect in its operation; but is enough if it actually and mechanically performs, though in a crude way, the function for which it was designed."

Undoubtedly, the machine which was built by Cody et al. in 1960 did in fact function in more than a crude way to cut grass.

In *Hedenskoog v. Backus*, 48 F.2d 408, 8 USPQ 436, (CCPA, 1931) the Court held that a pin setting machine constructed and operated to set one or two pins was a reduction to practice although it was never operated in a bowling alley and it was commercially unsatisfactory because it was too noisy in operation.

Of particular significance is the case of *Honda v. Brace*, 24 F.2d 446, 369 O.G. 731 (App. DC, 1928). Wherein the Court held that the counts in interference were not limited to magnets of any particular shape or configuration and, therefore, a reduction to practice was achieved though the pieces tested were not of a shape and dimension suitable for use as permanent magnets in instruments. This case also stands for the proposition that where, as here, the count is quite broad in its terminology, an equally broad testing would be involved.

In *Downs v. Andrews*, 25 F.2d 218, (App. DC, 1928) the Court of Appeals held that while reduction to practice requires that the invention be so tested that its efficacy and utility are demonstrated, it is not necessary that a practical embodiment of the idea of the invention should be mechanically perfect, since if the operative means accomplishes the desired end, reduction to practice is established although the elements of the device should have been made stronger or given better shape, arrangement, or adjustment.

The undisputed facts presented from the record of the Patent Office in the present case is that Cody built the elements in operative relationship which are called for in the counts in interference and that these elements functioned in 1960 to cut grass and to cut it fairly well. Under the ruling in the *Downs* case, the award of priority by the District Court to Cody was proper.

Nor does it matter whether the device was subsequently altered by Cody et al. In *Winkley v. Cogswell*, 19 F.2d 680, (App. DC, 1927), the Court held that it is well settled that a commercial test is not necessary to constitute a reduction to practice. A successful test of a machine although later altered for the purpose of causing the machine to respond to higher speeds and involving only mechanical skill, was a reduction to practice of the invention.

It is significant to note that the original machine is presented for the Court to examine, even though it is partly dismantled. The parts are in evidence. In *Smith v. Brooks*, 112 O.G. 953, it was held that where the inventor and a witness skilled in the art testified that the operation of the machine was successful in 1896, and the machine in its present condition, although partly dismantled by the removal of parts supports the allegation as to it, it was held that it must be regarded as a reduction to practice.

In *Michael v. Beach*, 353 O.G. (App. DC, 1926), it was held that the evidence of the construction of a device re-

sponding to the terms of the claims together with the testimony of the inventor corroborated by one witness that the machine was tested at that time and was successful, is sufficient to establish reduction to practice.

Furthermore, the mere fact that the inventors attempted to improve the device which they had constructed and operated does not prove that the device as first constructed was not a reduction to practice; as in almost every art the pioneer invention is a crude affair. *Pierson v. Beck*, 40 F.2d 769, 5 USPQ 359, (CCPA, 1930).

In the present situation the undisputed facts are that the machine of Cody et al. meets the terms of the claims or counts in interference and that the machine did and is capable of "cutting grass". It was therefore a grass cutting machine and did a quite substantial job of "cutting grass".

In *Herman v. Fullman*, 23 App. DC 259, 109 O.G. 1888, it was held that where a full size machine was made for making blueprints and it was testified that the machine did actually make a blueprint, that was sufficient to show a reduction to practice.

In the case at bar the testimony is that Cody built a full scale machine and it cut grass.

In *Laas et al. v. Scott et al.*, 161 F. 122, 126 (D Wis., 1908), it was held that in reducing an invention to practice it is not necessary to prolong the test until its commercial value has been established, but if it accomplishes the end desired, it is a perfected invention although it may prove of little or no commercial value.

In *Pool v. Dunn*, 34 App. DC 132, 151 O.G. 450 (App. DC, 1909) it was held that it was not necessary in order to establish reduction to practice that the test of the device relied upon should be one of complete accuracy. It is seldom that an inventor reaches perfection on the first device con-

structed. The test should be to ascertain whether or not the device reasonably meets the requirements of the specifications, and, if it does not measure up to this test can it be made to meet it by the introduction of mere mechanical changes? If it can, it should be regarded as a reduction to practice.

Indeed, in *Gardner v. Zillger*, 102 F.2d 203, 40 USPQ 661 (CCPA, 1939), it was held that a television receiver which received an unclear image was a reduction to practice at that state in the development of the art. The Court further pointed out that the reception of a picture which could be distinguished as that of a person is about all that could have been expected. Here, the grass that was cut was over a relatively wide swath even though a "narrow swath" with respect to the entire blade.

In *Ericson et al. v. Jorgensen et al.*, 180 F. 2d 180, 84 USPQ 176, (CA Eighth, 1950) it was held that in an interference the fact that the inventors were dissatisfied with the original device is not evidence of failure to reduce the invention to practice.

OPERABILITY

Again on page 24, Flymo refers to baffles. It seems to be absurd that Flymo should be so preoccupied since such baffles were installed in 1960 in the Cody machine. About the baffles, Sites said on page 381 of the Appendix:

"54. About when was it that you and John installed the baffles on the machine that you're talking about?

A. That was in the fall or winter, I believe it was. It was after John's season. The project wasn't worked on right during the heart of the season. John wasn't in this area at that time and I believe at that time, too, I was still in the Guards and I know I went to summer camp that year.

55. And by the 'Guards', you mean the National Guard?

A. National Guard, right.

56. What sort of baffles did you install in the fall of '60?

A. They were some that was attached to the spider and then some attached to the inside of the housing. They were air deflectors to correct the torque of the machine.

57. The ones that were attached to the spider, what were they for?

A. For torque.

58. And the ones attached to the housing, what were they for?

A. Partially for torque, too, and to let the very tips of the cutting blade out.

59. Did it accomplish that?

A. Yes, it did, but still again it still wasn't as efficient well, it was efficient but it wasn't what we wanted. It was efficient to the point where it would cut grass okay but I've always been a person that if it's worth doing it's worth doing it right and we always strived for the best.

Hence, by the fall of 1960 the machine developed by Cody was cutting grass with the very tips of the cutting blade. This certainly is all that is expected of any lawnmower, even in commercial production. The contention of Flymo that baffles were needed is clearly contrary to all the testimony. In any event, the baffles were on the machine in 1960 (A 381, 382). Indeed, the application of Cody describes a "vontex" and "partial vacuum in the central portion" of the machine (A 59) which would lift the grass, for cutting, even without baffles.

NO STATUTORY BAR

On page 26 of its Brief, Flymo claims that a Swedish Magazine published on November 1, 1962, (A 271) is a statutory bar. This publication has not been translated, has no affidavit or certification in its support and is not properly before this Court. Nevertheless, the publication was only *seven days* prior to the filing date of the Cody application (A 47), not more than one year, as required by 35 USC 102(b). Nor would a Belgium patent, issued after the filing of the Cody application, be an anticipation. This is another straw man of Flymo! No "new matter" or any change to the specification has been made, as suggested by Flymo. Instead the claims were copies from the patent, as permitted by 35 USC 135 (b).

The cases cited by Flymo relate to adding "new matter" to the specification, The specification of Cody, however, was not changed, nor was the scope varied, except to copy the Flymo claims.

It is believed well settled that applicants can amend their application even to assert rejected claims for interference purposes, *in re Tanke* 213 F. 2d 551, 41 CCPA (Pat.) 919 (CCPA 1954), and can assert any claims which could be the basis of the interference, even thirty days after the preliminary statement. *Power Patents Co. v. Coe*, 110 F. 2d 550 71 App. D. C. 369 (App. D. C., 1940). Indeed, an applicant can broaden the scope of his claims so long as they are fairly supported by the disclosure of his original application. *American Anode v. Lee-Tex Rubber Products Corp.*, 136 F. 2d 581 (CA 7, 1943) and it doesn't matter when a claim (supported by the original disclosure) is first presented, provided it is copied within one year after the other parties patent issues. *Wirkler v. Perkins & Bennett*, 44 CCPA 1005, 245 F.2d 502, 114 USPQ 284, 286; 35 USC 135 (b).

CONCLUSION

While Flymo has skillfully attempted to divert the Court's attention from the question of priority, these facts remain from the undisputed testimony:

1. Cody built a machine in 1960 corresponding to the counts in interference.
2. This machine operated to the satisfaction of the inventors and functioned for its intended purpose in field tests at the airport in Quincy and elsewhere to cut grass.
3. Flymo is limited to its 1961 date because it simply relied on its foreign filing.
4. The claims of Flymo were copies by Cody within one year of the issue of patent No. 3,110,996.
5. The District Court awarded priority to Cody and this should not be disturbed unless clearly erroneous.

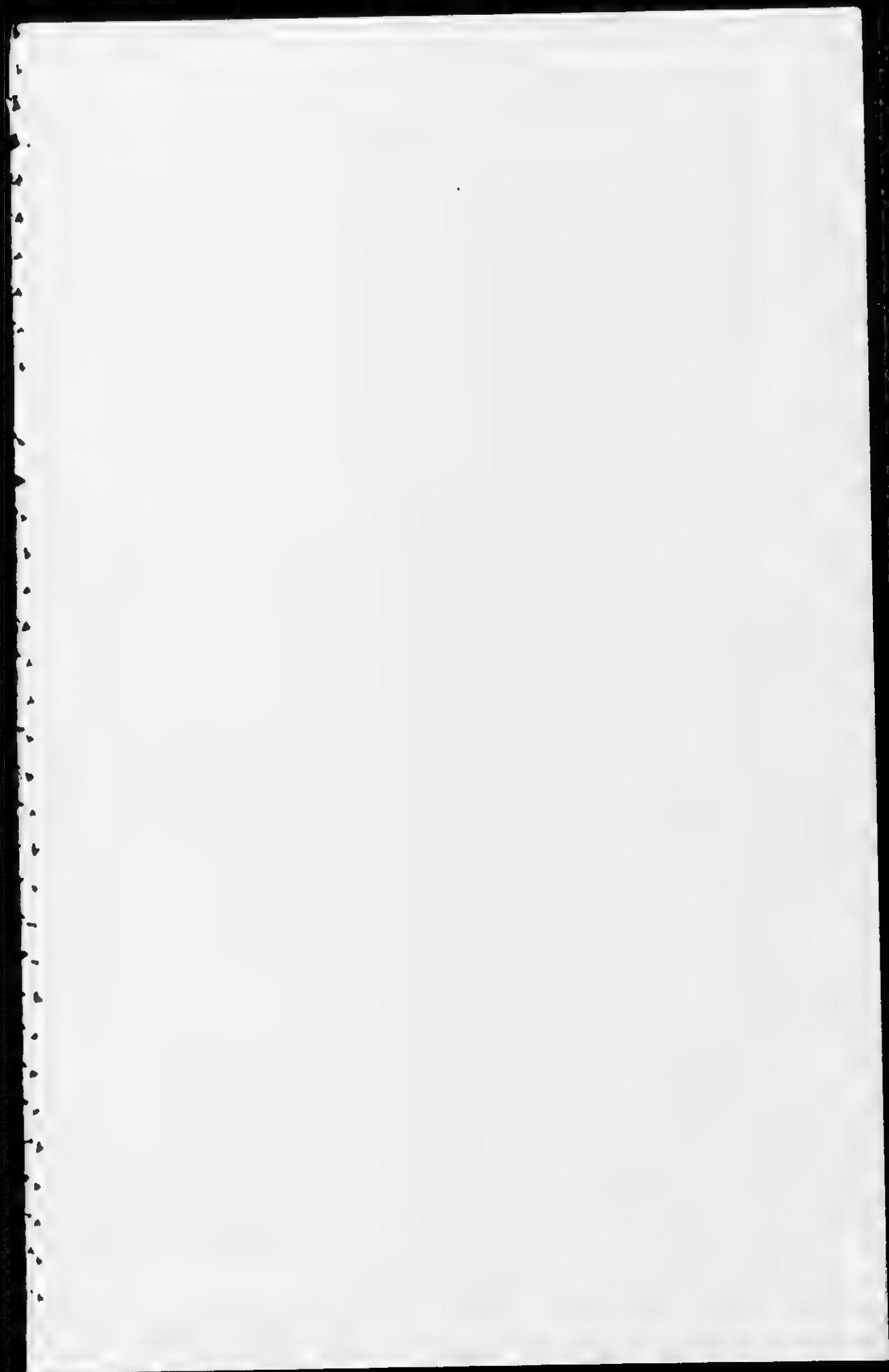
Respectfully submitted,

GEORGE M. HOPKINS
Newton, Hopkins & Ormsby
711 Candler Building
Atlanta, Georgia
Attorney for Appellee

Of Counsel:

EDWIN L. REYNOLDS
NEWTON, HOPKINS & ORMSBY

LAWRENCE COLBERT
National Press Building
Washington, D. C. 20004



REPLY BRIEF OF THE APPELLANT

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 23575

JOHN F. CODY ET AL. *Appellees*

v.

AKTIEBOLAGET FLYMO, KARL RUDOLPH DAHLMAN, AND
FLYMO SOCIETE ANONYME *Appellants*

Appeal From the United States District Court
for the District of Columbia

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

FILED APR 16 1970

LAURENCE R. BROWN
for Appellants

For appellees
Of Counsel:
JOHN H. LEWIS, JR.
STEVENS, DAVIS, MILLER & MOSHER

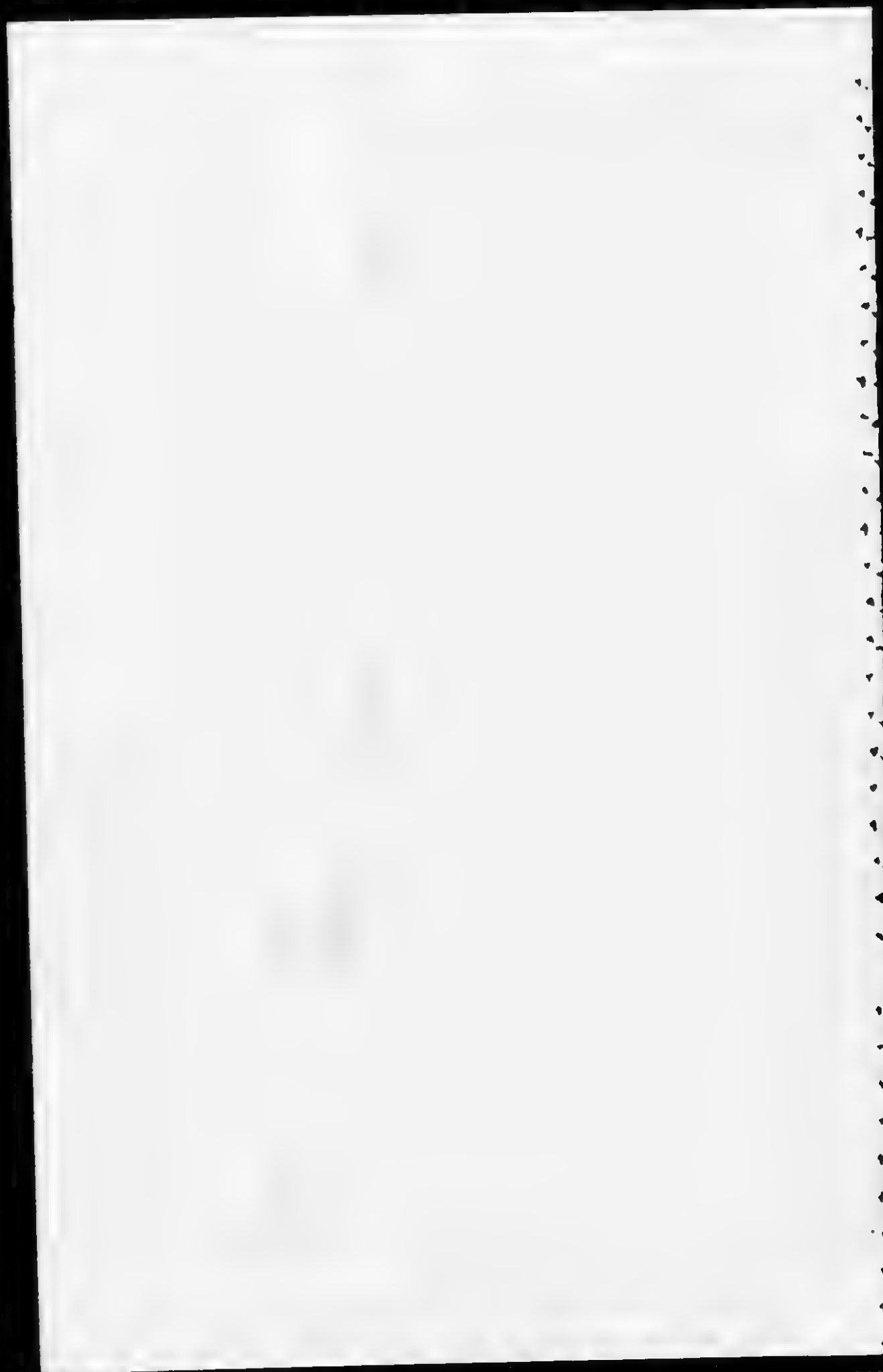


TABLE OF CONTENTS

	Page
BACKGROUND	1
RELATIONSHIP OF 35 USC 135 (b)	2
TESTIMONY	3
THE PATENT OFFICE RECORD	4
ERROR IN THE TRIAL COURT	5
THE RECORD BROUGHT BY APPELLANT	5
SUMMARY JUDGMENT PROCEEDING	6
FLYMO ARGUMENTS	7
NO COUNTER AFFIDAVITS ARE REQUIRED BY FLYMO UNDER RULE 56 (e) FRCP	7
STATEMENTS BY FLYMO	7
BAFFLES ARE MATERIAL	8
BURDEN OF PROOF	10
REDUCTION TO PRACTICE—PROOF OF OPERATION	10
OPERABILITY	12
STATUTORY BAR	12
CONCLUSION	12

INDEX OF CITATIONS

CASES:

<i>Abington Textile Machinery Works v. Carding Specialists (Canada) Ltd.</i> (D.C. Dist. Col.) 249 F. Supp. 823	5
<i>Aloe Creme Laboratories, Inc. v. Texas Pharmacal Co.</i> (CA 5) 335 F.2d 72	5
<i>De Seversky v. Brenner</i> (CA DC—No. 22202—Feb. 13, 1970) 164 USPQ 495	2, 5
<i>Package Devices Inc. v. Sun Ray Drug Co.</i> , 162 USPQ 400 (Appendix Exhibit V—p. 421)	3
<i>U.S. v. American Bell Telephone et al.</i> , 167 US 224 ...	3

	Page
STATUTES:	
35 USC 102(b)	2, 3, 12
35 USC 135(b)	2, 12
35 USC 146	6
FRAP 28(f), 30(a)	5
FRCP 56	7

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 23575

JOHN F. CODY ET AL. *Appellees*

v.

AKTIEBOLAGET FLYMO, KARL RUDOLPH DAHLMAN, AND
FLYMO SOCIETE ANONYME *Appellants*

Appeal From the United States District Court
for the District of Columbia

REPLY BRIEF OF THE APPELLANT

BACKGROUND

This case involves a review of a Patent Interference Proceeding where the Senior Party Appellant Flymo, obtained two decisions in the U.S. Patent Office from the Board of Patent Interferences awarding Flymo priority of invention on the basis that the Junior Party Appellee Cody

had failed to sustain the required burden of proof in overcoming the filing date of the Patent issued to Flymo.

Appellee Cody took the record below without any new testimony or new evidence to the trial court for a Summary Judgment on the record. The trial court reversed the Patent Office after opposition by Appellant.

Appellant brings this decision on review before this Honorable Court on the premise that the trial court committed reversible error contrary to the state of the law in this Circuit by refusing to attach weight and expertise to the Patent Office findings on highly technical matters and without any facts or evidence or law that carries a conviction that the Patent Office erred; *De Seversky v. Brenner* (CA DC No. 2262 February 13, 1970).

Briefs were filed before this Honorable Court by Appellant and Appellee.

This reply brief is filed to clarify the record as to the statements made in the Brief of the Appellee wherein many self-serving conclusions are made that do not conform to the facts or the law. The matters herein discussed are referenced to section and page numbers of the Reply Brief of the Appellant for ready reference and are presented in order of appearance therein.

RELATIONSHIP OF 35 USC 135(b)— Statement of the case, p. 1—

There can be no implication of this statute section that gives a right to copy the claims within one year if publication bars exist under 35 USC 102. Contrariwise, it is a negative statute that prevents claims from being copied after one year, stated as follows (*italics added*):

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent *may not be made* in any application unless such a claim is made prior to one year from the date on which the patent was granted.

In the Brief of the Appellant (Appendix 24a) the Supreme Court decision *U.S. v. American Bell Telephone et al.*, 167 US 224, is cited, which holds:

“Nowhere has it been found evident that any right to make claims supersedes and replaces the requirement of constructive estoppel defined by 35 USC 102 and particularly not in the case of 35 USC 135(b) as held by the Examiner.

Also in the record (Appendix Exhibit Volume V, p. 421, 426) is a recent case *Package Devices Inc. v. Sun Ray Drug Co.*, 162 USPQ 400, (D.C. E.D. Pennsylvania, April 28, 1969), that holds an amendment date is the reference date under section 35 USC 102(b) rather than the filing date.

Thus the law is clear under 35 USC 102(b) that the date of the application is the date of copying the claims and that copying claims more than one year after publication is estopped by a statutory bar. The statute is quoted (*italics added*):

35 USC 102.—A person shall be entitled to a patent unless—

(b) *the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.*

TESTIMONY—I—Patent Office proceedings, p. 2—

Apparently Appellee is trying to infer that because the Appellant has taken no testimony, Appellee has proved by a preponderance of evidence his case. It is long established, as a principle of law, that in an interference proceeding, the burden of proof is on the junior party—which was the Appellee Cody et al., and therefore the Appellant need not take any testimony or refute any claims of the junior party by taking testimony, unless the priority of invention is established by the junior party in his testi-

mony. It has been established of record as a matter of fact in the U.S. Patent Office and in two hearings before the Board of Patent Interferences that Appellee Cody et al. did not sustain his burden of the preponderance of the evidence in proving priority of invention.

THE PATENT OFFICE RECORD—

II—Decision of the Patent Office, p. 2—

A statement is made that "the undisputed record before this court shows that Cody et al., built a machine which met the counts in the interference in 1960 (A 141).

Attention is called to the record (Appendix Exhibit Volume III, p. 199, p. 203 and elsewhere) in the Brief for Dahlman (Appellant Flymo et al.) that it is established that the machine alleged to have been built by Appellee was not identified or fully described so that it could not be compared with the counts.

Clearly there is not an undisputed record before this court which shows that Cody et al. built a machine which met the counts in the interference nor can it fairly be stated "that Flymo has never seriously questioned the fact that Cody built a machine corresponding to the counts in interference in 1960".

Also a statement that "undisputed testimony also shows the machine did in fact cut grass" which is corroborated by three independent witnesses" and "is uncontradicted" is not an accurate statement of fact of record. Appellant Flymo's brief questions the veracity of the witnesses (Appendix Exhibit Volume III, p. 197) and the identity of what kind of a machine was used to cut grass if it in fact did (p. 199) and whether it successfully cut grass (pp. 183, 184).

As a matter of law the expert administrative body of the United States Patent Office, The Board of Patent Interferences in a contested proceeding held clearly on two separate hearings to the effect that "just cutting grass,

without regard for its effectiveness, is insufficient proof of the practical utility of the maching (sic) for its intended purpose under ordinary working conditions. Thus, Cody et al. did not sustain their burden of proof and did not prove actual reduction to practice of the invention in issue". (Appendix Exhibit Volume III, pp. 119-120).

This issue was clearly considered in detail below and was overruled on summary judgment by the trial court without any new evidence, new law or any new record, which is the basis for Appellants Flymo *et al.* coming before this Honorable Court for review. It is long held as a matter of law that the presumption of validity and priority is strengthened by vigorous contests in the Patent Office proceedings and that such patent not lightly granted by the Patent Office should not lightly be treated by the courts. *Aloe Creme Laboratories, Inc. v. Texas Pharmacal Co.* 1964 (CA 5) 335 F.2d 72; *Abington Textile Machinery Works v. Coding Specialists (Canada) Ltd.* (D.C. Dist. Col.) 249 F. Supp. 823.

ERROR IN THE TRIAL COURT

Trials in the District Courts have long attached great weight to the expertise of the Patent Office and its findings on highly technical matters where the decision may not be overruled unless new evidence is introduced which carries thorough conviction that the Office erred. This is the rule in this court, recently reaffirmed in *De Seversky v. Brenner* (CA DC No. 22262 Feb. 13, 1970). In the case at bar the trial court reversed the record on the record without any new evidence.

THE RECORD BROUGHT BY APPELLANT— IV—Record before the Court, p. 3—

Federal Rules of Appellate Procedure 28(f) and 30(a) provide for submission of the Appendices objected to by Appellee. Clearly from the record and the briefs of both

Appellant and Appellee many questions of law and fact are brought into issue requiring reference to the subject matter of each Appendix Exhibit Volume, and the context adjacent such references is necessary in convenient form for consideration of the Honorable Court.

Accordingly the appendix exhibits are necessary in this case, and are properly in the case and do not require certification, and costs should not be borne by Appellant regardless of the outcome of this case merely because Appellee refuses to agree to what appendices are necessary.

SUMMARY JUDGMENT PROCEEDING, p. 4—

As hereinbefore shown the Burden of Proof is upon the Junior Party Appellee Cody *et al.* who seems to urge that Appellant Flymo is required to provide affidavits or proofs in the trial court. Appellee Cody *et al.* as a matter of fact did not supply affidavits or proofs in the trial court.

Furthermore in this proceeding under 35 USC 146 for a review of the patent office proceeding in the trial court below, where the Appellee Cody *et al.* relied only on the record, there is no basis that only the senior party Appellant Flymo should have to introduce proofs or defenses not of record below. Flymo as a matter of law is entitled in the District Court to bring forth from the record below any defenses and grounds that were brought in issue on the record below.

All the matters of defense by Appellant herein are based upon grounds properly introduced before the Patent Office to the Examiner and to the Board of Interferences. The motions were presented but were not ruled upon in either the decision of the Board of Interferences or the trial court. The Board acknowledges the fact that motions were made by Dahlman (Appellant Flymo *et al.*) but did not find it necessary to rule upon them. (Appendix Exhibit Volume III p. 140).

FLYMO ARGUMENTS, p. 5—

Appellee, Cody *et al.* states inaccurately that Appellant Flymo made no request for reconsideration of motions in the Patent Office and no cross-appeal.

In the record it is clear that Appellants after presentation to the Examiner, asked for reconsideration by the Board of Patent Interferences (Appendix Exhibit Vol. III p. 207) as acknowledged in their decision (p. 140). Furthermore the Answer specifically puts in issue the motions (Defense (8) Appendix Vol. V p. 449) denying that the claims had been timely copied. Furthermore, Affirmative Defenses 3 through 11 clearly put in issue the subject matter of the motions, and established them before the trial court in a cross-motion (Appendix 12a, 34a).

Clearly the motions made of record below are before this Honorable Court for review if necessary by a ruling against Appellants on priority (Brief of Appellant 28). As a matter of Law Appellants are entitled to a review of this nature as set forth in detail in Appellant's Brief on p. 24.

**NO COUNTER AFFIDAVITS ARE REQUIRED
BY FLYMO UNDER RULE 56(e) FRCP, p. 6—**

Appellee Cody *et al.* is presumably trying to establish that on its motion for Summary Judgment made without affidavits and with sole reliance on the record (Appendix 1a) nevertheless the Appellant Flymo is required to submit affidavits. Clearly the rule cited only states form when affidavits are submitted and requires none for answer to a motion. Rule Sections 56(a) and (b) clearly establish that either party may come "with or without affidavits" before the court.

STATEMENTS BY FLYMO, p. 7—

One of the material issues in this case is operability of a machine that works on a ground effect principle of sup-

porting the machine on a cushion of air. Two entirely different structures are involved, an operable device, accepted and proven in the marketplace, produced by Patentee Appellant Flymo, and the inoperable device of Appellee Cody which was not demonstrated in the course of proofs below, as it easily could have been, if operable.

Flymo's machine operated successfully because of a different type blower—one that blows air radially out around the edges of the housing so that it does not blow the grass flat. However, Cody's machine had a propeller blowing air directly down into the grass that was going to be cut. This could give an illusion of cutting by blowing the grass flat. But it is inoperable without critical aerodynamic elements that must be provided to prevent the grass from being blown down by Cody's admission in his own patent application of record. (Appendix Exhibit Vol. II, pp. 68, 51, 57, 59 and 60). These baffles were never proven to be in the machine allegedly used by Cody when cutting grass in 1960.

BAFFLES ARE MATERIAL, p. 8—

A "baffle" is identified by Webster as a plate used to deflect, check, or otherwise regulate the flow of a gas. As such a baffle must be in the air flow path to regulate the flow of the gas. Appellee Cody et al. is attempting to misconstrue the importance of the baffles required in his construction employing a propeller forcing air downwardly toward the ground and grass where the cutting blade is rotating. Without plates used to deflect or regulate the air flow path the grass could not be held up to be cut. See the Cody et al. patent application which states that "the baffles 58 tend to lift the grass or vegetation which has been blown flat by the air blast" and "the secondary baffles 61 and 62 serve to block the flow of air momentarily against the marginal grass—Hence the marginal grass is given an opportunity to stand upright and indeed may be sucked

upwardly to be cut". (Appendix Exhibit Volume II pp. 59-60, 68).

Conversely Flymo puts no baffles in the air flow path outside the air impeller which radially passes air adjacent the housing walls. Flymo's patent drawing at Appendix 73a shows this. The discs Appellee identifies are not baffles but part of the air impeller or propeller and in no way correspond to the Appellee's baffle structure.

It is noted that in patent practice each claim constitutes a separate invention and Claim 3 of Cody is not the same invention as defined in the counts in issue in this proceeding. It rather is an invention to a tilting control in a grass cutting machine having a propeller driving air downwardly into a housing chamber at the bottom and a tilting control for the housing body. This claim is not for the same invention as copied from the Flymo Patent in the interference counts. Furthermore, all other claims not related to the tilt control had baffles claimed at the time of the copying of the claims so that any claim to the invention of the counts, if ever in the case, had been abandoned by Appellee Cody et al. and file wrapper estoppel prevails. Note that in Appellee Cody's amendment of July 29, 1964 (Appendix Exhibit Volume II, pp. 82ff) states "*the claims, as amended—relate to—means for shielding a portion of the path of travel of the blade from the flow of the air. This is believed to be a new combination since, by such an arrangement, a portion of the grass is shielded from the downward blast, whereby the grass may stand upright in the face of a blast of air sufficient to support the casing*". (Italics added). (Appendix Exhibit Volume II p. 76). Thus, the Appellee Cody has relied by his own admission upon these baffle features to show invention.

It is clear from the record that the Appellee Cody et al. had not continuously claimed subject matter "in such broad terms as to include within their scope substantial variations of the device or thing which he had disclosed in the

specification". Therefore the cases quoted by Appellee are not related to the facts in issue, as are the cases of Appellant Flymo (Brief of the Appellant pp. 25, 26).

BURDEN OF PROOF, p. 10—

The experts in the Patent Office Board of Patent Interferences held

"it has not been proved by a preponderance of the evidence that the machines operation was satisfactory. We therefore find that the party Cody et al. has failed to sustain their burden of proof and the senior party Dahlman must prevail on the basis of his constructive reduction to practice of counts 1-3 by the filing of his involved application". (Appendix Exhibit Volume III, 143, 144)

Also upon rehearing the Board further held as follows:

"We did not overlook the testimony referred to by Cody et al. . . . the overall record was considered by us. Such consideration did not convince us that Cody et al. had proved, with the required preponderance of evidence, that the machine built and used in April of 1960, or as modified in some indeterminate manner at any particular proven date in the fall or winter of 1960-61, did in fact operate in a satisfactory manner for its intended purpose.—Thus, Cody et al. did not sustain their burden of proof and did not prove actual reduction to practice of the invention in issue."

REDUCTION TO PRACTICE— PROOF OF OPERATION, pp. 12, 13—

It is clear on the record that Appellee Cody has not anywhere demonstrated an operable machine. It was his burden of proof. If the Cody machine was operable it would have been a simple matter to have shown the machine in operation at the time of proof. This was not done by Cody. By contrast it is also clear on the record that Appellant Flymo was required to demonstrate operability to

the Patent Office Examiner before his patent was granted. (Appendix Exhibit Volume I pp. 15, 8).

The record clearly states "Operativeness was conclusively shown to the Examiner in the demonstration of May 23, 1963—where—The machine at that time demonstrated the ability to closely and neatly crop thick tall grass in a swath clearly outlining that the grass cut in the regions of the extremity of the cutterblade near the outer skirt of the mower housing. The machine was shown to float upon both grass and sidewalk areas clearly showing the principles of the machine operation were sound. Inspection of the cut grass showed clearly no bending or flattening but cleanly cut stems throughout the swath area."

Clearly the expert body of the Patent Office and the Board of Patent Interference Examiners has on two occasions thoroughly reviewed the facts, the record, and the law and held without hesitation that the Appellee Cody had to prove operability to have a reduction to practice to overcome the Senior Party Flymo.

The trial court had no new evidence presented by Cody, had a very brief oral hearing without treating the complex technical matters of interferences and apparently not understanding them (See Appendix 53A) and thereafter promptly handed down a memorandum opinion without giving any substantial reason or finding any facts or relying upon any procedure of law for overruling the case stating contrariwise to the expert Patent Office Board of Patent Interference Examiners "without reviewing the facts of that case in detail" (Appendix 69A). "Flymos counts were not based upon the utility of Flymo's invention—Accordingly, it was not proper for the Board to reject the Cody claims merely because the Board apparently felt that Flymo's machine would work better than Cody's." This is clearly reversible error of fact and law.

Cody's prior conception date, even if proven, would have no bearing. Only a reduction to practice could overcome the Flymo patent.

Clearly therefore proof of operation by Cody *et al.* is pertinent to overcome the Flymo patent.

OPERABILITY, p. 23—

Appellee Cody having the burden of proof did not establish a witness to corroborate testimony of the invention as to the machine construction at the time the grass was allegedly "cut". No baffles on the machine in 1960 were identified by the persons who said grass was "cut".

STATUTORY BAR, p. 25—

The record below is properly before the Court. All the publications relied upon by Flymo are part of the record before the Court as presented to the Patent Office.

Attention is recalled to matter stated hereinbefore on the matter of effective filing date being at the time of copying claims and relationships between 35 USC 102(b) and 35 USC 135(b) as established by the Supreme Court in favor of a statutory bar under circumstances such as presented by Cody.

The scope of the Flymo claims is "quite an exception" to the scope of the application as admitted on the record by Cody *et al.* (Appendix Exhibit Volume II p. 76).

CONCLUSION

Attention is directed to the long line of exhibits and experiments made by Cody *et al.* as evidenced in the record (Appendix Exhibit Volume IV p. 379, Sites A 40, p. 382, Sites A 59, p. 383, Sites A 63-64 p. 385 and Sites A 75ff.) which certainly amount to an admission that the original machine did not operate to the satisfaction of the inventors and function for its intended purpose contrary to what counsel for Cody has stated.

Accordingly it is shown herein that if the Brief of the Appellee Cody is considered in any respect it should be

carefully scrutinized for factual content and substantiation on the record.

If it please this Honorable Court, it is clearly shown on the record that the requests of Appellant Flymo are sound in fact and in law and a favorable ruling to that effect is respectfully requested.

Respectfully submitted,

LAURENCE R. BROWN

Attorney for Appellants

Of Counsel:

JOHN H. LEWIS, JR.

STEVENS, DAVIS, MILLER & MOSHER